

# EXHIBIT 1



**SENT VIA US MAIL AND ELECTRONIC MAIL**

May 22, 2019

United States Patent and Trademark Office  
USPTO FOIA Officer  
PO Box 1450, Alexandria, VA 22313-1450  
FOIARequests@uspto.gov

**Re: Request under the Freedom of Information Act (FOIA)**

Dear FOIA Officer:

In view of a demonstrably false statements in the Proceeding No. D2019-31 in the Final Order with respect to Heather A. Sapp (a former associate attorney at our law firm) and its associated investigation file G3493, I am writing to request information under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552, et. seq. for all records and records from investigations pertaining to and leading up to the final order of Heather A. Sapp by the USPTO as explained below.

I request disclosure of records that were prepared, received, transmitted, collected and/or maintained relating or referring to the following information.

**I. Records Requested.**

All records containing, describing, pertaining to, or referring to:

1. Any and all Requests for Information (RFI)'s sent by the USPTO Office Of Enrollment & Discipline to Heather A. Sapp or her counsel leading to the Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.

**Law-inspiring™**

1580 W. El Camino Real, Ste 13  
Mountain View, CA 94040

T: 650.965.8731  
F: 650.989.2131

questions@legalforcelaw.com  
legalforcelaw.com



2. Any and all Responses submitted by Heather A. Sapp either directly or through counsel leading to the Final Order D2019-31 including, but not limited to, that associated with OED investigation file G3493.
3. Any and all notes from interviews conducted in person with Heather A. Sapp and/or her attorney that are not governed under any settlement privilege in to the Proceeding No. D2019-31 including, but not limited to, any 11.22 meeting notes associated with OED investigation file G3493.
4. Any and all declarations, affidavits, or statements of facts received or taken by OED from Heather A. Sapp by the USPTO in their investigation leading to the Final Order in Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.

## **II. Fees.**

I will pay any reasonable fees that may be associated with this request.

## **III. Request for Release of All Responsive Records.**

I believe that all of the records requested are subject to disclosure, and I request prompt processing and release of the requested information. I also request a complete list of documents covered by the request. I expect that all records will be provided in complete form. To the extent that any requested records are marked classified, please redact only the necessary portions of those records and immediately provide me with the remaining portions. If any records are withheld, please state the exemption claimed and provide a list of the records being withheld. If you deny this request in whole or in part, please provide a written explanation for the denial, including specific reference to the specific statutory provisions upon which you rely, and notify me of appeal procedures available under the law.

## **IV. Conclusion.**

I look forward to a written response to this FOIA Request by the close of the statutory time period, which is within ten working days of your receipt of this Request. To conserve public

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resources, please provide the requested records, to the extent possible, via electronic mail attachment to [raj@legalforcelaw.com](mailto:raj@legalforcelaw.com) or via Fax to 650-989-2131, and 888-846-8777.

Respectfully,

LEGALFORCE RAPC WORLDWIDE P.C.

A handwritten signature in black ink, appearing to read 'Raj Abhyanker'.

By: Raj Abhyanker

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# EXHIBIT 2



**UNITED STATES PATENT AND TRADEMARK OFFICE**

OFFICE OF THE GENERAL COUNSEL

Thursday, May 23, 2019

**VIA EMAIL**

Raj Abhyanker  
Legalforce RAPC Worldwide  
1580 W. El Camino Real, Suite 13  
Mountain View, CA 94040

Dear Abhyanker:

Your Freedom of Information Act (FOIA) and/or Privacy Act request was received by the United States Patent and Trademark Office (USPTO) FOIA Office on **Wednesday, May 22, 2019**.

Your request has been docketed as **"FOIA Request No. F-19-00197."** Any further inquiries regarding your request should include that number. A copy of your request is attached for reference.

In the event your original request was incorrectly addressed, please address all inquiries regarding your request to:

FREEDOM OF INFORMATION ACT (FOIA) OFFICER  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or via email to [foiarequests@uspto.gov](mailto:foiarequests@uspto.gov)

The Agency expects to send its response to this request no later than Thursday, June 20, 2019. You will be notified if it appears that additional time is required. You may check on the status of your request at the Agency's website: [www.uspto.gov](http://www.uspto.gov), click on "Freedom of Information Act" at the bottom of the page, and then "Check FOIA Request Status." You will need your request number, shown above, to check on the status of your request.

Sincerely,

USPTO FOIA Office

Enclosure

# EXHIBIT 3



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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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OFFICE OF THE GENERAL COUNSEL

May 29, 2019

Raj Abhyanker  
Legalforce RAPC Worldwide  
1580 W. El Camino Real, Suite 13  
Mountain View, CA 94040

Re: ***Freedom of Information Act (FOIA) Request No. F-19-00197***

Dear Mr. Abhyanker:

The United States Patent and Trademark Office (USPTO) FOIA Office received your email dated requesting, under the Freedom of Information Act (5 U.S.C. § 552) a copy of:

Various records that were prepared, received, transmitted, collected and/or maintained relating or referring to Heather A. Sapp or her counsel leading to the Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.

Preliminary estimates indicate that the approximate processing cost for this FOIA request is **\$ 3017.28**. This estimate includes estimated search time of approximately 26 hours (various GS level employees and 1 SL) and estimated review time of approximately 10 hours for the FOIA Specialist and 5 hours for the FOIA Officer. Associated copy charges cannot be estimated until a final determination regarding releasability is made.

This estimate does not necessarily represent the final cost. Estimates are inherently imprecise, and the final cost could be higher or lower than the amount provided here. However, the estimate provided herein is reasonably calculated to represent search costs required to adequately respond to your request.

As a commercial use FOIA requester, you are responsible for the costs involved in search, review and duplication. See 37 C.F.R. § 102.11(c)(1)(i).

Please note that a search fee is chargeable even when no responsive records are found, or when the records requested are determined to be totally exempt from disclosure. See 37 C.F.R. § 102.11(c)(3)(i)).

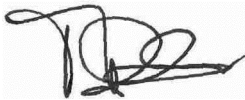
Requestors must pay the entire anticipated fee before the Agency begins processing a request when the fee estimate exceeds \$250.00. See 37 C.F.R. § 102.11(i)(2).

Please remit, within 30 calendar days of the date of this letter, a check made payable to the “**Department of Treasury**” in the amount of \$ **3017.28**. The payment must be sent to:

United States Patent and Trademark Office  
Freedom of Information Act Officer  
Office of the General Counsel  
P.O. Box 1450  
Alexandria, VA 22313-1450

If payment in the full amount of the initial estimate is not received by **June 28, 2019** this request will be considered withdrawn and closed. Please contact us before that date, however, if you would like to discuss your request in order to reformulate it to meet your needs at a reduced cost.

Sincerely,

A handwritten signature in black ink, appearing to read 'Traci Alexander', with a stylized flourish at the end.

Traci Alexander  
FOIA Specialist  
Office of General Law

# EXHIBIT 4



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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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Office of the General Counsel

June 20, 2019

**VIA EMAIL**

Mr. Raj Abhyanker  
Legalforce RAPC Worldwide  
1580 W. El Camino Real, Suite 13  
Mountain View, CA 94040  
raj@legalforcelaw.com

***Re: Freedom of Information Act (FOIA) Request No. F-19-00197***

Dear Mr. Abhyanker:

The USPTO is in receipt of your FOIA request referenced above. This is the Agency's notice to extend the response time limit to your Freedom of Information Act (5 U.S.C. § 552) request for:

Various documents from Office of Enrollment and Discipline (OED) proceeding D2019-31 re Heather Sapp. This is to include, but not limited to, OED investigation file G3493.

The request was received on May 22, 2019. The response period for the Agency's initial determination runs through June 20, 2019.

In accordance with 37 C.F.R. § 102.6(c), the response time limit is hereby extended ten additional working days to **July 14, 2019** due to unusual circumstances. This extension is necessary because of the need to appropriately examine a voluminous amount of records that are subject to the request. The Agency's response will promptly follow its review and final assembly of responsive documents. No additional extensions are anticipated, and records will be released before July 14, 2019 if possible.

Sincerely,

A handwritten signature in black ink, appearing to read "Traci Alexander", is positioned above the typed name.

Traci Alexander  
USPTO FOIA Specialist  
Office of General Law

# EXHIBIT 5





## UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

June 24, 2019

**VIA EMAIL**

Mr. Raj Abhyanker  
Legalforce RAPC Worldwide  
1580 W. El Camino Real, Suite 13  
Mountain View, CA 94040

RE: ***Freedom of Information Act (FOIA) Request No. F-19-00197***

Dear Mr. Abhyanker:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated Wednesday, May 22, 2019 requesting a copy of the following documents pursuant to the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

All records containing, describing, pertaining to, or referring to:

1. Any and all Request for Information (RFI's) sent by the USPTO Office of Enrollment and Discipline to Heather A. Sapp or her counsel leading to the Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.
2. Any and all responses submitted by Heather A. Sapp either directly or through counsel leading to the Final Order D2019-31 including, but not limited to, that associated with OED investigation file G3493.
3. Any and all notes from interviews conducted in person with Heather A. Sapp and/or her attorney that are not governed under any settlement privilege in to the Proceeding No. D2019-31 including but not limited to, any 11.22 meeting notes associated with OED investigation file G3493.
4. Any and all declarations, affidavits, or statements of facts received or taken by OED from Heather A. Sapp by the USPTO in their investigation leading to the Final Order in Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.

The USPTO has identified voluminous documents that are responsive to your request. Of those documents, nineteen pages are released in full and are included herein. The remaining documents were withheld in full pursuant to Exemption (b)(6) of the FOIA.

Exemption (b)(6) of the FOIA, which permits the withholding of "personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy." 5 U.S.C. § 552(b)(6). The term "similar files" has been broadly construed to cover "detailed Government records on an individual which can be identified as applying to that individual." Dep't of State v. Washington Post, 456 U.S. 595, 601 (1982). Information that applies to a particular individual meets the threshold requirement for Exemption (b)(6) protection. Id. The privacy interest at stake belongs to the individual, not the agency. See Dep't of Justice v. Reporters Comm. for Freedom of the Press, 489 U.S. 749, 763-65 (1989). Exemption (b)(6) requires a balancing of an individual's right to privacy against the public's right to disclosure. See Dep't of the Air Force v. Rose, 425 U.S. 352, 372 (1976); Multi Ag Media LLC v. Dep't of Agric., 515 F.3d 1224, 1228 (D.C. Cir. 2008).

Here, the records contained in discipline file D2019-31 and investigatory record for Investigation G3493 is information that applies to particular individuals, and in which those individuals have a legitimate privacy interest. The burden is on the requester to establish that disclosure of this information would serve the public interest. See Bangoura v. Dep't of the Army, 607 F. Supp. 2d 134, 148-49 (D.D.C. 2009). When balancing the public interest of release against individual privacy interest, the Supreme Court has made clear that information that does not directly

reveal the operations or activities of the federal government falls outside the ambit of the public interest. See Reporters Comm., 489 U.S. at 775. The withheld information does little to shed light or contribute significantly to public understanding of the operations or activities of the USPTO. Your FOIA request does not assert a public interest that outweighs the privacy interest, nor is one otherwise evident. As such, the FOIA dictates that the information be withheld.

You have the right to appeal this initial decision to the Deputy General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 90 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why the information should be made available and why this initial denial is in error. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal."

You may contact the FOIA Public Liaison at 571-272-9585 for any further assistance and to discuss any aspect of your request. Additionally, you may contact the Office of Government Information Services (OGIS) at the National Archives and Records Administration to inquire about the FOIA mediation services they offer. The contact information for OGIS is as follows: Office of Government Information Services, National Archives and Records Administration, 8601 Adelphi Road-OGIS, College Park, Maryland 20740-6001, e-mail at [ogis@nara.gov](mailto:ogis@nara.gov); telephone at 202-741-5770; toll free at 1-877-684-6448; or facsimile at 202-741-5769.

Sincerely,

A handwritten signature in blue ink, appearing to read "Tricia Choe".

Tricia Choe  
USPTO FOIA Officer  
Office of General Law

Enclosure

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE USPTO DIRECTOR**

In the Matter of  
  
Heather A. Sapp,  
  
Respondent

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Proceeding No. D2019-31

**FINAL ORDER PURSUANT TO 37 C.F.R. § 11.26**

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Heather A. Sapp (“Respondent”), by counsel, have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ joint stipulated facts, joint legal conclusions, and agreed-upon sanctions found in the Agreement.

**Jurisdiction**

1. At all times relevant Respondent of Tempe, Arizona, has been an attorney in good standing in the State of Arizona engaged in practice before the Office in trademark matters pursuant to 37 C.F.R. § 11.14(a). Therefore, Respondent is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. §§ 11.101 through 11.901.
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

**Legal Background**

3. USPTO regulations require that the person named as the signatory on an electronic trademark document to be filed with the Office personally enter his or her electronic signature on the document (*i.e.*, personally enter the combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission). *See* 37 C.F.R. § 2.193(a)(2), (c), and (e).
4. The USPTO Trademark Manual of Examining Procedure (“TMEP”) provides guidance to practitioners regarding the USPTO trademark electronic signature regulations:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a).

The person(s) identified as the signatory must manually enter the elements of the electronic signature.

Another person (*e.g.*, paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory.

Just as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.

*See* TMEP § 611.01(c) (case citations omitted) (line spacing added).

#### **Joint Stipulated Facts**

5. From September 1, 2016, to February 2019, Respondent was employed as a Senior Trademark Attorney and the Training and Communications Manager for LegalForce RAPC Worldwide, a law firm. Respondent represents that, although she managed the law firm's law clerks, she did not have the authority to hire or fire the law firm's non-practitioner assistants or have supervisory authority over the law firm's attorneys. Respondent worked in the law firm's Tempe, Arizona office.

6. At all relevant times, Respondent was the attorney of record before the USPTO in pending trademark applications or issued (or renewed) registrations.

7. At all relevant times, Respondent also prepared and reviewed trademark documents in pending trademark applications or issued (or renewed) registrations in which other attorneys from the law firm were the attorney of record before the USPTO.

8. Non-practitioner assistants helped Respondent in preparing and filing trademark documents filed with the USPTO. These non-practitioner assistants were located in Tempe, Arizona, and Maharashtra, India.

9. Contrary to the USPTO trademark signature regulations and guidance referenced in paragraphs 3 and 4, above, non-practitioner assistants were impermissibly signing client names to USPTO trademark filings. The filings—such as Trademark/Service Mark Statements of Use pursuant to 15 U.S.C. § 1051(d)—typically carried an important warning, such as:

*The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of*



*his/her own knowledge are true and all statements made on information and belief are believed to be true.*

10. The impermissible signature practice existed prior to Ms. Sapp's employment and continued at least until June 2018. By such time, Respondent had been directly involved, as the attorney of record or as an attorney assisting the attorney of record, in numerous impermissibly signed trademark documents filed with the USPTO.

11. Respondent represents that she first became aware in or around June 2018 that non-practitioner assistants were signing client names to trademark filings contrary to the aforementioned USPTO trademark signature regulations and TMEP guidance.

12. Respondent represents that, prior to June 2018, she did not understand adequately the USPTO trademark signature regulations and guidance referenced in paragraphs 3 and 4, above. Respondent now recognizes that (a) as the attorney of record in pending trademark applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of the law firm's clients or (b) as an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record, she did not take reasonable and appropriate steps to ensure compliance with the signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c). Specifically, she recognizes that, in such matters, she (a) allowed non-practitioner assistants to sign trademark filings rather than having the named signatory (*i.e.*, the client) sign the filings and/or (b) did not adequately monitor or supervise non-practitioner assistants to ensure compliance with the USPTO's trademark signature rules and guidance. Respondent further recognizes that, after learning of the impermissible signature practice, she did not take steps to notify clients or the USPTO promptly about the material misrepresentations set forth in the impermissibly signed trademark filings (*e.g.* that the named declarant did not sign the declaration) for those matters where she was either (a) the attorney of record in pending trademark applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients or (b) an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record. Instead, she waited several months after learning about the impermissible signature issue to start to take such steps. Respondent represents that she raised the issue of corrective action with the firm's management in June 2018, but she was told that no action was necessary at that time. Respondent further represents that, at the time her relationship with the firm was terminated, she intended to inform the firm's clients of the impermissible signatures and the implications thereof and was taking steps to attempt to identify the affected applications and/or registrations.

### **Additional Considerations**

13. In fourteen years of trademark law practice, Respondent has not been publicly disciplined by any state, territorial bar, state or federal court, or state or federal agency (including the USPTO).

14. Respondent has acknowledged her ethical lapses, demonstrated genuine contrition, and accepted responsibility for her acts and omissions. She understands the seriousness of allowing non-practitioner assistants to impermissibly sign others' signatures on trademark documents, including declarations, filed with and relied upon by the USPTO in examining trademark applications and issuing (or renewing) registrations. She also acknowledges the actual or potential significant adverse consequences that such impermissibly signed trademark filings may have had on clients' intellectual property rights in their pending trademark applications or issued (or renewed) registrations.

15. Respondent cooperated with OED's investigation, *e.g.*, by agreeing to a telephonic interview with Office of Enrollment and Discipline and by providing *sua sponte* informative, supplemental responses to her original responses to requests for information that clarified facts surrounding the impermissible signature practice.

16. Additionally, upon learning of the impermissible signature practice, Respondent took corrective action by way of retraining the firm's practitioners and non-practitioners to ensure future compliance with the USPTO signature regulations and guidance and by developing an internal audit team to assist with verifying and maintaining compliance.

### **Joint Legal Conclusions**

17. Respondent acknowledges that, based on the information contained in the joint stipulated facts, above, her conduct—as either (a) the attorney of record for clients in pending trademark applications or issued (or renewed) registrations before the USPTO or as (b) an attorney who prepared and reviewed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record—violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.101 (requiring a practitioner to provide competent representation to a client) by not understanding adequately the USPTO trademark signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c);
- b. 37 C.F.R. §§ 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client) and 11.503(b) (practitioner's responsibility over non-practitioners assisting practitioner) by (i) having trademark documents filed with the USPTO where someone other than the named signatory electronically signed the documents in violation of USPTO trademark signature regulations and guidance; (ii) prior to trademark documents being filed with the USPTO, not taking reasonable steps to learn whether non-practitioner assistants



who were tasked with obtaining the signatures of the named signatories on trademark documents were impermissibly signing the documents (*e.g.*, by not monitoring the signature process or otherwise taking reasonable steps to learn whether non-practitioner assistants were actually obtaining the named signatories' respective signatures); (iii) not knowing that non-practitioner assistants were signing for the named signatories; and/or (iv) after learning of the impermissible signature practice, not promptly notifying clients about the impermissibly signed trademark filings or the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice;

- c. 37 C.F.R. §§ 11.104(a) and (b) (communications with client), after learning of the impermissible signature practice, by (i) not promptly informing clients about impermissibly signed trademark filings or the status of their pending applications and issued (or renewed) registrations in light of the impermissible signature practice; (ii) not promptly and reasonably explaining to clients the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice (*e.g.*, including whether the electronic signing of a document, including a declaration, by one other than the named signatory jeopardizes the intellectual property rights of the client); and (iii) not promptly and reasonably consulting with clients about the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice so that clients can make informed decisions regarding the representation of their trademark interests;
- d. 37 C.F.R. §§ 11.303(a)(1), (a)(3), (b), (d) (candor toward the USPTO) by having trademark documents, including declarations, filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and not promptly reasonably correcting the impliedly false statement of material fact after learning of the impermissibly signed filings (*e.g.*, informing the USPTO that the named signatory did not sign the document);
- e. 37 C.F.R. §§ 11.804(c) (misrepresentation) and (d) (conduct prejudicial to the USPTO trademark registration process) by (i) having trademark documents, including declarations, filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and not promptly reasonably correcting the impliedly false statement after learning of the impermissibly signed filings (*e.g.*, informing the USPTO that the named signatory did not sign the document) and (ii) having declarations filed with the USPTO, on which the USPTO relied in examining trademark applications and issuing (or renewing) registrations, that were signed by other than the named declarant and not promptly taking reasonable remedial measures regarding the declarations (*e.g.*, informing the USPTO that the named signatory did not sign the document); and

- f. 37 C.F.R. § 11.804(i) (other conduct that adversely reflects on the practitioner's fitness to practice before the Office) by engaging in the acts and omissions regarding not notifying clients or the USPTO about the impermissible signature practice or the impermissibly signed filings.

**Agreed-Upon Sanction**

18. Respondent freely and voluntarily agrees, and it is hereby ORDERED that:

- a. Respondent be, and hereby is, publicly reprimanded;
- b. Respondent shall be placed on probation for one year beginning with the date of the Final Order;
- c. Respondent shall be permitted to practice before the USPTO in trademark and other non-patent matters during her probationary period, unless her probation is revoked and she is suspended by order of the USPTO Director or otherwise no longer has the authority to practice before the USPTO;
- d. (1) if the OED Director is of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the USPTO Rules of Professional Conduct, the OED Director shall:
  - (A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending the Respondent for up to twelve (12) months for the violations set forth in the Joint Legal Conclusions, above;
  - (B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director;
  - (C) grant Respondent fifteen (15) days to respond to the Order to Show Cause; and
- (2) in the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with the USPTO Rules of Professional Conduct, the OED Director shall:
  - (A) deliver to the USPTO Director: (i) the Order to Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence supporting the OED Director's position; and
  - (B) request that the USPTO Director enter an order immediately suspending Respondent for up to twelve (12) months for the violations set forth in the



Joint Legal Conclusions above;

- e. Nothing herein shall prevent the OED Director from seeking discrete discipline for any misconduct that formed the basis for an Order to Show Cause issued pursuant to the preceding subparagraph;
- f. In the event the Respondent seeks a review of any action taken pursuant to subparagraph d., above, such review shall not operate to postpone or otherwise hold in abeyance the suspension;
- g. The OED Director shall electronically publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- h. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

**Notice of Public Reprimand and Probation**

This notice concerns non-registered practitioner, Heather A. Sapp of Tempe, Arizona, who is hereby publicly reprimanded and placed on probation for twelve (12) months for violating 37 C.F.R. §§ 11.101; 11.103; 11.104 (a) and (b); 11.303(a)(1), (a)(3), (b) and (d); 11.503(b); 11.804(c); 11.804(d); and 11.804(i). The violations are predicated on non-practitioner assistants electronically signing numerous USPTO trademark filings on behalf of the named signatories in violation of the USPTO trademark electronic signature regulations and guidance in trademark matters where Ms. Sapp was either the attorney of record or the attorney who prepared, reviewed, and/or caused to be filed trademark documents where another attorney was the attorney of record. Ms. Sapp is permitted to practice before the Office in trademark and other non-patent matters during her probationary period unless she is subsequently suspended by order of the USPTO Director.

Between September 1, 2016, and February 2019, Ms. Sapp was a trademark attorney employed by LegalForce RAPC Worldwide. Prior to her employment and until at least June 2018, non-practitioner assistants were signing client names to USPTO trademark filings in violation of USPTO trademark signature regulations and guidance. Ms. Sapp represents that she first became aware in or around June 2018 that non-practitioners were signing documents to be filed with the USPTO. Ms. Sapp further represents that, while representing clients in trademark matters before the USPTO, she did not understand adequately the USPTO trademark signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c). Consequently, during this time period, Ms. Sapp, in her capacity as (a) the attorney of record in pending trademark

applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients and (b) an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record, did not take reasonable and appropriate steps to ensure compliance with the USPTO trademark signature requirements or guidance. Ms. Sapp was directly involved in USPTO trademark filings such that she (i) had trademark documents filed with the USPTO where non-practitioner assistants signed the documents, including declarations, instead of the named signatory; (ii) prior to trademark documents being filed with the USPTO, did not take reasonable steps to learn whether non-practitioner assistants were signing the documents in compliance with USPTO signature regulations and guidance (*e.g.*, she did not monitor the signature process or otherwise take reasonable steps to learn whether non-practitioner assistants were actually obtaining the named signatories' respective signatures); (iii) after learning of the impermissible signature practice, did not promptly notify clients about impermissibly signed trademark filings or the legal status of their pending applications and issued (or renewed) registrations in light of the impermissible signature practice, did not promptly and reasonably explain to clients about the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice (*e.g.*, including whether the electronic signing of a document, including a declaration, by one other than the named signatory jeopardizes the intellectual property rights of the client), and did not promptly and reasonably consult with clients regarding the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice so that clients can make informed decisions regarding the representation of their trademark interests; (iv) after learning of the impermissible signature practice, did not promptly notify the USPTO about the impermissibly signed trademark filings; (v) having trademark documents filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and did not promptly reasonably correct the impliedly false statement after learning of the impermissibly signed trademark filings (*e.g.*, informing the USPTO that the named signatory did not sign the document); and (vi) having declarations filed with the USPTO, on which the USPTO relied in examining trademark applications and issuing (or renewing) registrations, that were signed by other than the named declarant, and did not promptly take reasonable remedial measures regarding the declarations (*e.g.*, informing the USPTO that the named signatory did not sign the document). Ms. Sapp represents that she raised the issue of corrective



action with the firm's management in June 2018, but she was told that no action was necessary at that time. Ms. Sapp further represents that, at the time her relationship with the firm was terminated, she intended to inform the firm's clients of the impermissible signatures and the implications thereof and was taking steps to attempt to identify the affected applications and/or registrations.

Ms. Sapp has acknowledged her ethical lapses, demonstrated genuine contrition, and accepted responsibility for her conduct. Moreover, Ms. Sapp cooperated with OED's investigation, *e.g.*, by agreeing to a telephonic interview with Office of Enrollment and Discipline and by providing informative, supplemental responses to her original responses to requests for information that clarified how signatures were entered on USPTO trademark filings.

USPTO trademark signature regulations require that a proper person sign a trademark document and that the person named as the signatory on the document be the one who enters his or her electronic signature on the document (*i.e.*, personally enter the combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash ("/") symbols in the signature block on the electronic submission). *See* 37 C.F.R. § 2.193(a)(2), (c) and (e).

The USPTO Trademark Manual of Examining Procedure ("TMEP") provides straightforward guidance regarding the USPTO trademark electronic signature regulations:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a).

The person(s) identified as the signatory must manually enter the elements of the electronic signature.

Another person (*e.g.*, paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory.

Just as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.

*See* TMEP § 611.01(c) (case citations omitted) (line spacing added).

Practitioners may delegate tasks to non-practitioner paraprofessionals and other non-practitioner assistants. But where a

task is so delegated, the practitioner is to supervise adequately the non-practitioner, including giving appropriate instruction and monitoring the non-practitioners' activities. As in this matter, a practitioner may be disciplined for failing to take reasonable steps to supervise their paraprofessionals and other non-practitioner assistants.

Practitioners who represent trademark applicants before the USPTO have an ethical obligation to provide competent representation to a client, which includes the legal knowledge, skill, thoroughness, and preparation reasonably necessary for the representation. *See generally* 37 C.F.R. § 11.101. Accordingly, practitioners who represent trademark applicants before the USPTO in trademark matters are reasonably expected to be knowledgeable of USPTO regulations and guidance pertaining to electronically signing trademark applications and other trademark documents with the Office, including the regulations cited in, and guidance provided under, TMEP § 611.01(c).

Under 37 C.F.R. § 11.104, practitioners who represent trademark applicants before the USPTO have an ethical obligation to reasonably consult with the client about the means by which the client's objectives are to be accomplished (*e.g.*, who is authorized to electronically sign documents, including declarations, filed with the USPTO on behalf of a client), to keep the client reasonably informed about the status of the matter (*e.g.*, who electronically signed documents, including declarations, filed with the USPTO on behalf of the client), to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation (*e.g.*, whether the electronic signing of a document, including a declaration, by other than the named signatory may jeopardize the intellectual property rights of any issued trademark registration where the USPTO relied on an impermissibly signed declaration filed with the USPTO during its examination of the client's trademark application or when renewing a registration), and to consult with the client about any relevant limitation on the practitioner's conduct when the practitioner knows that the client expects assistance not permitted by the USPTO Rules of Professional Conduct or other law (*e.g.*, 37 C.F.R. § 2.193).

Practitioners who represent trademark applicants before the USPTO "shall not knowingly . . . [m]ake a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner," which includes, *e.g.*, a declaration not signed by the named signatory. 37 C.F.R. § 11.303(a)(1). "If a practitioner, the practitioner's client,



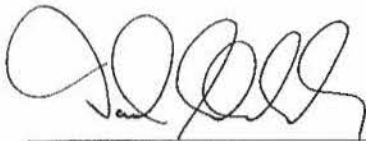
or a witness called by the practitioner, has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the [USPTO].” 37 C.F.R. § 11.303(a)(3). Practitioners also have the obligation to disclose to the USPTO that a person is engaging in or has engaged in fraudulent conduct relating to the examination of the practitioner’s client’s trademark application or renewal of registration and to take reasonable remedial measures. *See generally* 37 C.F.R. § 11.303(b). Compliance with § 11.303(a)(1), (a)(3), and (b) is required even if compliance requires disclosure of information or evidence otherwise protected by 37 C.F.R. § 11.106. *See generally* 37 C.F.R. § 11.303(d). Similar ethical obligations are found under 37 C.F.R. § 11.401.

Practitioners who represent trademark applicants before the USPTO have an ethical obligation to the USPTO not to engage in conduct prejudicial to the administration of justice and not to engage in conduct involving misrepresentation. *See generally* 37 C.F.R. § 11.804(d) and 37 C.F.R. § 11.804(e). Accordingly, practitioners who represent trademark applicants before the USPTO are reasonably expected not to file, or allow to be filed, declarations that are not signed by the named signatory. Trademark filings bearing declarations—such as a TEAS Plus Application, a Trademark/Service Mark Statement of Use pursuant to 15 U.S.C. § 1051(d) and a Combined Declaration of Use and Incontestability Under Sections 8 and 15—are relied upon by the USPTO when examining trademark applications, registering marks, and renewing registrations. When such filings are impermissibly signed and filed with the USPTO, the integrity of the federal trademark registration process is adversely affected. If signed by a person determined to be an unauthorized signatory, a resulting registration may be invalid.

This action is the result of a settlement agreement between Ms. Sapp and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: [http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp](http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp;);

- i. Nothing shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office and (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent’s behalf.

- j. Respondent waives all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner; and
- k. Each party shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and any Final Order.



David Shewchuk  
Deputy General Counsel for General Law  
U.S. Patent and Trademark Office

15 May 2019

Date

on delegated authority by

Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the U.S. Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline

Heather A. Sapp  
c/o Alexandra Mijares Nash  
Mijares Nash, PLLC  
301 W. Warner Road, Suite 133  
Tempe, Arizona 85284  
*Counsel for Respondent*



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Between September 1, 2016, and February 2019, Ms. Sapp was a trademark attorney employed by LegalForce RAPC Worldwide. Prior to her employment and until at least June 2018, non-practitioner assistants were signing client names to USPTO trademark filings in violation of USPTO trademark signature regulations and guidance. Ms. Sapp represents that she first became aware in or around June 2018 that non-practitioners were signing documents to be filed with the USPTO. Ms. Sapp further represents that, while representing clients in trademark matters before the USPTO, she did not understand adequately the USPTO trademark signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c). Consequently, during this time period, Ms. Sapp, in her capacity as (a) the attorney of record in pending trademark applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients and (b) an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record, did not take reasonable and appropriate steps to ensure compliance with the USPTO trademark signature requirements or guidance. Ms. Sapp was directly involved in USPTO trademark filings such that she (i) had trademark documents filed with the USPTO where non-practitioner assistants signed the documents, including declarations, instead of the named signatory; (ii) prior to trademark documents being filed with the USPTO, did not take reasonable steps to learn whether non-practitioner assistants were signing the documents in compliance with USPTO signature regulations and guidance (*e.g.*, she did not monitor the signature process or otherwise take reasonable steps to learn whether non-practitioner assistants were actually obtaining the named signatories'

respective signatures); (iii) after learning of the impermissible signature practice, did not promptly notify clients about impermissibly signed trademark filings or the legal status of their pending applications and issued (or renewed) registrations in light of the impermissible signature practice, did not promptly and reasonably explain to clients about the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice (*e.g.*, including whether the electronic signing of a document, including a declaration, by one other than the named signatory jeopardizes the intellectual property rights of the client), and did not promptly and reasonably consult with clients regarding the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice so that clients can make informed decisions regarding the representation of their trademark interests; (iv) after learning of the impermissible signature practice, did not promptly notify the USPTO about the impermissibly signed trademark filings; (v) having trademark documents filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and did not promptly reasonably correct the impliedly false statement after learning of the impermissibly signed trademark filings (*e.g.*, informing the USPTO that the named signatory did not sign the document); and (vi) having declarations filed with the USPTO, on which the USPTO relied in examining trademark applications and issuing (or renewing) registrations, that were signed by other than the named declarant, and did not promptly take reasonable remedial measures regarding the declarations (*e.g.*, informing the USPTO that the named signatory did not sign the document). Ms. Sapp represents that she raised the issue of corrective action with the firm's management in June 2018, but she was told that no action was necessary at that time. Ms. Sapp further represents that, at the time her relationship with the firm was terminated, she intended to inform the firm's clients of the impermissible signatures and the implications thereof and was taking steps to attempt to identify the affected applications and/or registrations.

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*See* TMEP § 611.01(c) (case citations omitted) (line spacing added).

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under, TMEP § 611.01(c).

Under 37 C.F.R. § 11.104, practitioners who represent trademark applicants before the USPTO have an ethical obligation to reasonably consult with the client about the means by which the client's objectives are to be accomplished (*e.g.*, who is authorized to electronically sign documents, including declarations, filed with the USPTO on behalf of a client), to keep the client reasonably informed about the status of the matter (*e.g.*, who electronically signed documents, including declarations, filed with the USPTO on behalf of the client), to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation (*e.g.*, whether the electronic signing of a document, including a declaration, by other than the named signatory may jeopardize the intellectual property rights of any issued trademark registration where the USPTO relied on an impermissibly signed declaration filed with the USPTO during its examination of the client's trademark application or when renewing a registration), and to consult with the client about any relevant limitation on the practitioner's conduct when the practitioner knows that the client expects assistance not permitted by the USPTO Rules of Professional Conduct or other law (*e.g.*, 37 C.F.R. § 2.193).

Practitioners who represent trademark applicants before the USPTO "shall not knowingly . . . [m]ake a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner," which includes, *e.g.*, a declaration not signed by the named signatory.

37 C.F.R. § 11.303(a)(1). "If a practitioner, the practitioner's client, or a witness called by the practitioner, has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the [USPTO]." 37 C.F.R. § 11.303(a)(3). Practitioners also have the obligation to disclose to the USPTO that a person is engaging in or has engaged in fraudulent conduct relating to the examination of the practitioner's client's trademark application or renewal of registration and to take reasonable remedial measures.

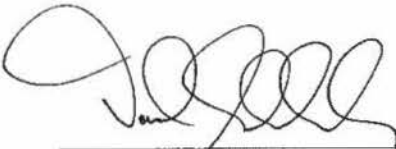
*See generally* 37 C.F.R. § 11.303(b). Compliance with § 11.303(a)(1), (a)(3), and (b) is required even if compliance requires disclosure of information or evidence otherwise protected by 37 C.F.R. § 11.106. *See generally* 37 C.F.R. § 11.303(d). Similar ethical obligations are found under 37 C.F.R. § 11.401.

Practitioners who represent trademark applicants before the USPTO have an ethical obligation to the USPTO not to engage in conduct prejudicial to the administration of justice and not to engage in



conduct involving misrepresentation. *See generally* 37 C.F.R. § 11.804(d) and 37 C.F.R. § 11.804(c). Accordingly, practitioners who represent trademark applicants before the USPTO are reasonably expected not to file, or allow to be filed, declarations that are not signed by the named signatory. Trademark filings bearing declarations—such as a TEAS Plus Application, a Trademark/Service Mark Statement of Use pursuant to 15 U.S.C. § 1051(d) and a Combined Declaration of Use and Incontestability Under Sections 8 and 15—are relied upon by the USPTO when examining trademark applications, registering marks, and renewing registrations. When such filings are impermissibly signed and filed with the USPTO, the integrity of the federal trademark registration process is adversely affected. If signed by a person determined to be an unauthorized signatory, a resulting registration may be invalid.

This action is the result of a settlement agreement between Ms. Sapp and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.



David Shewchuk  
Deputy General Counsel for General Law  
U.S. Patent and Trademark Office

15 May 2019

Date

on delegated authority by

Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the U.S. Patent and Trademark Office

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing Final Order was sent by first-class certified mail, return receipt requested, on this day to the Respondent's counsel:

Alexandra Mijares Nash.  
Mijares Nash, PLLC  
301 W. Warner Road, Suite 133  
Tempe, Arizona 85284

and to the OED Director via email at:

SO-OEDCases@uspto.gov

5/15/19  
Date

  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450



**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE USPTO DIRECTOR**

In the Matter of	)	
	)	
Heather A. Sapp,	)	
	)	Proceeding No. D2019-31
Respondent	)	
_____	)	

**DRAFT**  
**PROPOSED SETTLEMENT OF DISCIPLINARY MATTER  
PURSUANT TO 37 C.F.R. § 11.26**

After being fully advised, the Deputy General Counsel for Enrollment and Discipline and the Director of the Office of Enrollment and Discipline ("OED Director") for the United States Patent and Trademark Office ("USPTO" or "Office") and Heather A. Sapp ("Respondent"), by counsel, desire to settle the above-identified disciplinary proceeding without a hearing. Accordingly, pursuant to 37 C.F.R. § 11.26, the OED Director and Respondent present this Proposed Settlement Agreement ("Agreement") to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office ("USPTO Director") for approval.

**Jurisdiction**

1. At all times relevant hereto, Respondent of Tempe, Arizona, has been an attorney in good standing in the State of Arizona and, as such, is authorized to practice before the USPTO in trademark matters, *see* 37 C.F.R. § 11.14(a). Respondent is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. §§ 11.101 through 11.901.
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

**Preamble**

3. Pursuant to 37 C.F.R. § 11.26, the OED Director and Respondent jointly propose settlement of this disciplinary proceeding.
4. The parties agree that this Agreement resolves all disciplinary action by the Office against Respondent arising from the stipulated facts set forth below.
5. Respondent acknowledges that she may be subject to disciplinary action by the Office with respect to any violations of the USPTO Rules of Professional Conduct not specifically addressed in this Agreement.

6. Respondent is legally competent and freely and voluntarily enters into this Agreement and acknowledges that she is not acting under duress or coercion.
7. Respondent acknowledges that she is entitled to have a hearing conducted in accordance with the provisions of 37 C.F.R. §§ 11.32 through 11.57. Respondent hereby waives her right to any such hearing provided that the USPTO Director agrees to the terms and conditions of this Agreement.
8. Respondent acknowledges that she waives all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner.
9. Respondent is fully aware of the charges as set forth in the following stipulated facts and legal conclusions and understands the nature of these charges.
10. Respondent is fully aware of the implications of the USPTO Director accepting this Agreement. Respondent also understands and agrees that, unless the USPTO Director enters a Final Order in accord with the terms of this Agreement, the disciplinary matter has not been resolved and this Agreement is without effect.
11. The OED Director and Respondent also understand and agree that, pursuant to 37 C.F.R. § 11.26, if the USPTO Director rejects this Agreement, no reference to the offer of settlement, the contingent acceptance thereof, or the fact that the parties stipulated to facts and legal conclusions in support of this Agreement shall be admissible as evidence in any disciplinary proceeding brought against Respondent.
12. The OED Director and Respondent also understand and agree that this Agreement may be executed in counterparts, the executed counterparts may be exchanged in Portable Document Format ("PDF"), and the PDF of the executed signature page will constitute an original executed signature page.

#### **Legal Background**

13. USPTO regulations require that the person named as the signatory on an electronic trademark document to be filed with the Office personally enter his or her electronic signature on the document (*i.e.*, personally enter the combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash ("/") symbols in the signature block on the electronic submission). *See* 37 C.F.R. § 2.193(a)(2), (c), and (e).
14. The USPTO Trademark Manual of Examining Procedure ("TMEP") provides guidance to practitioners regarding the USPTO trademark electronic signature regulations:



All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a).

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Another person (e.g., paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory.

Just as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.

See TMEP § 611.01(c) (case citations omitted) (line spacing added).

#### Stipulated Facts

15. From September 1, 2016, to February 2019, Respondent was employed as a Senior Trademark Attorney and the Training and Communications Manager for LegalForce RAPC Worldwide, a law firm. Respondent represents that, although she managed the law firm's law clerks, she did not have the authority to hire or fire the law firm's non-practitioner assistants or have supervisory authority over the law firm's attorneys. Respondent worked in the law firm's Tempe, Arizona office.

16. At all relevant times, Respondent was the attorney of record before the USPTO in pending trademark applications or issued (or renewed) registrations.

17. At all relevant times, Respondent also prepared and reviewed trademark documents in pending trademark applications or issued (or renewed) registrations in which other attorneys from the law firm were the attorney of record before the USPTO.

18. Non-practitioner assistants helped Respondent in preparing and filing trademark documents filed with the USPTO. These non-practitioner assistants were located in Tempe, Arizona, and Maharashtra, India.

19. Contrary to the USPTO trademark signature regulations and guidance referenced in paragraphs 13 and 14, above, non-practitioner assistants were impermissibly signing client names to USPTO trademark filings. The filings—such as Trademark/Service Mark Statements of Use pursuant to 15 U.S.C. § 1051(d)—typically carried an important warning, such as:

*The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any*

*registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.*

20. The impermissible signature practice existed prior to Ms. Sapp's employment and continued at least until June 2018. By such time, Respondent had been directly involved, as the attorney of record or as an attorney assisting the attorney of record, in numerous impermissibly signed trademark documents filed with the USPTO.

21. Respondent represents that she first became aware in or around June 2018 that non-practitioner assistants were signing client names to trademark filings contrary to the aforementioned USPTO trademark signature regulations and TMEP guidance.

22. Respondent represents that, prior to June 2018, she did not understand adequately the USPTO trademark signature regulations and guidance referenced in paragraphs 13 and 14, above. Respondent now recognizes that, (a) as the attorney of record in pending trademark applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of the law firm's clients or (b) as an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record, she did not take reasonable and appropriate steps to ensure compliance with the signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c). Specifically, she recognizes that, in such matters, she (a) allowed non-practitioner assistants to sign trademark filings rather than having the named signatory (*i.e.*, the client) sign the filings and/or (b) did not adequately monitor or supervise non-practitioner assistants to ensure compliance with the USPTO's trademark signature rules and guidance. Respondent further recognizes that, after learning of the impermissible signature practice, she did not take steps to notify clients or the USPTO promptly about the material misrepresentations set forth in the impermissibly signed trademark filings (*e.g.* that the named declarant did not sign the declaration) for those matters where she was either (a) the attorney of record in pending trademark applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients or (b) an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record. Instead, she waited several months after learning about the impermissible signature issue to start to take such steps. Respondent represents that she raised the issue of corrective action with the firm's management in June 2018, but she was told that no action was necessary at that time. Respondent further represents that, at the time her relationship with the firm was terminated, she intended to inform the firm's clients of the impermissible signatures and the implications thereof and was taking steps to attempt to identify the affected applications and/or registrations.



#### **Additional Considerations**

23. In fourteen years of trademark law practice, Respondent has not been publicly disciplined by any state, territorial bar, state or federal court, or state or federal agency (including the USPTO).

24. Respondent has acknowledged her ethical lapses, demonstrated genuine contrition, and accepted responsibility for her acts and omissions. She understands the seriousness of allowing non-practitioner assistants to impermissibly sign others' signatures on trademark documents, including declarations, filed with and relied upon by the USPTO in examining trademark applications and issuing (or renewing) registrations. She also acknowledges the actual or potential significant adverse consequences that such impermissibly signed trademark filings may have had on clients' intellectual property rights in their pending trademark applications or issued (or renewed) registrations.

25. Respondent cooperated with OED's investigation, *e.g.*, by agreeing to a telephonic interview with Office of Enrollment and Discipline and by providing *sua sponte* informative, supplemental responses to her original responses to requests for information that clarified facts surrounding the impermissible signature practice.

26. Additionally, upon learning of the impermissible signature practice, Respondent took corrective action by way of retraining the firm's practitioners and non-practitioners to ensure future compliance with the USPTO signature regulations and guidance and by developing an internal audit team to assist with verifying and maintaining compliance.

#### **Joint Legal Conclusions**

27. Respondent acknowledges that, based on the information contained in the joint stipulated facts, above, her conduct—as either (a) the attorney of record for clients in pending trademark applications or issued (or renewed) registrations before the USPTO or as (b) an attorney who prepared and reviewed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record—violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.101 (requiring a practitioner to provide competent representation to a client) by not understanding adequately the USPTO trademark signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c);
- b. 37 C.F.R. §§ 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client) and 11.503(b) (practitioner's responsibility over non-practitioners assisting practitioner) by (i) having trademark documents filed with the USPTO where someone other than the named signatory electronically signed the documents in violation of USPTO trademark signature regulations and guidance; (ii) prior to trademark documents being filed with the



USPTO, not taking reasonable steps to learn whether non-practitioner assistants who were tasked with obtaining the signatures of the named signatories on trademark documents were impermissibly signing the documents (*e.g.*, by not monitoring the signature process or otherwise taking reasonable steps to learn whether non-practitioner assistants were actually obtaining the named signatories' respective signatures); (iii) not knowing that non-practitioner assistants were signing for the named signatories; and/or (iv) after learning of the impermissible signature practice, not promptly notifying clients about the impermissibly signed trademark filings or the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice;

- c. 37 C.F.R. §§ 11.104(a) and (b) (communications with client), after learning of the impermissible signature practice, not promptly informing clients about impermissibly signed trademark filings or the status of their pending applications and issued (or renewed) registrations in light of the impermissible signature practice; not promptly and reasonably explaining to clients the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice (*e.g.*, including whether the electronic signing of a document, including a declaration, by one other than the named signatory jeopardizes the intellectual property rights of the client); and not promptly and reasonably consulting with clients about the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice so that clients can make informed decisions regarding the representation of their trademark interests;
- d. 37 C.F.R. § 11.303(a)(1), (a)(3), (b), (d) (candor toward the USPTO) by having trademark documents, including declarations, filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and not promptly reasonably correcting the impliedly false statement of material fact after learning of the impermissibly signed filings (*e.g.*, informing the USPTO that the named signatory did not sign the document);
- e. 37 C.F.R. §§ 11.804(c) (misrepresentation) and (d) (conduct prejudicial to the USPTO trademark registration process) by (i) having trademark documents, including declarations, filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and not promptly reasonably correcting the impliedly false statement after learning of the impermissibly signed filings (*e.g.*, informing the USPTO that the named signatory did not sign the document) and (ii) by having declarations filed with the USPTO, on which the USPTO relied in examining trademark applications and issuing (or renewing) registrations, that were signed by other than the named declarant and not promptly

taking reasonable remedial measures regarding the declarations (e.g., informing the USPTO that the named signatory did not sign the document); and

- f. 37 C.F.R. § 11.804(i) (other conduct that adversely reflects on the practitioner's fitness to practice before the Office) by engaging in the acts and omissions regarding not notifying clients or the USPTO about the impermissible signature practice or the impermissibly signed filings.

#### **Agreed-Upon Sanction**

28. Based on the foregoing, the OED Director proposes, and the Respondent freely and voluntarily agrees, that the USPTO Director shall enter a Final Order that:

- a. Incorporates the substance of the joint stipulated facts set forth above;
- b. Incorporates the substance of the joint legal conclusions set forth above;
- c. Directs that Respondent be publicly reprimanded;
- d. Directs that Respondent be placed on probation for one year beginning with the date of the Final Order;
- e. Directs that:

(1) if the OED Director is of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

(A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending the Respondent for up to twelve (12) months for the violations set forth in the Joint Legal Conclusions, above;

(B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director;

(C) grant Respondent fifteen (15) days to respond to the Order to Show Cause; and

(2) in the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with the USPTO Rules of Professional Conduct, the OED Director shall:

(A) deliver to the USPTO Director: (i) the Order to Show Cause; (ii)



Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence supporting the OED Director's position; and

(B) request that the USPTO Director enter an order immediately suspending Respondent for up to twelve (12) months for the violations set forth in the Joint Legal Conclusions above;

- f. Directs that nothing herein shall prevent the OED Director from seeking discrete discipline for any misconduct that formed the basis for an Order to Show Cause issued pursuant to the preceding subparagraph;
- g. Directs that, in the event the Respondent seeks a review of any action taken pursuant to subparagraph e., above, such review shall not operate to postpone or otherwise hold in abeyance the suspension;
- h. Directs that the OED Director electronically publish the Final Order at the OED'S electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- i. Directs that the OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

**Notice of Public Reprimand and Probation**

This notice concerns non-registered practitioner, Heather A. Sapp of Tempe, Arizona, who is hereby publicly reprimanded and placed on probation for twelve (12) months for violating 37 C.F.R. §§ 11.101; 11.103; 11.104 (a) and (b); 11.303(a)(1), (a)(3), (b) and (d); 11.503; 11.804(c); 11.804(d); and 11.804(i). The violations are predicated on non-practitioner assistants electronically signing numerous USPTO trademark filings on behalf of the named signatories in violation of the USPTO trademark electronic signature regulations and guidance in trademark matters where Ms. Sapp was either the attorney of record or the attorney who prepared, reviewed, and/or caused to be filed trademark documents where another attorney was the attorney of record. Ms. Sapp is permitted to practice before the Office in trademark and other non-patent matters during her probationary period unless she is subsequently suspended by order of the USPTO Director.

Between September 1, 2016, and February 2019, Ms. Sapp, was a trademark attorney employed by LegalForce RAPC Worldwide. Prior to her employment and until at least June 2018, non-practitioner assistants were signing client names to USPTO trademark filings in violation of USPTO trademark signature regulations and guidance. Ms. Sapp represents that she first became aware in or around June 2018 that non-



practitioners were signing documents to be filed with the USPTO. Ms. Sapp further represents that, while representing clients in trademark matters before the USPTO, she did not understand adequately the USPTO trademark signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c). Consequently, during this time period, Ms. Sapp, in her capacity as (a) the attorney of record in pending trademark applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients and (b) an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record, did not take reasonable and appropriate steps to ensure compliance with the USPTO trademark signature requirements or guidance. Ms. Sapp was directly involved in USPTO trademark filings such that she (i) had trademark documents filed with the USPTO where non-practitioner assistants signed the documents, including declarations, instead of the named signatory; (ii) prior to trademark documents being filed with the USPTO, did not take reasonable steps to learn whether non-practitioner assistants were signing the documents in compliance with USPTO signature regulations and guidance (*e.g.*, she did not monitor the signature process or otherwise take reasonable steps to learn whether non-practitioner assistants were actually obtaining the named signatories' respective signatures); (iii) after learning of the impermissible signature practice, did not promptly notify clients about impermissibly signed trademark filings or the legal status of their pending applications and issued (or renewed) registrations in light of the impermissible signature practice, did not promptly and reasonably explain to clients about the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice (*e.g.*, including whether the electronic signing of a document, including a declaration, by one other than the named signatory jeopardizes the intellectual property rights of the client), and did not promptly and reasonably consult with clients regarding the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice so that clients can make informed decisions regarding the representation of their trademark interests; (iv) after learning of the impermissible signature practice, did not promptly notify the USPTO about the impermissibly signed trademark filings; (v) having trademark documents filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and did not promptly reasonably correct the impliedly false statement after learning of the impermissibly signed trademark filings (*e.g.*, informing the

USPTO that the named signatory did not sign the document); and (vi) having declarations filed with the USPTO, on which the USPTO relied in examining trademark applications and issuing (or renewing) registrations, that were signed by other than the named declarant, and did not promptly take reasonable remedial measures regarding the declarations (*e.g.*, informing the USPTO that the named signatory did not sign the document). Ms. Sapp represents that she raised the issue of corrective action with the firm's management in June 2018, but she was told that no action was necessary at that time. Ms. Sapp further represents that, at the time her relationship with the firm was terminated, she intended to inform the firm's clients of the impermissible signatures and the implications thereof and was taking steps to attempt to identify the affected applications and/or registrations.

Ms. Sapp has acknowledged her ethical lapses, demonstrated genuine contrition, and accepted responsibility for her conduct. Moreover, Ms. Sapp cooperated with OED's investigation, *e.g.*, by agreeing to a telephonic interview with Office of Enrollment and Discipline and by providing informative, supplemental responses to her original responses to requests for information that clarified how signatures were entered on USPTO trademark filings.

USPTO trademark signature regulations require that a proper person sign a trademark document and that the person named as the signatory on the document be the one who enters his or her electronic signature on the document (*i.e.*, personally enter the combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash ("/") symbols in the signature block on the electronic submission). See 37 C.F.R. § 2.193(a)(2), (c) and (e).

The USPTO Trademark Manual of Examining Procedure ("TMEP") provides straightforward guidance regarding the USPTO trademark electronic signature regulations:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a).

The person(s) identified as the signatory must manually enter the elements of the electronic signature.

Another person (*e.g.*, paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory.

Just as signing the name of another person on paper does not



serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.

*See* TMEP § 611.01(c) (case citations omitted) (line spacing added).

Practitioners may delegate tasks to non-practitioner paraprofessionals and other non-practitioner assistants. But where a task is so delegated, the practitioner is to supervise adequately the non-practitioner, including giving appropriate instruction and monitoring the non-practitioners' activities. As in this matter, a practitioner may be disciplined for failing to take reasonable steps to supervise their paraprofessionals and other non-practitioner assistants.

Practitioners who represent trademark applicants before the USPTO have an ethical obligation to provide competent representation to a client, which includes the legal knowledge, skill, thoroughness, and preparation reasonably necessary for the representation. *See generally* 37 C.F.R. § 11.101. Accordingly, practitioners who represent trademark applicants before the USPTO in trademark matters are reasonably expected to be knowledgeable of USPTO regulations and guidance pertaining to electronically signing trademark applications and other trademark documents with the Office, including the regulations cited in, and guidance provided under, TMEP § 611.01(c).

Under 37 C.F.R. § 11.104, practitioners who represent trademark applicants before the USPTO have an ethical obligation to reasonably consult with the client about the means by which the client's objectives are to be accomplished (*e.g.*, who is authorized to electronically sign documents, including declarations, filed with the USPTO on behalf of a client), to keep the client reasonably informed about the status of the matter (*e.g.*, who electronically signed documents, including declarations, filed with the USPTO on behalf of the client), to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation (*e.g.*, whether the electronic signing of a document, including a declaration, by other than the named signatory may jeopardize the intellectual property rights of any issued trademark registration where the USPTO relied on an impermissibly signed declaration filed with the USPTO during its examination of the client's trademark application or when renewing a registration), and to consult with the client about any relevant limitation on the practitioner's conduct when the practitioner knows that the client

expects assistance not permitted by the USPTO Rules of Professional Conduct or other law (*e.g.*, 37 C.F.R. § 2.193).

Practitioners who represent trademark applicants before the USPTO “shall not knowingly . . . [m]ake a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner,” which includes, *e.g.*, a declaration not signed by the named signatory.

37 C.F.R. § 11.303(a)(1). “If a practitioner, the practitioner’s client, or a witness called by the practitioner, has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the [USPTO].” 37 C.F.R. § 11.303(a)(3). Practitioners also have the obligation to disclose to the USPTO that a person is engaging in or has engaged in fraudulent conduct relating to the examination of the practitioner’s client’s trademark application or renewal of registration and to take reasonable remedial measures. *See generally* 37 C.F.R. § 11.303(b). Compliance with § 11.303(a)(1), (a)(3), and (b) is required even if compliance requires disclosure of information or evidence otherwise protected by 37 C.F.R. § 11.106. *See generally* 37 C.F.R. § 11.303(d). Similar ethical obligations are found under 37 C.F.R. § 11.401.

Practitioners who represent trademark applicants before the USPTO have an ethical obligation to the USPTO not to engage in conduct prejudicial to the administration of justice and not to engage in conduct involving misrepresentation. *See generally* 37 C.F.R. § 11.804(d) and 37 C.F.R. § 11.804(c). Accordingly, practitioners who represent trademark applicants before the USPTO are reasonably expected not to file, or allow to be filed, declarations that are not signed by the named signatory. Trademark filings bearing declarations—such as a TEAS Plus Application, a Trademark/Service Mark Statement of Use pursuant to 15 U.S.C. § 1051(d) and a Combined Declaration of Use and Incontestability Under Sections 8 and 15—are relied upon by the USPTO when examining trademark applications, registering marks, and renewing registrations. When such filings are impermissibly signed and filed with the USPTO, the integrity of the federal trademark registration process is adversely affected. If signed by a person determined to be an unauthorized signatory, a resulting registration may be invalid.

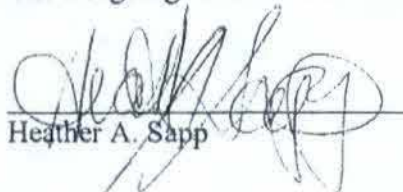
This action is the result of a settlement agreement between Ms. Sapp and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions



involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at:  
<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- j. Directs that nothing in this Agreement or the Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office and (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf.
- k. Directs that Respondent waive all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner; and
- l. Directs that each party shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and any Final Order.

The foregoing is understood and agreed to by:

  
Heather A. Sapp

5/13/19  
Date

  
William R. Covey

Deputy General Counsel for Enrollment and Discipline and  
Director of the Office of Enrollment and Discipline

14 May 2019  
Date

# EXHIBIT 6

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE USPTO DIRECTOR**

In the Matter of )  
 )  
Heather A. Sapp, )  
 )  
Respondent )  
\_\_\_\_\_ )

Proceeding No. D2019-31

**FINAL ORDER PURSUANT TO 37 C.F.R. § 11.26**

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Heather A. Sapp (“Respondent”), by counsel, have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ joint stipulated facts, joint legal conclusions, and agreed-upon sanctions found in the Agreement.

**Jurisdiction**

1. At all times relevant Respondent of Tempe, Arizona, has been an attorney in good standing in the State of Arizona engaged in practice before the Office in trademark matters pursuant to 37 C.F.R. § 11.14(a). Therefore, Respondent is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. §§ 11.101 through 11.901.
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

**Legal Background**

3. USPTO regulations require that the person named as the signatory on an electronic trademark document to be filed with the Office personally enter his or her electronic signature on the document (*i.e.*, personally enter the combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission). *See* 37 C.F.R. § 2.193(a)(2), (c), and (e).
4. The USPTO Trademark Manual of Examining Procedure (“TMEP”) provides guidance to practitioners regarding the USPTO trademark electronic signature regulations:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a).

The person(s) identified as the signatory must manually enter the elements of the electronic signature.

Another person (*e.g.*, paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory.

Just as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.

*See* TMEP § 611.01(c) (case citations omitted) (line spacing added).

### **Joint Stipulated Facts**

5. From September 1, 2016, to February 2019, Respondent was employed as a Senior Trademark Attorney and the Training and Communications Manager for LegalForce RAPC Worldwide, a law firm. Respondent represents that, although she managed the law firm's law clerks, she did not have the authority to hire or fire the law firm's non-practitioner assistants or have supervisory authority over the law firm's attorneys. Respondent worked in the law firm's Tempe, Arizona office.

6. At all relevant times, Respondent was the attorney of record before the USPTO in pending trademark applications or issued (or renewed) registrations.

7. At all relevant times, Respondent also prepared and reviewed trademark documents in pending trademark applications or issued (or renewed) registrations in which other attorneys from the law firm were the attorney of record before the USPTO.

8. Non-practitioner assistants helped Respondent in preparing and filing trademark documents filed with the USPTO. These non-practitioner assistants were located in Tempe, Arizona, and Maharashtra, India.

9. Contrary to the USPTO trademark signature regulations and guidance referenced in paragraphs 3 and 4, above, non-practitioner assistants were impermissibly signing client names to USPTO trademark filings. The filings—such as Trademark/Service Mark Statements of Use pursuant to 15 U.S.C. § 1051(d)—typically carried an important warning, such as:

*The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of*



*his/her own knowledge are true and all statements made on information and belief are believed to be true.*

10. The impermissible signature practice existed prior to Ms. Sapp's employment and continued at least until June 2018. By such time, Respondent had been directly involved, as the attorney of record or as an attorney assisting the attorney of record, in numerous impermissibly signed trademark documents filed with the USPTO.

11. Respondent represents that she first became aware in or around June 2018 that non-practitioner assistants were signing client names to trademark filings contrary to the aforementioned USPTO trademark signature regulations and TMEP guidance.

12. Respondent represents that, prior to June 2018, she did not understand adequately the USPTO trademark signature regulations and guidance referenced in paragraphs 3 and 4, above. Respondent now recognizes that (a) as the attorney of record in pending trademark applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of the law firm's clients or (b) as an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record, she did not take reasonable and appropriate steps to ensure compliance with the signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c). Specifically, she recognizes that, in such matters, she (a) allowed non-practitioner assistants to sign trademark filings rather than having the named signatory (*i.e.*, the client) sign the filings and/or (b) did not adequately monitor or supervise non-practitioner assistants to ensure compliance with the USPTO's trademark signature rules and guidance. Respondent further recognizes that, after learning of the impermissible signature practice, she did not take steps to notify clients or the USPTO promptly about the material misrepresentations set forth in the impermissibly signed trademark filings (*e.g.* that the named declarant did not sign the declaration) for those matters where she was either (a) the attorney of record in pending trademark applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients or (b) an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record. Instead, she waited several months after learning about the impermissible signature issue to start to take such steps. Respondent represents that she raised the issue of corrective action with the firm's management in June 2018, but she was told that no action was necessary at that time. Respondent further represents that, at the time her relationship with the firm was terminated, she intended to inform the firm's clients of the impermissible signatures and the implications thereof and was taking steps to attempt to identify the affected applications and/or registrations.

### **Additional Considerations**

13. In fourteen years of trademark law practice, Respondent has not been publicly disciplined by any state, territorial bar, state or federal court, or state or federal agency (including the USPTO).

14. Respondent has acknowledged her ethical lapses, demonstrated genuine contrition, and accepted responsibility for her acts and omissions. She understands the seriousness of allowing non-practitioner assistants to impermissibly sign others' signatures on trademark documents, including declarations, filed with and relied upon by the USPTO in examining trademark applications and issuing (or renewing) registrations. She also acknowledges the actual or potential significant adverse consequences that such impermissibly signed trademark filings may have had on clients' intellectual property rights in their pending trademark applications or issued (or renewed) registrations.

15. Respondent cooperated with OED's investigation, *e.g.*, by agreeing to a telephonic interview with Office of Enrollment and Discipline and by providing *sua sponte* informative, supplemental responses to her original responses to requests for information that clarified facts surrounding the impermissible signature practice.

16. Additionally, upon learning of the impermissible signature practice, Respondent took corrective action by way of retraining the firm's practitioners and non-practitioners to ensure future compliance with the USPTO signature regulations and guidance and by developing an internal audit team to assist with verifying and maintaining compliance.

### **Joint Legal Conclusions**

17. Respondent acknowledges that, based on the information contained in the joint stipulated facts, above, her conduct—as either (a) the attorney of record for clients in pending trademark applications or issued (or renewed) registrations before the USPTO or as (b) an attorney who prepared and reviewed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record—violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.101 (requiring a practitioner to provide competent representation to a client) by not understanding adequately the USPTO trademark signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c);
- b. 37 C.F.R. §§ 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client) and 11.503(b) (practitioner's responsibility over non-practitioners assisting practitioner) by (i) having trademark documents filed with the USPTO where someone other than the named signatory electronically signed the documents in violation of USPTO trademark signature regulations and guidance; (ii) prior to trademark documents being filed with the USPTO, not taking reasonable steps to learn whether non-practitioner assistants



who were tasked with obtaining the signatures of the named signatories on trademark documents were impermissibly signing the documents (*e.g.*, by not monitoring the signature process or otherwise taking reasonable steps to learn whether non-practitioner assistants were actually obtaining the named signatories' respective signatures); (iii) not knowing that non-practitioner assistants were signing for the named signatories; and/or (iv) after learning of the impermissible signature practice, not promptly notifying clients about the impermissibly signed trademark filings or the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice;

- c. 37 C.F.R. §§ 11.104(a) and (b) (communications with client), after learning of the impermissible signature practice, by (i) not promptly informing clients about impermissibly signed trademark filings or the status of their pending applications and issued (or renewed) registrations in light of the impermissible signature practice; (ii) not promptly and reasonably explaining to clients the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice (*e.g.*, including whether the electronic signing of a document, including a declaration, by one other than the named signatory jeopardizes the intellectual property rights of the client); and (iii) not promptly and reasonably consulting with clients about the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice so that clients can make informed decisions regarding the representation of their trademark interests;
- d. 37 C.F.R. §§ 11.303(a)(1), (a)(3), (b), (d) (candor toward the USPTO) by having trademark documents, including declarations, filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and not promptly reasonably correcting the impliedly false statement of material fact after learning of the impermissibly signed filings (*e.g.*, informing the USPTO that the named signatory did not sign the document);
- e. 37 C.F.R. §§ 11.804(c) (misrepresentation) and (d) (conduct prejudicial to the USPTO trademark registration process) by (i) having trademark documents, including declarations, filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and not promptly reasonably correcting the impliedly false statement after learning of the impermissibly signed filings (*e.g.*, informing the USPTO that the named signatory did not sign the document) and (ii) having declarations filed with the USPTO, on which the USPTO relied in examining trademark applications and issuing (or renewing) registrations, that were signed by other than the named declarant and not promptly taking reasonable remedial measures regarding the declarations (*e.g.*, informing the USPTO that the named signatory did not sign the document); and



- f. 37 C.F.R. § 11.804(i) (other conduct that adversely reflects on the practitioner's fitness to practice before the Office) by engaging in the acts and omissions regarding not notifying clients or the USPTO about the impermissible signature practice or the impermissibly signed filings.

**Agreed-Upon Sanction**

18. Respondent freely and voluntarily agrees, and it is hereby ORDERED that:

- a. Respondent be, and hereby is, publicly reprimanded;
- b. Respondent shall be placed on probation for one year beginning with the date of the Final Order;
- c. Respondent shall be permitted to practice before the USPTO in trademark and other non-patent matters during her probationary period, unless her probation is revoked and she is suspended by order of the USPTO Director or otherwise no longer has the authority to practice before the USPTO;
- d. (1) if the OED Director is of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the USPTO Rules of Professional Conduct, the OED Director shall:
  - (A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending the Respondent for up to twelve (12) months for the violations set forth in the Joint Legal Conclusions, above;
  - (B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director;
  - (C) grant Respondent fifteen (15) days to respond to the Order to Show Cause; and
- (2) in the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with the USPTO Rules of Professional Conduct, the OED Director shall:
  - (A) deliver to the USPTO Director: (i) the Order to Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence supporting the OED Director's position; and
  - (B) request that the USPTO Director enter an order immediately suspending Respondent for up to twelve (12) months for the violations set forth in the

Joint Legal Conclusions above;

- e. Nothing herein shall prevent the OED Director from seeking discrete discipline for any misconduct that formed the basis for an Order to Show Cause issued pursuant to the preceding subparagraph;
- f. In the event the Respondent seeks a review of any action taken pursuant to subparagraph d., above, such review shall not operate to postpone or otherwise hold in abeyance the suspension;
- g. The OED Director shall electronically publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- h. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

**Notice of Public Reprimand and Probation**

This notice concerns non-registered practitioner, Heather A. Sapp of Tempe, Arizona, who is hereby publicly reprimanded and placed on probation for twelve (12) months for violating 37 C.F.R. §§ 11.101; 11.103; 11.104 (a) and (b); 11.303(a)(1), (a)(3), (b) and (d); 11.503(b); 11.804(c); 11.804(d); and 11.804(i). The violations are predicated on non-practitioner assistants electronically signing numerous USPTO trademark filings on behalf of the named signatories in violation of the USPTO trademark electronic signature regulations and guidance in trademark matters where Ms. Sapp was either the attorney of record or the attorney who prepared, reviewed, and/or caused to be filed trademark documents where another attorney was the attorney of record. Ms. Sapp is permitted to practice before the Office in trademark and other non-patent matters during her probationary period unless she is subsequently suspended by order of the USPTO Director.

Between September 1, 2016, and February 2019, Ms. Sapp was a trademark attorney employed by LegalForce RAPC Worldwide. Prior to her employment and until at least June 2018, non-practitioner assistants were signing client names to USPTO trademark filings in violation of USPTO trademark signature regulations and guidance. Ms. Sapp represents that she first became aware in or around June 2018 that non-practitioners were signing documents to be filed with the USPTO. Ms. Sapp further represents that, while representing clients in trademark matters before the USPTO, she did not understand adequately the USPTO trademark signature requirements of 37 C.F.R. § 2.193 or the guidance set forth in TMEP § 611.01(c). Consequently, during this time period, Ms. Sapp, in her capacity as (a) the attorney of record in pending trademark



applications or issued (or renewed) registrations before the USPTO in which she prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients and (b) an attorney who prepared, reviewed, and/or caused to be filed trademark documents on behalf of clients in pending trademark applications or issued (or renewed) registrations before the USPTO in which other attorneys from the law firm were the attorney of record, did not take reasonable and appropriate steps to ensure compliance with the USPTO trademark signature requirements or guidance. Ms. Sapp was directly involved in USPTO trademark filings such that she (i) had trademark documents filed with the USPTO where non-practitioner assistants signed the documents, including declarations, instead of the named signatory; (ii) prior to trademark documents being filed with the USPTO, did not take reasonable steps to learn whether non-practitioner assistants were signing the documents in compliance with USPTO signature regulations and guidance (*e.g.*, she did not monitor the signature process or otherwise take reasonable steps to learn whether non-practitioner assistants were actually obtaining the named signatories' respective signatures); (iii) after learning of the impermissible signature practice, did not promptly notify clients about impermissibly signed trademark filings or the legal status of their pending applications and issued (or renewed) registrations in light of the impermissible signature practice, did not promptly and reasonably explain to clients about the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice (*e.g.*, including whether the electronic signing of a document, including a declaration, by one other than the named signatory jeopardizes the intellectual property rights of the client), and did not promptly and reasonably consult with clients regarding the actual or potential adverse consequences to the clients' pending applications or issued (or renewed) registrations arising from the impermissible signature practice so that clients can make informed decisions regarding the representation of their trademark interests; (iv) after learning of the impermissible signature practice, did not promptly notify the USPTO about the impermissibly signed trademark filings; (v) having trademark documents filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and did not promptly reasonably correct the impliedly false statement after learning of the impermissibly signed trademark filings (*e.g.*, informing the USPTO that the named signatory did not sign the document); and (vi) having declarations filed with the USPTO, on which the USPTO relied in examining trademark applications and issuing (or renewing) registrations, that were signed by other than the named declarant, and did not promptly take reasonable remedial measures regarding the declarations (*e.g.*, informing the USPTO that the named signatory did not sign the document). Ms. Sapp represents that she raised the issue of corrective



action with the firm's management in June 2018, but she was told that no action was necessary at that time. Ms. Sapp further represents that, at the time her relationship with the firm was terminated, she intended to inform the firm's clients of the impermissible signatures and the implications thereof and was taking steps to attempt to identify the affected applications and/or registrations.

Ms. Sapp has acknowledged her ethical lapses, demonstrated genuine contrition, and accepted responsibility for her conduct. Moreover, Ms. Sapp cooperated with OED's investigation, *e.g.*, by agreeing to a telephonic interview with Office of Enrollment and Discipline and by providing informative, supplemental responses to her original responses to requests for information that clarified how signatures were entered on USPTO trademark filings.

USPTO trademark signature regulations require that a proper person sign a trademark document and that the person named as the signatory on the document be the one who enters his or her electronic signature on the document (*i.e.*, personally enter the combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash ("/") symbols in the signature block on the electronic submission). *See* 37 C.F.R. § 2.193(a)(2), (c) and (e).

The USPTO Trademark Manual of Examining Procedure ("TMEP") provides straightforward guidance regarding the USPTO trademark electronic signature regulations:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a).

The person(s) identified as the signatory must manually enter the elements of the electronic signature.

Another person (*e.g.*, paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory.

Just as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.

*See* TMEP § 611.01(c) (case citations omitted) (line spacing added).

Practitioners may delegate tasks to non-practitioner paraprofessionals and other non-practitioner assistants. But where a

task is so delegated, the practitioner is to supervise adequately the non-practitioner, including giving appropriate instruction and monitoring the non-practitioners' activities. As in this matter, a practitioner may be disciplined for failing to take reasonable steps to supervise their paraprofessionals and other non-practitioner assistants.

Practitioners who represent trademark applicants before the USPTO have an ethical obligation to provide competent representation to a client, which includes the legal knowledge, skill, thoroughness, and preparation reasonably necessary for the representation. *See generally* 37 C.F.R. § 11.101. Accordingly, practitioners who represent trademark applicants before the USPTO in trademark matters are reasonably expected to be knowledgeable of USPTO regulations and guidance pertaining to electronically signing trademark applications and other trademark documents with the Office, including the regulations cited in, and guidance provided under, TMEP § 611.01(c).

Under 37 C.F.R. § 11.104, practitioners who represent trademark applicants before the USPTO have an ethical obligation to reasonably consult with the client about the means by which the client's objectives are to be accomplished (*e.g.*, who is authorized to electronically sign documents, including declarations, filed with the USPTO on behalf of a client), to keep the client reasonably informed about the status of the matter (*e.g.*, who electronically signed documents, including declarations, filed with the USPTO on behalf of the client), to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation (*e.g.*, whether the electronic signing of a document, including a declaration, by other than the named signatory may jeopardize the intellectual property rights of any issued trademark registration where the USPTO relied on an impermissibly signed declaration filed with the USPTO during its examination of the client's trademark application or when renewing a registration), and to consult with the client about any relevant limitation on the practitioner's conduct when the practitioner knows that the client expects assistance not permitted by the USPTO Rules of Professional Conduct or other law (*e.g.*, 37 C.F.R. § 2.193).

Practitioners who represent trademark applicants before the USPTO "shall not knowingly . . . [m]ake a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner," which includes, *e.g.*, a declaration not signed by the named signatory. 37 C.F.R. § 11.303(a)(1). "If a practitioner, the practitioner's client,



or a witness called by the practitioner, has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the [USPTO].” 37 C.F.R. § 11.303(a)(3). Practitioners also have the obligation to disclose to the USPTO that a person is engaging in or has engaged in fraudulent conduct relating to the examination of the practitioner’s client’s trademark application or renewal of registration and to take reasonable remedial measures. *See generally* 37 C.F.R. § 11.303(b). Compliance with § 11.303(a)(1), (a)(3), and (b) is required even if compliance requires disclosure of information or evidence otherwise protected by 37 C.F.R. § 11.106. *See generally* 37 C.F.R. § 11.303(d). Similar ethical obligations are found under 37 C.F.R. § 11.401.

Practitioners who represent trademark applicants before the USPTO have an ethical obligation to the USPTO not to engage in conduct prejudicial to the administration of justice and not to engage in conduct involving misrepresentation. *See generally* 37 C.F.R. § 11.804(d) and 37 C.F.R. § 11.804(e). Accordingly, practitioners who represent trademark applicants before the USPTO are reasonably expected not to file, or allow to be filed, declarations that are not signed by the named signatory. Trademark filings bearing declarations—such as a TEAS Plus Application, a Trademark/Service Mark Statement of Use pursuant to 15 U.S.C. § 1051(d) and a Combined Declaration of Use and Incontestability Under Sections 8 and 15—are relied upon by the USPTO when examining trademark applications, registering marks, and renewing registrations. When such filings are impermissibly signed and filed with the USPTO, the integrity of the federal trademark registration process is adversely affected. If signed by a person determined to be an unauthorized signatory, a resulting registration may be invalid.

This action is the result of a settlement agreement between Ms. Sapp and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: [http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp](http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp;);

- i. Nothing shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office and (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent’s behalf.



- j. Respondent waives all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner; and
- k. Each party shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and any Final Order.



David Shewchuk  
Deputy General Counsel for General Law  
U.S. Patent and Trademark Office

15 May 2019

Date

on delegated authority by

Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the U.S. Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline

Heather A. Sapp  
c/o Alexandra Mijares Nash  
Mijares Nash, PLLC  
301 W. Warner Road, Suite 133  
Tempe, Arizona 85284  
*Counsel for Respondent*

# EXHIBIT 7



Raj Abhyanker &lt;raj@legalforcelaw.com&gt;

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## Mediation request & FOIA Appeal, F-19-00197

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**Raj Abhyanker** <raj@legalforcelaw.com>

Mon, Jun 24, 2019 at 6:55 PM

To: ogis@nara.gov, "Boston, Louis" <Louis.Boston@uspto.gov>, LitigationSupport <lit-support@legalforcelaw.com>, Managers <managers@legalforcelaw.com>

Dear OGIS,

I would like to appeal the above referenced FOIA decision in F-19-00197, on the grounds laid for this request, and would like to request mediation.

I also left a voice message for Mr. Boston at the USPTO, whose number 571-272-9585 was provided in the final letter. Please let me know the next steps.

--

**Raj Abhyanker**  
Partner



call: 1-650-390-6461  
email: [raj@legalforcelaw.com](mailto:raj@legalforcelaw.com)  
web: <http://www.legalforcelaw.com/raj-v-abhyanker/>  
connect: <https://www.linkedin.com/in/rajthelawyer/>



LegalForce RAPC Worldwide  
Professional Law Corporation  
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Mountain View, CA 94040 United States

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About **LegalForce RAPC Worldwide** - LegalForce RAPC Worldwide is a leading general practice law firm specializing in serving the diverse needs of individuals, businesses, and institutions worldwide. The firm created the [Trademarkia.com](http://Trademarkia.com) website.

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8/3/2019

Case 3:19-cv-05995-WHA Document 1-1 Filed 09/23/19 Page 61 of 207



HeatherFOIA-Appeal.pdf  
510K

# EXHIBIT 8



June 24, 2019

*Via Postal Mail*

David Shewchuk, Esq.  
Deputy General Counsel for General Law  
Office of the General Counsel  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Re: Appeal of Freedom of Information Act Request No. F-19-00197**

Dear Mr. Shewchuk:

This letter serves as a formal appeal of United States Patent and Trademark Office ("USPTO") Freedom of Information Act ("FOIA") Request Number F-19-00197 (the "FOIA Request").

**ORIGINAL FOIA REQUEST**

Briefly, by letter dated May 22, 2019, the undersigned requested, on behalf of LegalForce RAPC Worldwide, P.C. ("LegalForce"), a copy of:

1. Any and all Request for Information (RFI's) sent by the USPTO Office of Enrollment and Discipline to Heather A. Sapp or her counsel leading to the Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.

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2. Any and all responses submitted by Heather A. Sapp either directly or through counsel leading to the Final Order D2019-31 including, but not limited to, that associated with OED investigation file G3493.
3. Any and all notes from interviews conducted in person with Heather A. Sapp and/or her attorney that are not governed under any settlement privilege in to the Proceeding No. D2019-31 including but not limited to, any 11.22 meeting notes associated with OED investigation file G3493.
4. Any and all declarations, affidavits, or statements of facts received or taken by OED from Heather A. Sapp aby the USPTO in their investigation leading to the Final Order in Proceeding No.D2019-31 including, but not limited to, that associated with OED investigation file G3493.

By letter dated May 29, 2019, the USPTO notified LegalForce that it would incur an estimated charge of \$3,017.28 for “estimated search time of approximately 26 hours (various GS level employees and 1 SL) and estimated review time of approximately 10 hours for the FOIA Specialist and 5 hours for the FOIA Officer.” LegalForce immediately remitted payment. By letter dated June 24, 2019, the USPTO issued a formal response providing zero (0) documents responsive to paragraph 1-4.

### **EXCESSIVE FEE**

LegalForce takes issue with propriety of the estimated fee, especially in light of the computerized nature of the Deposit Account system in the USPTO Office of Finance. USPTO FOIA regulations limit computerized search time to the “[a]ctual direct cost, including operator time.” See 37 CFR § 102.11(c)(2). Additionally, as LegalForce plans to use the data for noncommercial purposes on the blog of the undersigned, the FOIA fees should have been limited to only duplication. See 37 CFR § 102.11(c)(1); *see also Forest Guardians v. DOI*, 416 F.3d 1173, 1180 (10th Cir. 2005) (requester's

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website using requested records was sufficient for dissemination provision of fee waiver). At the very least, the first two hours of search should have been included at no charge under the non-commercial all other requesters provision. See 37 CFR § 102.11(c)(1). Therefore, LegalForce formally appeals the imposition of an excessive fee, and requests a breakdown of: (1) all searches performed regarding paragraph 1; (2) the name and GS level of each employee performing the search; and (3) any communications regarding the results of such search, including the raw results of the search.

**PUBLIC INTEREST IS SERVED RENDERING APPLICATION  
OF EXEMPTION (b)(6) INAPPLICABLE**

The letter of June 24, 2019 states that "USPTO has identified voluminous documents that are responsive to your request. Of those documents, nineteen pages are released in full and are included herein. The remaining documents were withheld in full pursuant to Exemption (b)(6) of the FOIA." The only "nineteen pages" produced are the final order and a draft version of the Final Order. The requested information does not seek to reveal the operations or activities of the federal government.

In contrast, the requested documents seek information that provide a means for LegalForce to protect the rights and take corrective action necessary to address any and all issues caused by the alleged improper signatures of trademark applications for small businesses and individuals represented by LegalForce. For this reason alone, there are strong public interests for the release of the requested information.

Moreover, there is strong public interest in hearing about the matters covered in these requests. In fact, one of the most popular IP Blogs, the PatentlyO blog recently

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wrote an article on the issues of the requested documents related to Sapp here :  
<https://patentlyo.com/hricik/2019/06/disciplines-personally-documents.html>

Notwithstanding this, Sapp was a former USPTO trademark examining attorney with over a decade of experience at the USPTO prior to LegalForce. To the extent that Sapp may have followed incorrect protocols, procedures, and policies promulgated by the USPTO, it is in the strong public interest to ensure that an agency of the federal government properly trained its employees and trademark examining attorneys with proper signature rules on trademark applications before they enter private practice. For at least the above reasons, there are strong public policy reasons to override any claims of exemptions under (b)(6).

Specifically, disclosure of the requested documents will most certainly help “shed light or contribute significantly to public understanding of the operations or activities of the USPTO” given Sapp’s senior status at the USPTO with over a decade of experience. Among the relevant years of experience that Sapp had with respect to the FOIA issues sought include Sapp’s more than one decade from 2005 to 2015 at the USPTO where she never properly learned signature rules apparently while at the same time :

- Examine and prosecute Trademark applications in a wide variety of fields.
- Conduct trademark searches to determine likelihood of confusion.
- Review trademark applications to determine registrability.
- Adept at crafting identifications of goods and services.
- Write Office Actions raising substantive or procedural objections on behalf of the Office.
- Represent the Office in appeals to the Trademark Trial and Appeal Board (TTAB). 100% affirmance rate by the Board.
- Have reviewed more than 13,000 applications over the course of more than a decade.

See Exhibit A.

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Attached as **Exhibit A** is a true and correct copy of Sapp's resume provided to LegalForce showing and describing her extensive experience at the USPTO on which light will be shed through a complete response to a FOIA appeal.

### **FAILURE TO PROPERLY SEARCH**

LegalForce also appeals the failure of the USPTO to return results related to paragraph 1-4. As you are aware, USPTO FOIA regulations contemplate that "[r]ecords under FOIA include all Government records, regardless of format, medium or physical characteristics, and include electronic records and information, audiotapes, videotapes, and photographs." See 37 CFR § 102.3(a) (emphasis added).

The USPTO charged LegalForce \$3,017.28 for a search which apparently revealed numerous responsive documents. However, none of these documents were produced to LegalForce, except for largely documents already available on the FOIA reading room. The only excuse provided was the dubious claim of exception under (b)(6), despite the very strong public interest.

Therefore, LegalForce formally appeals the inadequate search, and requests that a full search be performed, along with a breakdown of: (1) all searches performed regarding paragraphs 1-4, any communications regarding the results of such search, including the raw results of the search.

Thank you for your attention to this important matter.

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Respectfully submitted,

A handwritten signature in blue ink, appearing to be 'Raj Abhyanker', written in a cursive style.

Raj Abhyanker, Esq.

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# EXHIBIT A



## **HEATHER A. SAPP**

703-405-6827 (cell)  
571-272-8809 (work)  
heatheramandasapp@gmail.com

### **INTELLECTUAL PROPERTY EXPERIENCE**

#### **UNITED STATES PATENT & TRADEMARK OFFICE, Alexandria, VA**

September 2005-present

*Attorney Advisor (Trademark Examining Attorney)*

- Examine and prosecute Trademark applications in a wide variety of fields.
- Conduct trademark searches to determine likelihood of confusion.
- Review trademark applications to determine registrability.
- Adept at crafting identifications of goods and services.
- Write Office Actions raising substantive or procedural objections on behalf of the Office.
- Represent the Office in appeals to the Trademark Trial and Appeal Board (TTAB). *100% affirmance rate by the Board.*
- Have reviewed more than 13,000 applications over the course of more than a decade.

#### **UNITED STATES HOUSE OF REPRESENTATIVES, COMMITTEE ON THE JUDICIARY; SUBCOMMITTEE ON COURTS, THE INTERNET, & INTELLECTUAL PROPERTY**

May 2005-September 2005

*Legal Fellow*

- Researched and drafted legal memoranda, policy statements, and floor speeches for Congressman Howard Berman, then the Ranking Member of the IP Subcommittee.
- Met with constituents, interest groups, and Members of Congress to assist in negotiating solutions to legislative problems regarding intellectual property.
- Staffed hearings as counsel to the Congressman, advising him on a host of issues.
- Drafted legislation on copyright and patent issues.
- Invited witnesses to testify at legislative hearings.

#### **SILVERBERG, GOLDMAN & BIKOFF, L.L.P., Washington, DC**

November 2004 – May 2005

*Law Clerk/Staff Attorney*

- Handled intellectual property issues for domestic and foreign clients.
- Responded to Office Actions.
- Performed legal research on trademark infringement for use in Trademark Trial and Appeal Board litigation.
- Drafted articles for publication in *World Trademark Law Report*.
- Assisted in discovery and pre-trial matters for civil RICO litigation.
- Advised clients on issues of copyright and domain name infringement.

**UNITED STATES COPYRIGHT OFFICE, GENERAL COUNSEL, Washington, DC**

May-August 2003

*Law Clerk*

- Performed legal research regarding a host of issues including electronic signatures, exemptions to the anti-circumvention provisions of the Digital Millennium Copyright Act, and proposed legislation concerning reform of the Copyright Arbitration Royalty Panels and state immunity for intellectual property infringement.
- Analyzed third party litigations to determine advisability of intervention.
- Attended Congressional hearings.

**HYNDMAN & NAVAZO, P.C., Phoenix, AZ**

May-August 2002; January - April 2003

*Law Clerk*

- Conducted legal research on commercial litigation topics, including trademark infringement, trade secrets, intentional interference with business relations, and alter ego liability.
- Drafted trial memoranda, pleadings and demand letters.

**FULBRIGHT & JAWORSKI, L.L.P. ; Washington, DC**

July 1999- July 2001

*Intellectual Property Paralegal/Foreign Filing Specialist*

- Coordinated patent and trademark prosecution of over 400 intellectual property applications in over 50 countries.
- Researched and drafted arguments to assist with trademark opposition proceedings.
- Corresponded with foreign associates regarding maintenance and prosecution issues.
- Assisted with discovery for patent infringement litigation.

**OTHER EXPERIENCE**

**ARIZONA STATE UNIVERSITY, STUDENT LEGAL ASSISTANCE, Tempe, AZ**

September 2003- April 2004

*Law Clerk*

- Counseled and advocated on behalf of over fifty student clients in a wide array of legal matters.
- Conducted legal research, interviewed witnesses, and wrote legal memoranda.

**SUPERIOR COURT OF ARIZONA, MARICOPA COUNTY, Phoenix, AZ**

September - December 2002

*Judicial Extern to The Honorable Roland J. Steinle*

- Drafted opinions and conducted legal research in connection with civil actions involving unfair competition, medical malpractice, and insurance administrative review.

**ARIZONA STATE UNIVERSITY COLLEGE OF LAW, Tempe, AZ**

May 2002- April 2003

*Research Assistant to Professor David H. Kaye*

- Conducted legal research on admissibility of expert testimony and DNA evidence.
- Drafted chapters for inclusion in MODERN SCIENTIFIC EVIDENCE.

**ATLANTA COMMITTEE FOR OLYMPIC GAMES, Atlanta, GA**

July – August 1996

**Protocol Officer**

- Assisted with protocol issues and hospitality for heads of state, royalty and VIP guests.

## **EDUCATION**

**THE GEORGE WASHINGTON UNIVERSITY LAW SCHOOL, Washington, DC**

Master of Laws in Intellectual Property with High Honors, May 2005

**Honors:** North American Consortium on Legal Education student essay contest winner (presented paper on intellectual property law in US, Canada, and Mexico at annual conference Dalhousie University, Halifax, Nova Scotia, Canada)

**THE COLLEGE OF LAW AT ARIZONA STATE UNIVERSITY, Tempe, AZ**

Juris Doctor, May 2004; Certificate in Law, Science, & Technology (IP specialization)

**Journal:** *Jurimetrics, The Journal of Law, Science & Technology*, Senior Editor

**Honors:** National Association of Women Lawyers Outstanding Graduate at ASU 2004; Center Scholar, Center for Law, Science, & Technology 2002-2004; Willard J. Pedrick Scholar (Dean's List); Brown & Bain Scholarship

**Activities:** Graduate and Professional Students Association, Senator 2003-2004; Women Law Students Association, President 2002-2003; Intellectual Property Student Association, Secretary 2002-2003

**DUKE UNIVERSITY – Durham, NC**

Bachelor of Arts, May 1999

Majors: Political Science (International Relations) and French & European Studies

**UNIVERSITÉ DE PARIS VII (DENIS DIDEROT) – Paris, France – Fall 1997**

## **ADMISSIONS**

Arizona – admitted January 10, 2005 (Bar No. 23,448); eligible for D.C. Bar waiver

## **SELECTED LEGAL PUBLICATIONS**

*Copyright Graveyard*, RUBY-SLIPPED SISTERHOOD (October 31, 2013).

*DMCA 101*, RUBY-SLIPPED SISTERHOOD (August 21, 2012).

*What's So Fair About Fair Use?*, RUBY-SLIPPED SISTERHOOD (May 7, 2012).



*Trademark Law for Writers*, RUBY-SLIPPED SISTERHOOD (November 14, 2011).

*All's Fair in Love and War (But not Necessarily in Copyright)*, ROMANCE WRITERS REPORT (February 2010).

*Monopolizing Medicinal Methods: The Debate Over Patent Rights for Indigenous Peoples*, 25 TEMPLE JOURNAL OF SCIENCE, TECHNOLOGY & ENVIRONMENTAL LAW 191-212 (2006).

- Reprinted in Robin Wright, ed., RELIGION, MEDICINE, AND HEALING: AN ANTHOLOGY (2016).

*North American Anti-Circumvention: Implementation of the WIPO Internet Treaties in the United States, Mexico and Canada*, 10 COMPUTER LAW REVIEW & TECHNOLOGY JOURNAL 1-39 (2005).

- Winner of North American Consortium on Legal Education student essay contest. Presented at annual NACLE conference in Halifax, Nova Scotia.

*Garage Door Openers and Toner Cartridges: Why Congress Should Revisit the Anti-Circumvention Provisions of the DMCA*, 3 BUFFALO INTELLECTUAL PROPERTY LAW JOURNAL 135-163 (2005).

*You've Been Served! Rio Properties, Inc. v. Rio International Interlink*, 43 JURIMETRICS 493-504 (2003).

## LEGAL PRESENTATIONS

"Legally Fiction: Basic Intellectual Property Law for Authors"

- November 11-22, 2013, online through Romance Writers of America
- June 8, 2013, Arlington, VA (Washington Romance Writers)
- September 24, 2011, Charlotte, NC (Society of Children's Book Writers & Illustrators)
- July 18, 2009, Washington, DC (Romance Writers of America annual conference)
- October 5, 2008, Matera, Italy (International Women's Fiction Festival)
- April 12, 2008, Nashua, NH (Society of Children's Book Writers & Illustrators)
- October 6, 2008, Iselin, NJ (New Jersey Romance Writers)

"North American Anti-Circumvention" – May 18, 2005, Halifax, Nova Scotia, Canada (North American Consortium on Legal Education)

## LANGUAGES

Fluent in French (10 years of study); working knowledge of Spanish (5 years of study); some Italian.



**UNITED STATES PATENT AND TRADEMARK OFFICE**

OFFICE OF THE GENERAL COUNSEL

June 24, 2019

**VIA EMAIL**

Mr. Raj Abhyanker  
Legalforce RAPC Worldwide  
1580 W. El Camino Real, Suite 13  
Mountain View, CA 94040

RE: ***Freedom of Information Act (FOIA) Request No. F-19-00197***

Dear Mr. Abhyanker:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated Wednesday, May 22, 2019 requesting a copy of the following documents pursuant to the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

All records containing, describing, pertaining to, or referring to:

1. Any and all Request for Information (RFI's) sent by the USPTO Office of Enrollment and Discipline to Heather A. Sapp or her counsel leading to the Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.
2. Any and all responses submitted by Heather A. Sapp either directly or through counsel leading to the Final Order D2019-31 including, but not limited to, that associated with OED investigation file G3493.
3. Any and all notes from interviews conducted in person with Heather A. Sapp and/or her attorney that are not governed under any settlement privilege in to the Proceeding No. D2019-31 including but not limited to, any 11.22 meeting notes associated with OED investigation file G3493.
4. Any and all declarations, affidavits, or statements of facts received or taken by OED from Heather A. Sapp by the USPTO in their investigation leading to the Final Order in Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.

The USPTO has identified voluminous documents that are responsive to your request. Of those documents, nineteen pages are released in full and are included herein. The remaining documents were withheld in full pursuant to Exemption (b)(6) of the FOIA.

Exemption (b)(6) of the FOIA, which permits the withholding of "personnel and medical files and similar files the disclosure of which would constitute a clearly unwarranted invasion of personal privacy." 5 U.S.C. § 552(b)(6). The term "similar files" has been broadly construed to cover "detailed Government records on an individual which can be identified as applying to that individual." Dep't of State v. Washington Post, 456 U.S. 595, 601 (1982). Information that applies to a particular individual meets the threshold requirement for Exemption (b)(6) protection. Id. The privacy interest at stake belongs to the individual, not the agency. See Dep't of Justice v. Reporters Comm. for Freedom of the Press, 489 U.S. 749, 763-65 (1989). Exemption (b)(6) requires a balancing of an individual's right to privacy against the public's right to disclosure. See Dep't of the Air Force v. Rose, 425 U.S. 352, 372 (1976); Multi Ag Media LLC v. Dep't of Agric., 515 F.3d 1224, 1228 (D.C. Cir. 2008).

Here, the records contained in discipline file D2019-31 and investigatory record for Investigation G3493 is information that applies to particular individuals, and in which those individuals have a legitimate privacy interest. The burden is on the requester to establish that disclosure of this information would serve the public interest. See Bangoura v. Dep't of the Army, 607 F. Supp. 2d 134, 148-49 (D.D.C. 2009). When balancing the public interest of release against individual privacy interest, the Supreme Court has made clear that information that does not directly

reveal the operations or activities of the federal government falls outside the ambit of the public interest. See Reporters Comm., 489 U.S. at 775. The withheld information does little to shed light or contribute significantly to public understanding of the operations or activities of the USPTO. Your FOIA request does not assert a public interest that outweighs the privacy interest, nor is one otherwise evident. As such, the FOIA dictates that the information be withheld.

You have the right to appeal this initial decision to the Deputy General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 90 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why the information should be made available and why this initial denial is in error. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal."

You may contact the FOIA Public Liaison at 571-272-9585 for any further assistance and to discuss any aspect of your request. Additionally, you may contact the Office of Government Information Services (OGIS) at the National Archives and Records Administration to inquire about the FOIA mediation services they offer. The contact information for OGIS is as follows: Office of Government Information Services, National Archives and Records Administration, 8601 Adelphi Road-OGIS, College Park, Maryland 20740-6001, e-mail at [ogis@nara.gov](mailto:ogis@nara.gov); telephone at 202-741-5770; toll free at 1-877-684-6448; or facsimile at 202-741-5769.

Sincerely,



Tricia Choe  
USPTO FOIA Officer  
Office of General Law

Enclosure





**SENT VIA US MAIL AND ELECTRONIC MAIL**

May 22, 2019

United States Patent and Trademark Office  
USPTO FOIA Officer  
PO Box 1450, Alexandria, VA 22313-1450  
FOIARequests@uspto.gov

**Re: Request under the Freedom of Information Act (FOIA)**

Dear FOIA Officer:

In view of a demonstrably false statements in the Proceeding No. D2019-31 in the Final Order with respect to Heather A. Sapp (a former associate attorney at our law firm) and its associated investigation file G3493, I am writing to request information under the Freedom of Information Act ("FOIA"), 5 U.S.C. § 552, et. seq. for all records and records from investigations pertaining to and leading up to the final order of Heather A. Sapp by the USPTO as explained below.

I request disclosure of records that were prepared, received, transmitted, collected and/or maintained relating or referring to the following information.

**I. Records Requested.**

All records containing, describing, pertaining to, or referring to:

1. Any and all Requests for Information (RFI)'s sent by the USPTO Office Of Enrollment & Discipline to Heather A. Sapp or her counsel leading to the Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.

**Law-inspiring™**

1580 W. El Camino Real, Ste 13  
Mountain View, CA 94040

T: 650.965.8731  
F: 650.989.2131

questions@legalforcelaw.com  
legalforcelaw.com



2. Any and all Responses submitted by Heather A. Sapp either directly or through counsel leading to the Final Order D2019-31 including, but not limited to, that associated with OED investigation file G3493.
3. Any and all notes from interviews conducted in person with Heather A. Sapp and/or her attorney that are not governed under any settlement privilege in to the Proceeding No. D2019-31 including, but not limited to, any 11.22 meeting notes associated with OED investigation file G3493.
4. Any and all declarations, affidavits, or statements of facts received or taken by OED from Heather A. Sapp by the USPTO in their investigation leading to the Final Order in Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.

## **II. Fees.**

I will pay any reasonable fees that may be associated with this request.

## **III. Request for Release of All Responsive Records.**

I believe that all of the records requested are subject to disclosure, and I request prompt processing and release of the requested information. I also request a complete list of documents covered by the request. I expect that all records will be provided in complete form. To the extent that any requested records are marked classified, please redact only the necessary portions of those records and immediately provide me with the remaining portions. If any records are withheld, please state the exemption claimed and provide a list of the records being withheld. If you deny this request in whole or in part, please provide a written explanation for the denial, including specific reference to the specific statutory provisions upon which you rely, and notify me of appeal procedures available under the law.

## **IV. Conclusion.**

I look forward to a written response to this FOIA Request by the close of the statutory time period, which is within ten working days of your receipt of this Request. To conserve public

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1510 W. El Camino Real, Ste 13  
Mountain View, CA 94040

T: 650.965.8731  
F: 650.989.2131

questions@legalforcelaw.com  
legalforcelaw.com



resources, please provide the requested records, to the extent possible, via electronic mail attachment to [raj@legalforcelaw.com](mailto:raj@legalforcelaw.com) or via Fax to 650-989-2131, and 888-846-8777.

Respectfully,

LEGALFORCE RAPC WORLDWIDE P.C.

A handwritten signature in black ink, appearing to read 'Raj Abhyanker'.

By: Raj Abhyanker

**Law-inspiring™**

1580 W. El Camino Real, Ste 13  
Mountain View, CA 94040

T: 650.965.8731  
F: 650.989.2131

[questions@legalforcelaw.com](mailto:questions@legalforcelaw.com)  
[legalforcelaw.com](http://legalforcelaw.com)



# EXHIBIT 9



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**UNITED STATES PATENT AND TRADEMARK OFFICE**

Office of the General Counsel

Wednesday, June 26, 2019

**VIA EMAIL**

Mr. Raj Abhyanker  
Legalforce RAPC Worldwide  
1580 W. El Camino Real, Suite 13  
Mountain View, CA 94040

Dear Mr. Abhyanker:

Your Appeal of the decision in Freedom of Information Act (FOIA)/Privacy Act Request No. **F-19-00197** was received by the United States Patent and Trademark Office (USPTO) Office of the General Counsel on **Tuesday, June 25, 2019**.

Your appeal has been docketed as “**FOIA Appeal No. A-19-00006**.” Any further inquiries regarding your appeal should include that number. A copy of your appeal is attached for reference.

The Agency expects to send its response to this appeal no later than Wednesday, July 24, 2019. You will be notified if it appears that additional time is required.

Sincerely,

Office of the General Counsel

Enclosure

# EXHIBIT 10





UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

Tuesday, July 30, 2019

VIA U.S. MAIL

Mr. Raj Abhyanker  
Legalforce RAPC Worldwide  
1580 W. El Camino Real, Suite 13  
Mountain View, CA 94040

Dear Abhyanker:

As indicated in the United States Patent and Trademark Office (USPTO) Office of General Counsel response dated July 30, 2019 to FOIA Appeal No. A-19-00006, a portion of your appeal has been remanded back to the USPTO FOIA Office for process. This remand was received by the USPTO FOIA Office on Tuesday, July 30, 2019.

Your remand has been docketed as **"FOIA Request No. F-19-00238."** Any further inquiries regarding your request should include that number. A copy of the appeal response is attached for reference and will be used as the basis for this request.

Please address all inquiries regarding your request to:

FREEDOM OF INFORMATION ACT (FOIA) OFFICER  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or via email to [foiarequests@uspto.gov](mailto:foiarequests@uspto.gov)

The Agency expects to send its response to this request no later than **Tuesday, August 27, 2019**. You will be notified if it appears that additional time is required. You may check on the status of your request at the Agency's website: [www.uspto.gov](http://www.uspto.gov), click on "Freedom of Information Act" at the bottom of the page, and then "Check FOIA Request Status." You will need your request number, shown above, to check on the status of your request.

Sincerely,

USPTO FOIA Office

Enclosure



# United States Patent and Trademark Office

Office of the General Counsel

July 30, 2019

**VIA U.S. MAIL**  
**RETURN RECEIPT REQUESTED**

Mr. Raj Abhyanker  
Legalforce RAPC Worldwide  
1580 W. El Camino Real, Suite 13  
Mountain View, CA 94040

RE: ***Freedom of Information Act Appeal No. A-19-00006 (Appeal of Request No. F-19-00197)***

Dear Mr. Abhyanker,

This determination responds to the letter dated June 24, 2019, which was received by the United States Patent and Trademark Office ("USPTO" or "Agency") on June 28, 2019, appealing the Agency's response to your Freedom of Information Act Request No. F-19-00197. Your appeal was docketed as FOIA Appeal No. A-19-00006.

## FOIA Request and Response

You initially contacted the USPTO by letter dated May 22, 2019, which was received on June 3, 2019, requesting all records containing, describing, pertaining to, or referring to:

1. Any and all Request for Information (RFI's) sent by the USPTO Office of Enrollment and Discipline to Heather A. Sapp or her counsel leading to the Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493;
2. Any and all responses submitted by Heather A. Sapp either directly or through counsel leading to the Final Order D2019-31 including, but not limited to, that associated with OED investigation file G3493;
3. Any and all notes from interviews conducted in person with Heather A. Sapp and/or her attorney that are not governed under any settlement privilege in to the Proceeding No. D2019-31 including but not limited to, any 11.22 meeting notes associated with OED investigation file G3493; and
4. Any and all declarations, affidavits, or statements of facts received or taken by OED from Heather A. Sapp by the USPTO in their investigation leading to the Final Order in Proceeding No. D2019-31 including, but not limited to, that associated with OED investigation file G3493.

FOIA Appeal No. A-19-00006

Page 2 of 6

FOIA Request No. F-19-00197. On May 29, 2019, you were provided a preliminary estimate of \$3,017.28, as the approximate processing cost of your FOIA request, which you paid by check. On June 24, 2019, the Agency informed you that in response to your initial FOIA request, it had collected voluminous documents that were responsive to your request, but that due to Exemption (b)(6) of the FOIA, only nineteen pages are releasable in full. The remaining documents were withheld pursuant to Exemption (b)(6). Initial Determination (FOIA Request No. F-19-00197).

### Appeal

You appealed the Agency's initial determination by letter dated June 24, 2019, which was received by the Agency's Office of the General Counsel on June 28, 2019. In your appeal, you allege that the fee assessed for processing your request was excessive, Exemption (b)(6) is inapplicable in light of strong public interest, and you question the adequacy of the search. Appeal No. 19-00006.

For the reasons set forth below, your appeal is denied.

### Fees

On May 29, 2019, the Agency notified you that processing your request would cost approximately \$3,017.28 for "estimated search time of approximately 26 hours ... and estimated review time of approximately 10 hours for the FOIA specialist and 5 hours for the FOIA Officer." Notice of Processing Cost (FOIA Request No. F-19-00197). The notice further provided that "[a]s a commercial use FOIA requester, you are responsible for the costs involved in search, review and duplication" and that the "search fee is chargeable even when no responsive records are found, or when records requested are determined to be totally exempt from disclosure." *Id.* You paid this fee and the Agency presented you with nineteen pages of releasable material.

In your appeal, you state for the first time that "Legalforce plans to use the [requested] data for noncommercial purposes on the blog of the undersigned, [thus] the FOIA fees should have been limited to only duplication [pursuant to] 37 CFR § 102.11(c)(1)." Appeal No. 19-00006.

The fees charged by the Agency for responding to FOIA requests are laid out in 37 CFR 102.11(c)(1). The Agency designated your request as a commercial request, therefore you were charged for search, review, and duplication fees as mandated by the regulations for commercial requestors. *See* 37 CFR 102.11(c)(1). While you allege you should only be responsible for duplication fees, educational institutions, non-commercial scientific institutions and representatives of the news media are the only ones who pay a reduced fee of only duplication fees. *Id.* You do not fit this reduced fee category, as LegalForce is a law firm<sup>1</sup> and not an educational or non-commercial scientific institution or representative of the media. Although

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<sup>1</sup> The website listed on the letterhead of the appeal, [legalforcelaw.com](http://legalforcelaw.com), states that LegalForce is a law firm. *See* [www.legalforcelaw.com](http://www.legalforcelaw.com)



FOIA Appeal No. A-19-00006

Page 3 of 6

you state that LegalForce plans to use the requested data for noncommercial purposes on a blog, merely making the information available on a blog is not sufficient to qualify for placement in the reduced fee category. *See Nat'l Sec. Archive*, 880 F.2d at 1386 (finding that “making information available to the public . . . [is] insufficient to establish an entitlement to preferred [fee] status”); *see also Hall*, 2005 WL 850379, at \*6 (stating that plaintiff’s endeavors “may establish” him as “vendor of information” but not as representative of news media).

Although I read your appeal to request a fee waiver or reduced fees, you fail to satisfy the criteria under the statute and regulations for granting a fee waiver. The fee waiver standard of the Freedom of Information Act provides that fees should be waived or reduced “if disclosure of the information is in the public interest because it is likely to contribute significantly to public understanding of the operations or activities of the government and is not primarily in the commercial interest of the requester.” 5 U.S.C. § 552(a)(4)(A)(iii); *see also* 37 CFR 102.11(k) (setting out the same two-part test under USPTO regulations). The burden is on the requestor to identify the public interest to be served. *National Treasury Employees Union v. Griffin*, 811 F.2d 644, 647 (D.C.Cir.1987). Here, you do not explain how your requests will elicit information that is of public interest. For example, you do not explain how requests for information sent from the Agency to Ms. Sapp or responses from Ms. Sapp to the Agency during the course of the OED investigation concern USPTO operations or activities or how disclosure of information specific to this one OED investigation into one practitioner would likely contribute to the public understanding of USPTO operations and activities.<sup>2</sup>

Your initial request did not state that your request was for non-commercial purposes and did not contain information indicating that the request was for non-commercial purposes, nor did you respond to the Agency’s Notice of Processing Fee, which stated that you were a commercial requestor and would be responsible for search, review and duplication costs. Furthermore, the information you provided in your appeal indicates that the requested information was for commercial use. You clearly assert that “the requested documents seek information that provide a means for LegalForce to protect the rights and take corrective action necessary to address any and all issues caused by the alleged improper signatures of trademark applications and small businesses and individuals represented by LegalForce.” Appeal No. 19-00006. As a law firm, furthering your own interests constitutes a commercial use request under 37 CFR 102.11(b)(1). *See Rozet v. HUD*, 59 F. Supp. 2d 55, 57 (D.D.C. 1999) (finding commercial interest where requester sought documents to defend his corporations in civil fraud action); *Research Air, Inc. v. Kempthorne*, 589 F. Supp. 2d 1, 10 (D.D.C. 2008) (concluding that requester’s intent to use records to oppose suspension of his pilot card was primarily in requester’s commercial interest). Furthermore, since Ms. Sapp was disciplined for conduct that occurred while employed at LegalForce and the misconduct involved other employees from LegalForce, I find that the nexus between the content of the FOIA request and LegalForce’s involvement clearly demonstrates that these requests advance LegalForce’s interests rather than any public interest.

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<sup>2</sup> Moreover, you state that “[t]he requested information does not seek to reveal the operations or activities of the federal government.” Appeal No. 19-00006. It is unclear whether this statement is accurate as written, but assuming it is, you would fail to meet your burden of establishing that a fee waiver is appropriate on this basis alone.

FOIA Appeal No. A-19-00006

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You state very clearly your intention to use the information to further your own interests and the interests of your clients, which as previously stated, constitutes a commercial request. *Id.* For all of the forgoing reasons, I find that you do not qualify for reduced fees and were appropriately categorized as a commercial requestor.

Your appeal also “takes issue with the propriety of the estimated fee” in light of the “computerized nature of the Deposit Account system in the USPTO Office of Finance.” Appeal No. 19-00006. However any computerized nature of the USPTO’s finance systems do not have bearing on the time necessary to process your request related to documents from the Agency’s Office of Enrollment and Discipline. Thus, I find this argument to be without merit.

For the forgoing reasons, your claim that the Agency charged you excess fees is denied.

#### Exemption (b)(6)

Your appeal disputes the withholding of documents under (b)(6), which are related to the Office of Enrollment and Discipline’s investigation of and disciplinary proceeding for Heather A. Sapp, a former employee of LegalForce based on misconduct that occurred while she was employed at LegalForce. Appeal No. 19-00006. In the initial determination, the Agency correctly found that the investigatory records requested concerned particular individuals who have a legitimate privacy interest in that information about themselves.

You do not argue that there are no privacy considerations in the information you seek. Rather you appear to allege that any privacy interests are outweighed by strong public interest in Ms. Sapp’s matter, as you claim is evidenced by a patent blog that published a summary of the decision. Appeal No. 19-00006. One blog summarizing an OED decision does not explain how other information in the investigative file, including requests for information sent from the Agency to Ms. Sapp, responses by Ms. Sapp, or statements from Ms. Sapp during the course of the OED investigation would be of any public interest outside of information already contained in the publically available decision. There is no discernable public interest in the information requested from the investigation of Ms. Sapp’s conduct while she worked at LegalForce.

Even assuming there is a minimal amount of information of interest to the public in this single disciplinary matter involving one practitioner, it would not be enough to overcome the strong privacy interest implicated by the requested materials. *Mueller v. U.S. Dep’t of the Air Force*, 63 F. Supp. 2d 738, 745 (E.D. Va. 1999). (“[T]he interest of the public in the personnel file of one Air Force prosecutor is attenuated because information concerning a single isolated investigation reveals relatively little about the conduct of the Air Force as an agency.”); *Chin v. U.S. Dep’t of the Air Force*, No. 97-2176, slip op. at 5 (W.D. La. June 24, 1999) (finding only “marginal benefit to the public interest” in release of the facts of a single case, particularly “where alternative means exist -- such as statistical samples or generalized accounts -- to satisfy the public interest”); *Cotton v. Adams*, 798 F. Supp. 2d, 27 n.9 (D.D.C. 1992) (finding that, where FOIA request sought misconduct reports for two named employees, the “generalized public interest in good management does not override the privacy interests”).



FOIA Appeal No. A-19-00006  
Page 5 of 6

Accordingly, I find that the information requested relating to the OED disciplinary proceedings and investigation of Ms. Sapp is exempt from disclosure under Exemption (b)(6) and was properly withheld.

#### Adequacy of the Search

Your appeal alleges that agency failed to properly search for the requested information. Appeal No. 19-00006. As support for your contention, you state that numerous responsive documents were identified by the Agency but not produced except for publically available documents. *Id.* Therefore, you request another search be performed. Additionally, you request a breakdown of: (1) all searches performed regarding paragraphs 1-4, any communications regarding the results of such search, including the raw results of the search. *Id.*

Your request for a breakdown of all searches performed and any communications is a new request for new documents. Therefore, I will remand this additional request to the FOIA office for processing.

Although you complain that the search was inadequate, the search criteria were reviewed and found to be appropriate.

Agencies are required to undertake a search that is “reasonably calculated to uncover all relevant documents.” *See Weisberg v. DOJ*, 705 F.2d 1344, 1351 (D.C. Cir. 1983). Courts have held that an agency’s search is reasonable when it focused on the records specifically mentioned in the request. *See Ledesma v. U.S. Marshals Serv.*, No. 05-5150, 2006 U.S. App. LEXIS 11218, at \*2 (D.C. Cir. Apr. 19, 2006). Additionally, the reasonableness of an agency’s search can depend on whether the agency properly determined where responsive records were likely to be found, and searched those locations. *See, e.g., Iacoe v. IRS*, No. 98-C0466, 1999 WL 675322, at \*4 (E.D. Wis. July 23, 1999) (recognizing that agency “diligently searched for the records requested in those places where [agency] expected they could be located”).

The search methods used to find documents in response to your request were reasonably calculated to uncover all relevant documents. The custodians most likely to have responsive documents were sent your exact document request, which indicates file names and other information necessary for a targeted search. Furthermore, the individuals sent the search request were familiar with the matter, knowledgeable about the requested documents, and most likely to know where the documents were located.

Although you complain that only “nineteen pages” were produced, which were the final order and a draft version of the final order, the “adequacy of a FOIA search is generally determined not by the fruits of the search, but by the appropriateness of the methods used to carry out the search.” *Jennings v. DOJ*, 230 F. App’x 1, 1 (D.C. Cir. 2007) (quoting *Iturralde v. Comptroller of Currency*, 315 F.3d 311, 315 (D.C. Cir. 2003)).

The search criteria were reviewed and are appropriate and tailored to your request.



FOIA Appeal No. A-19-00006

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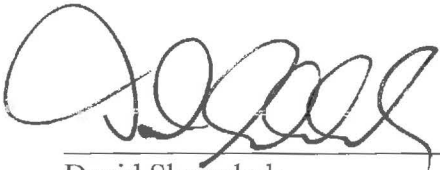
Final Decision and Appeal Rights

This is the final decision of the United States Patent and Trademark Office with respect to your appeal. You have the right to seek judicial review of this decision as provided in 5 U.S.C. § 552(a)(4)(B). Judicial review is available in the United States District Court for the district in which you reside or have a principal place of business, the United States District Court for the Eastern District of Virginia, or the United States District Court for the District of Columbia.

Additionally, as part of the 2007 FOIA amendments, the Office of Government Information Services (OGIS) was created to offer mediation services to resolve disputes between FOIA requesters and Federal agencies as a non-exclusive alternative to litigation. Using OGIS services does not affect your right to pursue litigation. If you are requesting access to your own records (which is considered a Privacy Act request), you should know that OGIS does not have the authority to handle requests made under the Privacy Act of 1974. You may contact OGIS in any of the following ways:

Office of Government Information Services  
National Archives and Records Administration  
Room 2510  
8601 Adelphi Road  
College Park, MD 20740-6001  
E-mail: [ogis@nara.gov](mailto:ogis@nara.gov)  
Telephone: 301-837-1996  
Facsimile: 301-837-0348  
Toll-free: 1-877-684-6448

Sincerely,



---

David Shewchuk  
Deputy General Counsel for General Law  
Office of the General Counsel

# EXHIBIT 11



Raj Abhyanker &lt;raj@legalforcelaw.com&gt;

---

**Re: Mediation request & FOIA Appeal, F-19-00197**

---

**OGIS** <OGIS@nara.gov>

Fri, Jul 19, 2019 at 8:03 AM

To: OGIS &lt;OGIS@nara.gov&gt;

Cc: ogis@nara.gov, lit-support@legalforcelaw.com, managers@legalforcelaw.com, raj@legalforcelaw.com

Dear Mr. Abhyanker:

This responds to your June 24, 2019 request for assistance from the Office of Government Information Services (OGIS). OGIS is the Federal Freedom of Information Act (FOIA) Ombudsman. We assist the public and Federal agencies by helping them resolve their FOIA disputes, and by addressing their questions and concerns about the FOIA process. OGIS has no investigatory or enforcement power, nor can we compel an agency to release documents. Instead, OGIS provides information to FOIA requesters and Federal agencies to increase understanding and resolve disputes.

We carefully reviewed your submission. We understand that the U.S. Patent and Trademark Office (USPTO) identified documents responsive to your request. The agency released nineteen pages to you in their entirety and withheld the remaining documents in their entirety pursuant to FOIA Exemption 6, 5 U.S.C. § 552(b)(6). You disputed USPTO's action on your request - specifically the agency's withholdings, fees assessment, and search. You filed a FOIA administrative appeal with the agency's Deputy General Counsel by a letter dated June 24, 2019. You also sought OGIS assistance in mediating your dispute with USPTO.

The appeal is an important part of the FOIA administrative process, and OGIS's assistance does not replace the appeal process. By filing an appeal, you preserve your administrative rights and give the agency a chance to look at the request anew and carefully review and reconsider every part of the initial response, from the search the agency conducted to any initial decision the agency made to withhold records in full or in part.

On appeal, the agency FOIA office that reviews and addresses administrative appeals will typically review your request, the agency's initial response, your appeal letter, and files pertaining to the agency's processing of your request. Based on the available information, the appeals office will independently determine whether the agency properly processed your request at the initial stage. The appeals office may affirm the initial response in full; or it may reverse or modify the initial response - and may remand your request back to the FOIA office which handled the initial request for further action. The agency will notify you of its appeal determination in writing.

At this time, if you are concerned with USPTO's initial response to your request, your best course of action is to wait until USPTO processes your appeal and has sent you a final determination. If you dispute the appeal determination or have questions or concerns that we have not addressed, please contact us again and provide us with the materials listed on our website <<https://www.archives.gov/ogis/mediation-program/request-assistance>>.

We hope you find this information useful. Thank you for bringing this matter to OGIS; at this time we consider this matter closed.

Sincerely,  
The OGIS Staff

On Monday, June 24, 2019 at 9:57:19 PM UTC-4, Raj Abhyanker wrote:

Dear OGIS,

I would like to appeal the above referenced FOIA decision in F-19-00197, on the grounds laid for this request, and would like to request mediation.

I also left a voice message for Mr. Boston at the USPTO, whose number 571-272-9585 was provided in the final letter. Please let me know the next steps.

--

**Raj Abhyanker**  
Partner





call: 1-650-390-6461  
email: [raj@legalforcelaw.com](mailto:raj@legalforcelaw.com)  
web: <http://www.legalforcelaw.com/raj-v-abhyanker/>  
connect: <https://www.linkedin.com/in/rajthelawyer/>



LegalForce RAPC Worldwide  
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Mountain View, CA 94040 United States

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About **LegalForce RAPC Worldwide** - LegalForce RAPC Worldwide is a leading general practice law firm specializing in serving the diverse needs of individuals, businesses, and institutions worldwide. The firm created the [Trademarkia.com](http://Trademarkia.com) website.

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# EXHIBIT 12

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE  
UNITED STATES DEPARTMENT OF HOUSING AND URBAN DEVELOPMENT**

In the Matter of:

[REDACTED]

Respondent

Proceeding No. D2019-42

**OED DIRECTOR'S PROPOSED EXHIBITS**

The Director of the Office of Enrollment and Discipline ("OED Director") for the United States Patent and Trademark Office ("USPTO" or "Office"), by counsel, exchanges this exhibit list as directed by the Tribunal's Order of June 20, 2019. Copies of the documents identified are being provided to Respondent as of the date of the filing of this document.

<b>GOV NO.</b>	<b>DATE</b>	<b>DESCRIPTION</b>	<b>BATES NO.</b>
1		LegalForce RAPC bio for [REDACTED] from LegalForce webpage, retrieved September 9, 2019	1-3
2		State Bar of Arizona lawyer page for [REDACTED] retrieved September 13, 2019	1-3
3		Linked-In Profile for [REDACTED] retrieved, retrieved September 13, 2019	1-4
4	09/26/18	Office of Enrollment and Discipline ("OED") Initial Request For Information and Evidence ("RFI") to [REDACTED]	1-6
5	10/25/18	[REDACTED] Response to Initial RFI from OED, including Exhibit A	1-22
6	11/30/18	OED Second RFI to [REDACTED]	1-13
7	01/07/19	[REDACTED] Response to Second RFI from OED, including Exhibit 1	1-30



GOV NO.	DATE	DESCRIPTION	BATES NO.
8	01/11/19	OED Third RFI to [REDACTED]	1-7
9	02/01/19	[REDACTED] Response to Third RFI from OED, including Exhibits 1-3	1-52
10	02/21/19	[REDACTED] Supplemental Response to OED RFIs, including Exhibits 1-7	1-33
11	2/28/19	Memo to OED file from Staff Atty Reitz, Staff Atty Dorsey, SCDI Jaicks re: In-Person Interview of [REDACTED] on Feb. 25, 2019	1-9
12	03/18/19	[REDACTED] Supplemental Response to OED RFIs	1-3
13	1/31/19	Memo to File from Howie Reitz, OED, re telephone call with [REDACTED] [Redacted]	1-7
14	5/16/19	Letter from Howie Reitz, OED, to [REDACTED] counsel for [REDACTED]	1
15	5/23/19	Letter from [REDACTED] counsel for [REDACTED] to Howie Reitz, OED	1-9
16	6/14/19	[REDACTED] of [REDACTED] as [REDACTED] for [REDACTED]	1
17	6/28/19	OED RFI to [REDACTED]	1-7
18	7/25/19	[REDACTED] Response to OED RFI	1-9
19	11/29/18	OED RFI to [REDACTED]	1-8
20	12/22/18	[REDACTED] Response to RFI	1-5
21	7/31/18	OED RFI to [REDACTED]	1-2
22	12/15/18	[REDACTED] Response to RFI	1-5
23	11/21/18	OED RFI to [REDACTED]	1-8
24	1/3/19	[REDACTED] response to RFI	1-14
25	11/21/18	OED RFI to [REDACTED]	1-8

<b>GOV NO.</b>	<b>DATE</b>	<b>DESCRIPTION</b>	<b>BATES NO.</b>
26	01/07/19	[REDACTED] response to RFI	1-7
27	11/21/18	[REDACTED] response to RFI	1-15
28	1/30/19	[REDACTED] response to Supplemental Request for Information.	1-14
29	3/13/19	Memo from Elizabeth Dorsey, OED, re interview with [REDACTED] [REDACTED] on March 5, 2019	1-5
30	10/23/18	Sapp response to RFI	1-18
31	3/5/19	Memo from Sarah Franz, OED, re interview with Heather Sapp on February 22, 2019	1-38
32	1/31/19	Sapp response to supplemental RFI	1-53
33	3/5/19	Sapp Amended Responses to RFIs.	1-34
34	7/20/16	Heather Sapp Job Description	1-3
35	8/15/14	Employee Handbook LegalForce	1-47
36	6/4/15	Email from [REDACTED] to [REDACTED] [REDACTED]	[REDACTED]
37	6/4/15	Email exchange between [REDACTED] [REDACTED] [REDACTED] are compliant	[REDACTED]
38	6/4/15	[REDACTED] [REDACTED]	[REDACTED]
39	6/5/15	[REDACTED] [REDACTED]	[REDACTED]

GOV NO.	DATE	DESCRIPTION	BATES NO.
40	6/5/15	Email from [REDACTED] [REDACTED]	[REDACTED]
41	9/26/14	[REDACTED] [REDACTED]	[REDACTED]
42	6/18/15	[REDACTED] [REDACTED]	[REDACTED]
43	7/13/15	Email from [REDACTED] [REDACTED]	[REDACTED]
44	9/1/15	Email from [REDACTED] [REDACTED]	[REDACTED]
45	9/30/15	Email from [REDACTED] [REDACTED]	[REDACTED]
46	1/29/16	Email from [REDACTED] [REDACTED]	[REDACTED]
47	2018	Annual [REDACTED] [REDACTED]	[REDACTED]
48	5/15/18	Email from [REDACTED] [REDACTED]	[REDACTED]
49	6/8/18	Email exchange between [REDACTED] [REDACTED]	[REDACTED]



GOV NO.	DATE	DESCRIPTION	BATES NO.
		Serial # [REDACTED] - [REDACTED] [REDACTED]	
50	6/8/18	Email from [REDACTED] [REDACTED]	[REDACTED]
51	6/8/18	Email from [REDACTED] [REDACTED]	[REDACTED]
52	6/8/18	Email from [REDACTED] [REDACTED]	[REDACTED]
53	6/27/18	Email from [REDACTED] [REDACTED]	[REDACTED]
54	6/28/18	Email exchange between [REDACTED] [REDACTED]	[REDACTED]
55	8/11/18	Email from [REDACTED] [REDACTED]	[REDACTED]
56	8/14/18	Email from [REDACTED] [REDACTED]	[REDACTED]

GOV NO.	DATE	DESCRIPTION	BATES NO.
57	12/10/18	Email from [REDACTED] [REDACTED]	1
58	12/10/18	Attorney Professional Responsibility Commitment, signed by [REDACTED] LegalForce RAPC Worldwide	1
59	12/11/18	Non-Licensed Employees/Attorneys Professional Responsibility Commitment, LegalForce signed by [REDACTED]	1-4
60	January 2019	The ABC's of Ethics (Legal Ethics for Non-Lawyers) LegalForce Employee Training (PowerPoint Presentation) (prepared by Sapp)	1-18
61	2/8/18	Terms of Service for LegalForce clients	1-20
62	1/23/19	LegalForce Terms of Service, LegalForce client	1-33
63	2/1/19	Email from [REDACTED] [REDACTED]	1
64	2/7/19	Email string between from [REDACTED] and [REDACTED] [REDACTED] re signature issues	1
65	2/13/19	Memorandum To: [REDACTED] [REDACTED], Managing Partner; From: [REDACTED] Rules	1
66	03/08/19	Email from [REDACTED] [REDACTED]	1
67	8/16/19	[REDACTED]	1
68	12/20/18	Whatis [REDACTED] [REDACTED]	1

GOV NO.	DATE	DESCRIPTION	BATES NO.
69	12/10/18	Whatis [REDACTED] [REDACTED]	[REDACTED]
70	3/22/19	Whatis [REDACTED] [REDACTED]	[REDACTED]
71	3/27/19	What is [REDACTED] [REDACTED]	[REDACTED]
72	5/16/2019	What is [REDACTED] [REDACTED]	[REDACTED]
73	1/04/19	LegalForce RAPC webpage "Legal Service for Global Innovation"	1-4
74	1/04/19	LegalForce RAPC webpage "Our Team" page, retrieved January 4, 2019	1-3
75	1/04/19	Trademarkia webpage "Register a Trademark Online," retrieved January 4, 2019	1-2
76	3/01/19	LegalForce RAPC webpage "About"	1-6
77	8/29/19	Case # 19SC080274 Raj Abhyanker v. John Salcido, Complaint with Exhibits A – F	1-24
78	12/9/18	Email from Raj Abhyanker to [REDACTED] [REDACTED] Statement of Use, checking to confirm he signed declaration	[REDACTED]
79	12/10/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], Section 8, checking to confirm he signed declaration	[REDACTED]
80	12/10/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], [REDACTED] checking to confirm he signed declaration	[REDACTED]
81	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], Trademark Serial	[REDACTED]



GOV NO.	DATE	DESCRIPTION	BATES NO.
		No. [REDACTED], Appointment of Attorney, checking to confirm he signed declaration	
82	12/11/18	Email from Raj Abhyanker to [REDACTED] Subject: Confirmation Request [REDACTED], checking to confirm he signed declaration	1
83	12/10/18	Email from Raj Abyanker to [REDACTED] [REDACTED], [REDACTED] Renewal, checking to confirm he signed declaration	1
84	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED] renewal, checking to confirm he signed declaration	1
85	12/10/18	Email from Raj Abhyanker to [REDACTED] [REDACTED] renewal, checking to confirm he signed declaration	1
86	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED] renewal, checking to confirm he signed declaration	1
87	12/11/18	Email from Raj Abyanker to [REDACTED] [REDACTED], [REDACTED] renewal, checking to confirm he signed declaration, checking to confirm he signed declaration	1
88	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], [REDACTED] renewal, checking to confirm he signed declaration	1
89	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], Statement of Use, checking to confirm he signed declaration	1

GOV NO.	DATE	DESCRIPTION	BATES NO.
90	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], Extension of Use, checking to confirm he signed declaration	1
91	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], Statement of Use, checking to confirm he signed declaration	1
92	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], Response to Office Action, checking to confirm he signed declaration	1
93	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], [REDACTED] renewal, checking to confirm he signed declaration	1
94	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], [REDACTED] renewal, checking to confirm he signed declaration	1
95	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], Section 8 renewal, checking to confirm he signed declaration	1
96	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], [REDACTED] renewal, checking to confirm he signed declaration	1
97	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED] renewal, checking to confirm he signed declaration	1

GOV NO.	DATE	DESCRIPTION	BATES NO.
98	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], Specimen of Use, checking to confirm he signed declaration	1
99	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], [REDACTED] renewal, checking to confirm he signed declaration	1
100	12/11/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], [REDACTED] renewal, checking to confirm he signed declaration	1
101	12/10/18	Email from Raj Abhyanker to [REDACTED] [REDACTED], [REDACTED] Renewal, checking to confirm he signed declaration	1
102	10/15/18	OED Request for Information and Evidence to [REDACTED] [REDACTED]	1-3
103	10/31/18	Response to OED October 15, 2018 RFI from [REDACTED] [REDACTED]	1
104	11/19/18	OED Supplemental RFI to [REDACTED]	1-4
105	12/17/18	Response to OED November 19, 2018 Supplemental RFI from [REDACTED] including Exhibits [REDACTED]	1-1504
106	1/7/19	OED Second Supplemental RFI to [REDACTED]	1-8
107	1/22/19	Response to OED January 7, 2019 Second Supplemental RFI sent from [REDACTED] including Exhibits DD - JJ	1-1184
108	1/28/19	OED Third Supplemental RFI to [REDACTED]	1-5
109	2/4/19	Response to OED January 28, 2019 Third Supplemental RFI sent from [REDACTED]	1-18



GOV NO.	DATE	DESCRIPTION	BATES NO.
110	2/11/19	Supplemental Response to Request No. 17 to OED January 28, 2019 RFI from [REDACTED] as Witness, including Exhibits 1-14	1-93
111	2/14/19	OED Lack of Response letter re OED's Third Supplemental RFI to [REDACTED]	1-7
112	2/20/19	[REDACTED] Response to OED Lack of Response Letter, including Exhibits 1-25	1-210
113	2/28/19	Email from [REDACTED] counsel for [REDACTED] to OED Subject [REDACTED]	1-5
114	3/11/19	Letter from Ronald K. Jaicks, Senior Counsel for Disciplinary Investigation, OED to [REDACTED] counsel for [REDACTED] re: OED response to February 28, 2019 Email	1-4
115	3/4/19	Letter from [REDACTED] counsel for [REDACTED] to Andrei Iancu re Petition to the USPTO Director	1-5
116	3/15/19	USPTO Response to Petition filed March 4, 2019	1
117	12/11/18	Memo to File from Howie Reitz, OED, re telephone call with [REDACTED]	1
118	12/12/18	Memo to File from Howie Reitz, OED, re telephone call with [REDACTED]	1
119	12/13/18	Memo to File from Howie Reitz, OED, re telephone call with [REDACTED]	1
120	2/1/19	Memo to File from Howie Reitz, OED, re telephone call with [REDACTED]	1-13
121	1/4/19	Memo to File from Sarah Franz, OED, re telephone call with [REDACTED]	1
122	12/10/18	Memo to File from Elizabeth Dorsey, OED, re telephone call with [REDACTED]	1

GOV NO.	DATE	DESCRIPTION	BATES NO.
110	2/11/19	Supplemental Response to Request No. 17 to OED January 28, 2019 RFI from [REDACTED] as Witness, including Exhibits 1-14	1-93
111	2/14/19	OED Lack of Response letter re [REDACTED] [REDACTED]	[REDACTED]
112	2/20/19	[REDACTED] Response to OED Lack of Response Letter, including Exhibits 1-25	1-210
113	2/28/19	[REDACTED]	[REDACTED]
114	3/11/19	Letter from Ronald K. Jaicks, Senior Counsel for Disciplinary Investigation, OED to [REDACTED] counsel for [REDACTED] re: OED response to February 28, 2019 Email	1-4
115	3/4/19	Letter from [REDACTED] counsel for [REDACTED] to Andrei Iancu re Petition to the USPTO Director	1-5
116	3/15/19	USPTO Response to Petition filed March 4, 2019	1
117	12/11/18	Memo to File from Howie Reitz, OED, re telephone call with [REDACTED]	1
118	12/12/18	Memo to File from Howie Reitz, OED, re telephone call with [REDACTED]	1
119	12/13/18	Memo to File from Howie Reitz, OED, re telephone call with [REDACTED]	1
120	2/1/19	Memo to File from Howie Reitz, OED, re telephone call with John Salcido	1-13
121	1/4/19	Memo to File from Sarah Franz, OED, re telephone call with [REDACTED]	1
122	12/10/18	Memo to File from Elizabeth Dorsey, OED, re telephone call with [REDACTED]	1

GOV NO.	DATE	DESCRIPTION	BATES NO.
123	3/1/19	Memo to File from Elizabeth Dorsey, OED, re telephone call with [REDACTED]	1
124	3/6/19	Memo to File from Elizabeth Dorsey, OED, re second telephone call with [REDACTED]	1
125	12/12/18	Email to Elizabeth Dorsey, OED, from [REDACTED]	1-39
126		USPTO Trademark Manual of Examining Procedure ("TMEP") § 611.01	1-10
127		37 C.F.R. § 2.193	1-3
128	5/15/19	Sapp Final Order Pursuant to 37 C.F.R. § 11.26	1-18
129	9/5/19	Rajan Final Order Pursuant to 37 C.F.R. § 11.26	1-11
130		Deposition of Heather Sapp [REDACTED] [REDACTED] [REDACTED]	[REDACTED]
131		Deposition of John Salcido [REDACTED] [REDACTED] [REDACTED]	[REDACTED]
132		Complaint filed in LegalForce RAPC Worldwide, PC v. MyCorporation Business Services, Inc., Case No.5:18-cv-00142-HRL (U.S. District Court, N.D. Ca.)	1-206
133	5/31/18	Complaint filed by [REDACTED] with [REDACTED] [REDACTED] (Trademarks) against Deborah Sweeney	1-69
134	6/19/19	Sweeny Final Order Pursuant to 37 C.F.R. § 11.26	1-7
135	Various	Emails between [REDACTED] RAPC, to [REDACTED] re Trademark Serial No. [REDACTED]	1-6
136	10/29/18	[REDACTED] Response to OED Initial RFI	1-12
137	3/25/19	[REDACTED] Response to OED Second RFI	1-11
138	8/20/18	[REDACTED] Response to OED Initial RFI	1-12



GOV NO.	DATE	DESCRIPTION	BATES NO.
139	12/12/18	██████████ Response to OED Supplemental RFI	1-13
140	3/26/19	██████████ Response to OED Third RFI	1-12
141	10/04/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-152
142	08/09/11	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-162
143	7/07/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-92
144	6/09/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-163
145	6/21/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-159
146	6/03/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-112
147	6/14/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-147
148	6/20/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-103
149	5/08/12	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-110
150	6/08/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-64
151	6/09/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-55
152	6/21/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-163
153	6/09/17	Trademark Application Serial No. ██████████, Declaration of Use § 8	1-73

<b>GOV NO.</b>	<b>DATE</b>	<b>DESCRIPTION</b>	<b>BATES NO.</b>
154	3/20/18	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-281
155	6/03/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-116
156	8/08/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-100
157	6/06/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-165
158	6/14/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-54
159	2/28/18	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-81
160	6/07/17	Trademark Application Serial No. [REDACTED], Combined Declaration of Use § 8 & 15	1-150
161	6/07/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-56
162	6/15/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-140
163	6/15/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-106
164	6/15/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-112
165	6/03/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-141
166	6/03/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-130
167	6/06/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-114

GOV NO.	DATE	DESCRIPTION	BATES NO.
168	6/14/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-63
169	6/06/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-91
170	7/11/17	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-92
171	5/15/18	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-157
172	5/18/18	Trademark Application Serial No. [REDACTED], Declaration of Use § 8	1-139
173	6/07/17	Trademark Application Serial No. [REDACTED], Revocation/Appointment	1-339
174	4/20/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-89
175	8/29/17	Trademark Application Serial No. [REDACTED], Petition to Revive	1-180
176	8/27/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-109
177	6/02/17 6/03/17	Trademark Application Serial No. [REDACTED], Revoke/Change POA; Petition to Revive	1-217
178	6/06/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-82
179	6/09/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-83
180	4/24/18	Trademark Application Serial No. [REDACTED], Response to Office action	1-285
181	4/24/18	Trademark Application Serial No. [REDACTED], Revoke/Change in POA	1-203



<b>GOV NO.</b>	<b>DATE</b>	<b>DESCRIPTION</b>	<b>BATES NO.</b>
182	8/03/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-146
183	6/07/17	Trademark Application Serial No. [REDACTED], Revoke/Change in POA; Statement of Use	1-130
184	9/07/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-125
185	9/07/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-116
186	10/12/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-146
187	8/11/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-123
188	9/07/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-117
189	5/30/17	Trademark Application Serial No. [REDACTED], Response to Office action	1-94
190	4/30/18	Trademark Application Serial No. [REDACTED], Request for Extension of time to file Statement of Use	1-137
191	9/07/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-81
192	10/11/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-85
193	4/25/18	Trademark Application Serial No. [REDACTED], Statement of Use	1-160
194	12/21/17	Trademark Application Serial No. [REDACTED], Statement of Use	1-66

<b>Demonstrative Evidence</b>
-------------------------------

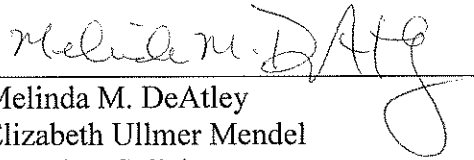
The OED Director may offer demonstrative evidence in the form of showing how the signature method used to electronically sign a trademark document is readily publicly available via TSDR.
--

Counsel for the OED Director reserves the right to supplement this list of Exhibits, as she anticipates taking depositions at which documents may be produced. Counsel for the OED Director may also be filing a Motion to request permission to send discovery. If that Motion is granted and discovery is sent, any additional documents identified and provided in response may be added to this proposed Exhibit List.

[signature page follows]

Respectfully submitted,

September 17, 2019

  
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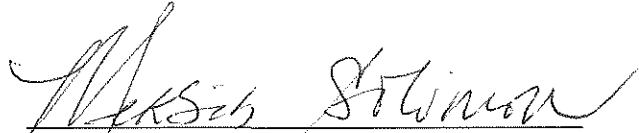
*Counsel for:*

Director of the Office of Enrollment and Discipline  
United States Patent and Trademark Office

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing OED Director's Proposed Exhibit List was emailed this day to Respondent's counsel, Michael McCabe at [mike@ipethics.com](mailto:mike@ipethics.com).

September 17, 2019

A handwritten signature in cursive script, appearing to read "Melissa Solomon", written over a horizontal line.

United States Patent and Trademark Office

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# EXHIBIT 13

# "Shaky legal ground" – the unintended consequences of USPTO requests for proof of legal residence

- **USPTO now asks "proof of legal residence in the US" from some trademark applicants**
- **Report finds office is "facing a backlash" from its own staff due to new instructions**
- **Experts tell *WTR* that new instructions could affect small business owners and domestic violence victims**

A new investigation has found the US Patent and Trademark Office is "facing a backlash" due to new instructions that require examining attorneys to ask some trademark applicants for "proof of legal residence in the United States". Talking to *WTR*, IP experts have spoken of the unexpected consequences of such a move, including issues that could affect small business owners and even domestic violence victims.

As [we have widely reported](#), the USPTO has experienced a sharp rise in trademark applications originating from China in recent years. While not necessarily a bad thing, there have been concurrent reports of alleged fraud by some Chinese applicants, especially around the submission of improper specimens of use. It's an issue we first reported on [in 2017](#), while we recently published a two-part investigation ([part one](#), [part two](#)) into how it continued to be a widespread problem for the office.

For that reason, on July 2, the registry [confirmed](#) new rules that would require all applicants not domiciled in the United States to engage US licensed attorneys to file and prosecute trademark applications. When first announced, this move was criticised by some foreign applicants, who believed it could lead to a steep rise in costs. Nonetheless, the new rules came into effect earlier this month, on August 3.

A few weeks have now passed, and details have recently emerged about examination changes related to the new rules. An [investigation by WGBH News](#) has revealed a "backlash" from the USPTO's own staff over new instructions that "seems to require trademark examiners to ask some applicants for proof of legal residence in the US" – a move that examiners reportedly believe "has no role in trademark approval".

Details about the changes can be found in [the USPTO's Examination Guide 4-19](#), which are new instructions related to the rule regarding foreign trademark applicants requiring a US licensed attorney. In section 3, the guide states: "Foreign citizens must comply with US visa immigration laws to claim the US as their permanent legal residence. When the applicant or registrant is a foreign citizen/entity with a US street address, it is necessary to determine whether the US street address is the applicant's or registrant's domicile."

The new instructions – and especially the use of the term "permanent legal residence" – have raised alarm bells for examining attorneys, according to *WGBH News*. "Trademark examiners are now required to ask questions about the immigration status of applicants living in the US that have never been asked of applicants before," one examiner told the Boston-based outlet. "Any immigrant who does not have a green card will likely be unable to obtain a trademark registration, even if they hire an attorney in compliance with the new rule requiring US counsel."

Furthermore, the examination guide states the determination of a trademark applicant's domicile will be based on a number of factors, including the use of private mailboxes. "The initial determination of

whether an applicant's, registrant's, or party's domicile is within or outside the US is based on its physical address," the guide states. "A post-office box cannot be a domicile address. When necessary, the USPTO will require an applicant or registrant to verify its domicile."

Privately, some attorneys have voiced concern that the move is part of the current US administration's ongoing crackdown on illegal immigration. But USPTO spokesperson Paul Fucito has denied this. "We do not require immigration status as part of an application," he said. However, question marks still remain over use the new instructions and the potential impact for applicants.

## Response to the revelations

With concern growing, *WTR* reached out to a number of IP experts to get their response to the new instructions. Most told us that, in general, it is understandable that *some* information is requested by examining attorneys in certain cases. "If an applicant/registrant appears *pro se*, then yes, the USPTO needs to have a way to ascertain that the applicant or registrant is indeed domiciled in the US and some kind of proof is needed," explains [Maria Eliseeva](#) from Patentbar International PC. "Otherwise the same 'bad actors' and entities that engaged in fraud and unauthorised practice of law before the USPTO will continue their practice by listing phony US addresses. In my opinion, it seems like a stretch to equate the legal place of residence in the US with being a permanent resident – or green card holder – in the US."

That view is echoed by Marc Whipple, patent and trademark attorney at [Legal Inspiration](#), who says that if the USPTO has such a rule, it needs to ask questions about residency. "On the one hand, it seems like up to now we've taken people at their word and even the new attorney requirement is still largely taking people at their word that the attorney represents them, at least at first," he adds. "On the other hand, if the idea is to reduce inappropriate applications and stop them as early in the process as possible – as opposed to necessitating oppositions, petitions for cancellation, or court action – this will, at least in theory, be part of that solution."

According to [John E Ottaviani](#), partner at Partridge Snow & Hahn LLP, such questions should only be asked in narrow circumstances, such as "if there is something to cause suspicion" like, for example, "different individuals using the same PO box number" or "an individual with a '.cn' email address claiming residence in the US". [Erik Pelton](#), founder and managing attorney of Erik M Pelton & Associates, agrees. He says that "the rule may raise implications regarding immigration status" – and believes proof of a US domicile shouldn't be needed regularly: "All submissions to the USPTO are done under a declaration made under penalty of perjury. If the USPTO requires applicants to attest that they are domiciled in the US, perhaps that attestation should be sufficient unless there is reason to believe it is false."

Furthermore, Eliseeva notes that the new examination instructions require records of an applicant's domicile even if they are represented by US counsel. "That looks like an unintended consequence to me, because since the goal of the new rule was to make sure foreign domiciled parties are represented, then for a represented party the domicile question should not be an issue," she says. "Requesting documents and proof of immigration status for a represented party would likely lead to unnecessary expenses and time."

## PO box consequences

As well as concerns over the domicile proof, Pelton spoke further about the "other unintended consequences" from the new guidelines – especially around the use of certain addresses on trademark applications. "Many applicants may not have a business address and could be forced to list their home address," he says. "This impacts small businesses in particular, which are much more likely to be run out of the owner's home. Furthermore, will private mailboxes – such as a shared office space at Regus or a registered agent's address – be acceptable? It is possible that the rule will disincentivize some potential applicants from filing trademark applications because they would have to list their home address, or spend more money to get a different address, or because they don't have a permanent physical address. That could raise access-to-justice issues."

Such question marks are a concern for Ottaviani, who says "many people in the US have PO boxes for entirely legitimate reasons", expanding: "For example, students and young professionals living in cities rent apartments on an annual basis and want a more permanent address for mailing purposes. Secondly, some professionals and businesses do not have a business office and work from home or a shared office space and use a PO box for the business address in order to look more professional or to shield their home address from clients/customers. Thirdly, domestic violence victims often use PO boxes and do not disclose their home address for fear of being victimized again. Ultimately, there is no need for the USPTO to become involved in requiring disclosure of the physical addresses, and in some cases, such disclosure could cause harm."

Indeed, Pelton sees irony in the guidelines' stance towards PO boxes. "The USPTO itself uses a PO box for correspondence, it is even included as the location for written comments to have been submitted regarding the proposed foreign counsel rulemaking," he says. "Overall, PO boxes can be quite valuable; in fact, our law firm has used the same box for more than a decade for USPTO paper correspondence because changing addresses for many records when the office moves can be burdensome and difficult, and because the USPTO's various systems do not always reflect the most recent address change filings."

### What next?

As the reality emerges of what the USPTO's new rules mean for trademark applicants and registrants, the experts we spoke with believe that some elements of the guidelines should be cleared up. For example, Eliseeva hopes that "the issue equating US domicile with a specific immigration status will be corrected and clarifications will be made", and also wishes for "a clarification that foreign applicants/registrants represented by a US licensed attorney do not need to get into things like proving their immigration status in the US and documents proving their residence address". Pelton, meanwhile, hopes that the office "will re-examine the specifics of the rule and suggest a public roundtable featuring stakeholders with a variety of perspectives to be held in the near future".

Without stakeholder dialogue to clear up these issues, Ottaviani says the USPTO could face problems down the line: "When the new rules were proposed, it said nothing about requiring applicants to state their domicile or principal place of business. The requirement was added when the new rule was promulgated, and then expanded upon when the USPTO issued its guidelines to examiners earlier this month. Therefore, trademark practitioners and the public have not been given any input into the rule and the unintended consequences it may cause. In my opinion, then, the USPTO may be on shaky legal ground unless until it follows the proper rule-making procedure."

According to Whipple, there are many eyes focused on the work of the USPTO, and any unforeseen wrongdoings will be identified – eventually. "Onerous requirements not supported by law *could* be imposed on legal residents and foreign nationals," he states. "However, I don't see that happening for multiple reasons – but there are a lot of people who do statistical analysis of USPTO processes and by some coincidence, many of them are lawyers. Therefore, so long as the grounds for rejection are part of the public record, it will become apparent if the registry is doing something inappropriate."

*Following publication of this article, USPTO spokesperson Paul Fucito told WTR: "The Lanham Act has required all trademark applicants to provide their citizenship and domicile since 1946. The new rule has just recently issued, and we continue to assess revisions to the examiner guidance."*



# EXHIBIT 14

## Examination Guide 4-19 (Revised)

### Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants and Registrants

September 2019

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On July 2, 2019, the United States Patent and Trademark Office (USPTO) published a final rule (*Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, 84 FR 31498) requiring applicants, registrants, or parties to a trademark proceeding whose domicile is not located within the United States (U.S.) or its territories (hereafter foreign-domiciled applicants, registrants, or parties) to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. (including the District of Columbia or any Commonwealth or territory of the U.S.) (hereafter U.S. attorney or U.S. counsel). In addition, the final rule requires U.S. attorneys to provide their bar information when representing applicants and registrants, whether domiciled inside or outside the U.S. It also removes the ability of foreign patent attorneys or agents to seek reciprocal recognition to practice before the USPTO in trademark matters. The changes became effective August 3, 2019 and supersede the current edition of the Trademark Manual of Examining Procedure (TMEP) to the extent any inconsistency exists.

Since issuing Examination Guide 4-19 on August 2, 2019, the USPTO has received requests for additional clarification regarding implementation of the final rule. Accordingly, the USPTO issues this revised examination guide, which supersedes all prior guidance. The USPTO continues to monitor implementation of this rule and may issue revised and/or additional guidance as needed in the future.

## **I. REQUIREMENT FOR REPRESENTATION**

The Trademark Act has long required that the “application shall include specification of the applicant’s domicile and citizenship.” 15 U.S.C. §1051(a)(2). Under the new U.S. counsel rule, domicile dictates whether an applicant or registrant is required to have an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory to represent the applicant or registrant at the USPTO. See 37 C.F.R. §§2.2(o), 2.11(a), 2.189.

Under this rule, the USPTO amended Rule 2.11 to require foreign-domiciled applicants, registrants, or parties to a trademark proceeding to be represented by a U.S. attorney. 37 C.F.R. §2.11(a). Further, the USPTO may require such applicants, registrants, or parties to furnish information or declarations necessary to the proper determination of whether the applicant, registrant, or party is subject to the requirement for a U.S. attorney. 37 C.F.R. §2.11(b).

All applications must include the applicant’s domicile address, and foreign-domiciled applicants must appoint a U.S. attorney to meet the requirements for a complete application. See 37 C.F.R. §§2.11(a), 2.32(a)(2), (a)(4), 2.189. Foreign-domiciled applicants submitting an application using the Trademark Electronic Application System (TEAS) Plus filing option will be required to designate a U.S. attorney in order to complete the submission of the application. 37 C.F.R. §2.22(a)(21).

### **A. Determining Domicile**

The term “domicile” means the “permanent legal place of residence” of a natural person or the “principal place of business” of a juristic entity. 37 C.F.R. §2.2(o). Under this rule, a person’s “permanent legal place of residence” is the place the person resides and intends to be the person’s principal home. The “principal place of business” is the location of a juristic entity’s headquarters where the entity’s senior executives or officers ordinarily direct and control the entity’s activities and is usually the center from where other locations are controlled. 37 C.F.R. §2.2(p). Applicants and registrants must provide and keep current the address of their domicile. 37 C.F.R. §§2.22(a)(1), 2.32(a)(2), 2.189.

The initial determination of whether an applicant's, registrant's, or party's domicile is within or outside the U.S. is based on its street address. In most cases, a post-office box, a "care of" (c/o) address, or other similar variation cannot be a domicile address because it generally does not identify the location of the place the person resides and intends to be the person's principal home (for a natural person) or the location of a juristic entity's headquarters where the entity's senior executives or officers ordinarily direct and control the entity's activities (for a juristic entity). When necessary, the USPTO will require an applicant or registrant to confirm its domicile address.

The USPTO will implement the following procedures under this rule.

### **1. Non-U.S. Domicile**

If a foreign address (i.e., any street address that is located outside of the United States and its territories) is listed as the domicile in any submission on or after August 3, 2019, and the applicant or registrant is not represented by a U.S. attorney, the examining attorney or post-registration specialist will issue an Office action that requires the applicant or registrant to appoint a U.S. attorney as its representative. The Office action will also include any other applicable refusals and/or requirements.

If the applicant responds, but does not appoint U.S. counsel, the examining attorney will issue a final action as to the requirement for U.S. counsel and all other unresolved refusals and/or requirements, if the file is otherwise in condition for a final action. If the registrant responds in a post-registration matter, but does not appoint U.S. counsel, the post-registration specialist will issue a second action maintaining the requirement for U.S. counsel and maintaining all prior unresolved refusals and/or requirements.

If the applicant or registrant responds by appointing U.S. counsel, the examining attorney or post-registration specialist will withdraw the requirement for U.S. counsel. If the applicant or registrant responds by amending to a U.S. street address, but does not appoint U.S. counsel, the USPTO will follow the procedures in Section I.A.2. If the applicant or registrant responds by amending to a U.S. post-office box or "care of" address or other similar variation, the USPTO will follow the procedures in Section I.A.3.

### **2. U.S. Domicile**

If a U.S. address (i.e., any street address that is located within the United States and its territories) is listed as the domicile in any submission, an applicant or registrant need not appoint a U.S. attorney as its representative.

Under some circumstances, the USPTO will require an applicant or registrant to provide documentation to support its U.S. address. For example, if the address appears incorrect, the examining attorney or post-registration specialist will issue an Office action requiring the applicant or registrant to provide documentation supporting the address as specified below. As another example, if the applicant or registrant is a foreign citizen or entity with a U.S. street address, and is **not** represented by U.S. counsel, the examining attorney or post-registration specialist will issue an Office action requiring, at the choice of the applicant or registrant, either the addition of U.S. counsel or documentation supporting the address as specified below. In such cases, the Office action will also include all other applicable refusals and/or requirements.



If the applicant or registrant responds by appointing U.S. counsel, the examining attorney or post-registration specialist will withdraw the requirement for documentation supporting the U.S. street address, unless the U.S. street address appears to be incorrect. The requirement will be reissued if the U.S. counsel withdraws or is subsequently revoked.

An applicant or registrant who provides documentation as specified below is not required to appoint U.S. counsel.

If the applicant responds but does not appoint U.S. counsel or provide the information necessary to support its U.S. street address, the examining attorney will issue a final action as to the requirements regarding domicile, U.S. counsel, and all other unresolved refusals and/or requirements, if the application is otherwise in condition for final action. If the registrant responds in a post-registration matter but does not appoint U.S. counsel or provide the information necessary to support its U.S. street address, the post-registration specialist will issue a second action maintaining the requirements regarding domicile, U.S. counsel, and all other unresolved refusals and/or requirements.

Examples of documents that can support a U.S. street address include the following:

- (a) For an individual, documentation showing the name and listed address of the individual, such as one of the following:
  - (i) a current, valid signed rental, lease, or mortgage agreement;
  - (ii) a current, valid homeowner's, renter's, or motor vehicle insurance policy; or
  - (iii) a computer-generated bill issued by a utility company dated within 60 days of the application or post-registration document filing date.
- (b) For a juristic entity, documentation showing that the address is the applicant's or registrant's business headquarters, such as one of the following:
  - (i) the most recent final annual or quarterly report or other similar report; or
  - (ii) a current certificate of good standing for the corporation or other business entity issued by a federal or state government agency.

### **3. Post-office box, "care of," and other lack of street address**

In most cases, a post-office box address, "care of" address, or similar variation cannot be a domicile address. If an applicant or registrant lists such an address as its domicile, or lacks a street address entirely, the applicant or registrant will be required to provide a street address. Alternatively, an applicant may demonstrate that the listed address is, in fact, its domicile.

The following procedures will apply to these requirements:

If an applicant lists as its domicile a post-office box address or "care of" address or similar variation, or no street address at all, the examining attorney or post registration specialist will require the applicant's or registrant's street address. 37 C.F.R. §2.32(a).

If the applicant or registrant adds a non-U.S. street address as its domicile, the USPTO will follow the procedures in Section I.A.1. If the applicant or registrant adds a U.S. street address as its domicile, the USPTO will follow the procedures in Section I.A.2.

If the applicant does not amend the listed domicile to a street address, and fails to demonstrate that the listed address is the domicile, the examining attorney will issue a final

action as to the requirements regarding domicile and all other unresolved refusals and/or requirements, if the application is otherwise in condition for final action. If the registrant does not amend the listed domicile to a street address, and fails to demonstrate that the listed address is the domicile, the post-registration specialist will issue a second action maintaining the requirements regarding domicile and all other unresolved refusals and/or requirements.

#### 4. Waiver of requirement to make domicile public

In an extraordinary situation, an individual applicant or registrant may seek a waiver of the requirement to make public their domicile address by filing a Petition to the Director. See 37 C.F.R. §2.146(a)(5) and TMEP §1708. In such cases, when filing the application or registration maintenance document, the applicant or registrant may enter "Petition" in the street address field of the TEAS form and separately file a petition to waive the requirement to make public their domicile address. If a petition is granted, the applicant or registrant must also provide an address where mail can be received. Contact the Petitions Office by email at [TMPetitionQuestion@uspto.gov](mailto:TMPetitionQuestion@uspto.gov) or by phone at 571-272-8950 for more information. Filing a petition does not extend the time for responding to an outstanding Office action or other statutory deadline.

#### 5. Multiple owners

If there are multiple owners, and one of the owners is U.S.-domiciled, a U.S. attorney is not required, unless the U.S. address appears to be incorrect.

#### 6. U.S. Government entities or federally recognized American Indian and Alaska Native tribes with U.S. street address or U.S. post-office box address

No further inquiry regarding domicile is required.

### B. Submissions that are Subject to the Requirements of the Rule

#### 1. Documents Filed Before August 3, 2019

If a new application, or an application- or registration-related document, was submitted prior to August 3, 2019, but was not examined until on or after that date, the rule requirements for domicile, U.S. attorney, and bar information will be applied as follows:

##### a. Application and Registration Documents

- If the document requires no further action by the applicant or registrant, the examining attorney or post-registration specialist will approve it without making any requirements for domicile, U.S. attorney, and/or bar information, including a statement of good standing, ***as to that filing***.
- If the examining attorney or post-registration specialist must issue a first or supplemental Office action, ***and there is already a qualified U.S. attorney of record who was appointed before August 3, 2019***, the examining attorney or post-registration specialist will not require bar information or a statement of good standing.
- If the examining attorney or post-registration specialist must issue a first or supplemental Office action, ***and there is no qualified U.S. attorney of record***, the Office action will include the requirements regarding domicile and appointment of U.S. counsel, when appropriate, per Section I.A. 37 C.F.R. §§2.11, 2.32(a)(2),

2.189. If the requirement is made in a supplemental Office action, it raises a new issue that requires a nonfinal action.

**b. Petitions, Requests for Reinstatement, or Post-publication Amendments**

If a petition, request for reinstatement, or post-publication amendment was submitted prior to August 3, 2019, but is not decided or examined until on or after August 3, 2019, the USPTO will not require appointment of a U.S. attorney as to those filings.

**c. Examiner's Amendment without Prior Authorization**

If an application filed prior to August 3, 2019 is otherwise in condition for publication on first action, or a submission filed prior to August 3, 2019 resolves all outstanding issues, but it is necessary to issue an examiner's amendment without prior authorization, the examining attorney may issue the examiner's amendment and approve for publication or issue without requiring domicile, U.S. counsel, and/or bar information. See TMEP §707.02.

**d. Partial Abandonment**

If a partial abandonment advisory was issued prior to August 3, 2019 and no response is received, the examining attorney may issue an examiner's amendment without prior authorization deleting the goods, services, and/or classes to which the refusal or requirement pertained and then approve the application for publication without requiring domicile, U.S. counsel, and/or bar information. See TMEP §707.02.

**e. Suspension**

If an application filed prior to August 3, 2019 is in condition for suspension, or a response filed prior to August 3, 2019 puts an application in condition for suspension, the examining attorney should suspend the application. If it is necessary to issue another Office action when the application is removed from suspension, the requirements for domicile, U.S. counsel, and/or bar information will be made, if appropriate, at that time. If the application is in condition for approval for publication when removed from suspension, the examining attorney will approve it for publication without making the additional requirements.

**f. TEAS Plus Status**

If the application was filed prior to August 3, 2019, it does not lose TEAS Plus status for failure to provide attorney representation and/or bar information. If the application was filed on or after August 3, 2019, and the applicant has a foreign address, the TEAS Plus form will require designation of a U.S. attorney and provision of bar information in order to meet the filing requirements for TEAS Plus. The form will also require the bar information when filed by a U.S. attorney who is representing a U.S.-domiciled applicant, because bar information is required for any TEAS Plus applicant who designates an attorney. The relevant fields require the entering of information in order to validate the TEAS Plus application. However, if the application includes clearly invalid bar information, or the bar information is later determined to be invalid, the application will lose TEAS Plus status and be subject to the processing fee.

## **2. Application and Registration Documents Filed on or after August 3, 2019**

### **a. Trademark Act Section 1 and/or Section 44**

If the USPTO receives a trademark application filed on or after August 3, 2019 by a foreign-domiciled applicant that does not include appointment of U.S. counsel, with a filing basis under Section 1 and/or Section 44, 15 U.S.C. §§1051, 1126, the examining attorney will conduct a complete review of the application and issue an Office action that includes the requirement for U.S. counsel, as well as any other refusals and/or requirements.

If, after a complete review of an application filed by a foreign-domiciled applicant, the examining attorney determines that it would otherwise be in condition for publication upon first action, the examining attorney must nevertheless issue an Office action requiring the applicant to appoint a U.S. attorney. The applicant will have six months to respond to the Office action. 37 C.F.R. §2.65(a).

To appoint or designate a U.S. attorney, or add bar information, the applicant should (1) submit a TEAS Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative form and (2) submit a TEAS response to Office action form indicating that the attorney appointment form has been submitted. Note that if the applicant is represented by a recognized Canadian trademark attorney or agent, the U.S. attorney appointment is still necessary, but the U.S. attorney cannot appear by signing a response to the Office action and must first be appointed using the TEAS Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative form *before* submitting a response to the Office action. See Section III below.

### **b. Trademark Act Section 66(a)**

Foreign-domiciled applicants who submit an application based on Section 66(a) (Madrid application), 15 U.S.C. §1141f, are also subject to the requirement to appoint a U.S. attorney. Madrid applications are initially filed with the International Bureau (IB) of the World Intellectual Property Organization and subsequently transmitted to the USPTO. There is currently no provision for designating a U.S. or any other local attorney in an application filed with the IB. Therefore, until an application submitted to the IB provides for such designation, the USPTO will not enforce the requirement to appoint a U.S. attorney prior to publication for those Madrid applications that comply with all formalities and statutory requirements when received by the USPTO, such that the application is in condition for publication upon first action.

However, if the examining attorney issues an Office action that includes any substantive refusals and/or requirements, the examining attorney will also include a requirement to appoint a U.S. attorney or otherwise follow the procedures in Sections I.A.1-I.A.5, as appropriate.

### **c. Statements of Use**

Statements of use are reviewed by the ITU/Divisional Unit to determine whether they are timely and in compliance with the minimum filing requirements listed in Rule 2.88(c). 37 C.F.R. §2.88(c); TMEP §1109.02. The USPTO will follow its current procedures regarding statements of use that are untimely. TMEP §1109.02. A statement of use filed by a foreign-domiciled applicant that does not include appointment of U.S. counsel and that is timely and meets the minimum filing requirements under Rule 2.88(c) will be referred to the examining attorney for examination on the merits. The examining attorney will conduct a complete



review of the statement of use and issue an Office action that includes the requirements regarding appointment of U.S. counsel discussed in Section I.A, as well as any other refusals and/or requirements. 37 C.F.R. §§2.11, 2.32(a)(2), 2.189.

#### **d. Post-Registration Documents**

If the USPTO receives a post-registration document under Sections 7, 8, 9, 15, or 71, 15 U.S.C. §§1057, 1058, 1059, 1065, 1141(k), filed by a foreign-domiciled registrant that does not include appointment of U.S. counsel, the post-registration specialist will examine the filing in accordance with current examination guidelines by conducting a complete review of the document and issuing an Office action that includes the requirement for domicile, and for U.S. counsel, when appropriate, as well as any other refusals and/or requirements. 37 C.F.R. §2.11(b).

#### **e. Petitions to the Director, Requests for Reinstatement, and Post-Publication Amendments**

If the USPTO receives a petition to the Director, a request for reinstatement, or a post-publication amendment filed by a foreign domiciliary, an attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that appointment of U.S. counsel is required and of any other deficiencies. The applicant or registrant will be granted 60 days to appoint U.S. counsel and to supplement the petition or request for reinstatement, as appropriate. If the applicant or registrant does not appoint U.S. counsel and submit any additional necessary information within the time allowed, the petition or request for reinstatement will be denied or the amendment will not be entered. Filing a petition does not extend the time for responding to an outstanding Office action or other statutory deadline.

### **3. Trademark Trial and Appeal Board (TTAB) Proceedings**

Regarding proceedings before the TTAB, if it is necessary to require a foreign-domiciled party to obtain a U.S. attorney, generally the TTAB will suspend the proceedings and inform the party of the time frame within which it must obtain a U.S. attorney.

### **4. Review on Petition of Requirement for a U.S. Attorney**

If the USPTO issues an Office action that (1) maintains only a requirement for U.S. counsel and/or additional information under Rule 2.11 (a), (b), and/or (c), or (2) maintains only the requirement for the TEAS Plus processing fee under Rule 2.22(c) in addition to one or all of those requirements, an applicant's or registrant's recourse for seeking review is limited to a petition to the Director under Rule 2.146. 37 C.F.R. §§2.11(f), 2.146, 2.165, 2.186, 7.40.

## **II. RECOGNITION OF REPRESENTATIVES AND REQUIREMENT FOR BAR INFORMATION**

Under amended Rules 2.22(a)(21) and 2.32(a)(4), a U.S. attorney must provide the attorney's name, postal address, email address, and bar information as a requirement for a TEAS Plus application or a complete trademark application. 37 C.F.R. §§2.22(a)(21), 2.32(a)(4). Moreover, amended Rule 2.17(b)(3) makes the requirement for bar information applicable to recognized attorneys in all trademark filings. 37 C.F.R. §2.17(b)(3). The requirement for bar information is not tied to the domicile of the applicant and is required of all attorneys representing applicants at the USPTO, except as discussed above in Section I.B.1. Bar information includes (1) the applicable U.S. state, Commonwealth, or territory,

(2) the year of admission, (3) the bar number, if applicable, and (4) a statement that the attorney is a registered and active member in good standing of the bar of the listed U.S. state, Commonwealth, or territory.

As of August 3, 2019, the majority of the TEAS forms include specific fields to enter attorney bar information for the attorney of record. The information will not be required for other appointed attorneys. If attorney bar information and/or the statement that the attorney is an active member in good standing of the referenced bar is omitted or incomplete, the examining attorney will issue an Office action requiring the bar information and/or statement of active bar membership in good standing.

In cases where bar information is required and all other outstanding issues may be resolved by examiner's amendment, the examining attorney may email or call the U.S. attorney about the outstanding issues, obtain the bar information, and ask that he or she agree to a statement of good standing, if it is not already in the record.

If bar information is obtained by examiner's amendment, the amendment will indicate only that the bar information has been completed and provided. The USPTO will not display it in the public record. Bar information entered on a TEAS form will be hidden only if it is entered in the bar information fields on the attorney information page of the form.

If a submission includes clearly invalid attorney identification information,<sup>1</sup> the examining attorney or post-registration specialist must send an email to the TM Policy mailbox. The USPTO will notify the applicant or registrant that the listed attorney does not appear to be a qualified practitioner. In such cases, correspondence must be sent directly to the applicant or registrant at the address specified in the initial application or post-registration maintenance document. Therefore, the examining attorney or post-registration specialist may be instructed to remove the attorney identification information from the correspondence section of the Trademark database and enter the applicant's or registrant's address, or the examining attorney may send a request to a legal instruments examiner to do so. In addition, for a foreign-domiciled applicant, any Office action issued must make requirements for appointment of U.S. Counsel and domicile, if applicable.

If the bar information appears valid on its face, but circumstances calling into question the veracity of the information arise, the examining attorney or post-registration specialist must (1) proceed as discussed above regarding correcting the correspondence address to that of the applicant or registrant, and (2) issue an Office action notifying the applicant or registrant that the listed attorney does not appear to be a qualified practitioner or has not consented to represent the applicant or registrant. In addition, the Office action must include a requirement for the attorney's identification information (including bar credentials) if appropriate, and a domicile requirement, as applicable.

### **III. RECIPROCAL RECOGNITION**

Foreign attorneys and agents must be granted reciprocal recognition by the USPTO pursuant to Rule 11.14(c) and (f) in order to practice before the USPTO in trademark matters. The final rule removes reciprocal recognition of foreign patent attorneys and agents to practice before the USPTO in trademark matters. 37 C.F.R. §11.14(c)(1). Additionally, the rule requires in any trademark matter where a reciprocally recognized foreign trademark

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<sup>1</sup> "Clearly invalid attorney identification information" includes, e.g., John Doe, a series of question marks or letters/numerals, a single name, the word "test," or the listed attorney does not appear to be a qualified practitioner, or the listed attorney has not consented to represent the applicant.

attorney or agent is representing an applicant, registrant, or party to a proceeding whose domicile is not in the U.S., a qualified U.S. attorney must also be appointed as the applicant's or registrant's representative who will file documents with the USPTO and with whom the USPTO will correspond. 37 C.F.R. §11.14(c)(2).

Currently, only Canadian attorneys and agents are reciprocally recognized under Rule 11.14(c)(1) and their representation is limited to applicants, registrants, and parties located in Canada (Canadians). On or after August 3, 2019, Canadian trademark attorneys and agents continue to be authorized to represent Canadian parties in trademark matters before the USPTO as additionally appointed practitioners, so long as they remain registered and in good standing in Canada and are formally reciprocally recognized by the USPTO's Office of Enrollment and Discipline (OED). Currently reciprocally recognized Canadian patent attorneys and agents may complete prosecution of an application or post-registration maintenance filing (for which they are listed as the representative) which was pending with the USPTO before August 3, 2019, but may not handle new trademark matters.

With regard to documents filed before August 3, 2019 by a reciprocally recognized Canadian trademark or patent attorney or agent in a matter for a Canadian applicant or registrant, the USPTO will follow the same procedures as those discussed above in Section I. For example:

- If the document requires no further action by the applicant or registrant, the USPTO will not require appointment of a U.S. attorney ***as to that filing***.
- If a first or supplemental Office action must be issued, the Office action will include the requirement for appointment of a U.S. attorney. If the requirement is made in a supplemental Office action, it raises a new issue that requires a nonfinal action.

With regard to trademark documents filed with the USPTO on or after August 3, 2019, Canadian applicants and registrants must appoint U.S. counsel and may also appoint a Canadian trademark attorney or agent who is formally reciprocally recognized by OED as an additional practitioner. On or after August 3, 2019, reciprocally recognized Canadian trademark attorneys and agents may:

- Prepare, sign, and file new applications (TEAS Plus applications require designation of a U.S. attorney).
- Prepare and sign other application- and registration-related submissions, including responses and other formal communications; a U.S. attorney must file the submissions with the USPTO and authorize any examiner's amendments.
- Contact the assigned examining attorney by phone or email to discuss the application status, the contents of the examining attorney's Office action, and possible responses to the Office action.
- Receive courtesy copies of USPTO communications.

# EXHIBIT 15



THE NATIONAL INTEREST | 12:36 P.M.

# Trump Blurts Out to Reporters That He Pressured Ukraine to Smear Biden

By Jonathan Chait



## RUMP: WHAT BIDEN DID WAS A DISC

**FOX NEWS ALERT**

Photo: Screenshot via Fox News

Over the past two days, President Trump has drained most of the remaining mystery from the world's least mysterious crime drama. In a series of comments to the media, the

president casually revealed that yes, he had pressured Ukraine's president to investigate Joe Biden, and yes, he had tied that demand to military aid.

An old editor of mine who once worked the police beat for a newspaper told me most murder investigations are solved with the police arriving at the crime scene to see a man holding a gun and weeping about why he did it. The political ecosystem, though, is not structured to handle such cut-and-dried scenarios. Concerns must be raised, hearings must be held, money must be followed.

Mitt Romney commendably broke ranks to denounce Trump's abuse of his authority to discredit Biden. Yet he felt it necessary to phrase his condemnation in the hypothetical. "If the President asked or pressured Ukraine's president to investigate his political rival, either directly or through his personal attorney, it would be troubling in the extreme," Romney tweeted. "Critical for the facts to come out."

*If?* The facts *have* come out! Rudy Giuliani literally told a newspaper reporter last spring that he was pressuring Ukraine's president to investigate Biden ("We're meddling in an investigation") and that he was doing so not for the U.S. government but for the personal benefit of Trump, his client. ("I'm going to give [Ukraine] reasons why they shouldn't stop [the investigation] because that information will be very, very helpful to my client and may turn out to be helpful to my government.")

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So Trump's campaign to pressure Ukraine to investigate Biden, through the grossly improper channel of his personal lawyer, was established fact. The only remaining question

was how overtly Trump used the lure of military aid to compel Ukraine's cooperation. The Washington *Post* reported a couple of weeks ago that the aid was being held up as leverage. Trump has blurted out his scheme to the media in recent days.

Trump "speaks in code," as his former fixer, Michael Cohen, testified. He avoids direct corrupt offers, but makes his intentions plain. As he revealingly told a reporter, "I did not make a statement that 'you have to do this or I'm not going to give you aid.' I wouldn't do that. I wouldn't do that." The code is Trump's plausible deniability. But in several comments, he has translated it, eliminating that deniability.

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Yesterday, a reporter asked Trump if he had mentioned the name of Joe Biden or his son in his phone call with Ukraine's president. Trump did not answer directly but did make it clear that "corruption" was his code word for his demand to investigate Biden. He also made clear that he connected the Biden investigation to aid for Ukraine:

Reporter: Can you say whether, on this call, you raised Joe Biden or his son's name with Ukraine?

Trump: Well, I don't even want to mention it, but certainly I'd have every right to. I'd have every right to. If there's corruption, and we're paying lots of money to a country, we don't want a country we're giving massive aid to to be corrupting our system, and we don't want it to be corrupt in any way.

Trump's decoding is crucial because it removes his mob-boss-like ability to give himself plausible deniability for his threats. He's making it explicit that his references to corruption in Ukraine mean investigating "bogus" charges against Biden.

Also Sunday, Trump told reporters his conversation was "largely" devoted to the subject of "corruption" — i.e., Biden:

The conversation I had was largely congratulatory, **was largely corruption**, all of the corruption taking place, was largely the fact that we don't want our people like Vice-President Biden and his son [contributing] to the corruption already in Ukraine.

Trump has previously dismissed the *Wall Street Journal* report that he repeated his demand to investigate Biden about eight times, but Trump's own account is that the conversation was "largely" devoted to this very topic!

And in remarks to reporters today, he reaffirmed his belief that it is proper to withhold aid from Ukraine to compel the country to investigate Biden (again expressed through the code of "corruption"):

It's very important to talk about corruption. If you don't talk about corruption, why would you give money to a country that you think is corrupt?

Also this morning, Giuliani refused to say if it was totally untrue that Trump had threatened to withhold aid from Ukraine:

Bartiromo: Did the president threaten to cut off aid to Ukraine?

Giuliani: No, no. That was a false story.

Bartiromo: 100 percent?

Giuliani: Well, I can't tell you if it's 100 percent.

Everybody seems to want the mystery to string out longer so Democrats can build support for impeachment and the handful of concerned Republicans can test public opinion. But what if Trump and Giuliani don't want to hide it?

*This column has been updated.*

TAGS: POLITICS THE NATIONAL INTEREST DONALD TRUMP UKRAINE SCANDAL



# EXHIBIT 16

14 Mar  
2019

## LegalForce founder takes aim at USPTO as attorneys come out in support of proposed change to representation rules

- In public comments, US attorneys overwhelmingly support proposed rule change
- Concern voiced over fraudulent specimens and misuse of US attorney information
- LegalForce founder hits out at USPTO's "callous disrespect of principles of equality"

With four days to go, a clear majority of the submitted comments on the USPTO's proposed change to representation rules have backed the suggestion that foreign trademark applicants be required to use the services of a US-qualified attorney. However, one dissenting voice is [LegalForce](#) founder Raj Abhyanker, who has doubled down on previous criticism of the office.

Last month we [reported](#) on the publication of a proposal to change federal trademark law to require foreign-domiciled trademark applicants, registrants and parties to Trademark Trial and Appeal Board (TTAB) proceedings to use an attorney who is licensed to practice law in the United States. The proposals are designed to tackle the problem posed by "foreign trademark applicants who purportedly are represented *pro se* and who are filing inaccurate and possibly fraudulent submissions that violate the Trademark Act and/or the USPTO's rules".

At time of writing there has been 28 [submissions](#), of which 23 come out in support. Amongst these submissions there are common themes and concerns. One is the need to protect the integrity of the register, with [Michael Lasky](#), founding partner of Altera Law, declaring: "Without this rule, the USPTO is largely powerless to do anything to prevent false filers from using the US trademark register like a wild west internet domain registry." [Nora A Preece](#) of Alter and Preece expands: "Without the proposed change, the field will continue to become cluttered with fraudulent registrations that are not in commercial use but which a legitimate user would have to spend thousands of dollars invalidating through cancellation... While ethical foreign filers will not welcome the additional expense of a US attorney, the costs created by misuse of our existing system is borne by all good faith trademark users regardless of where they live or whether or not they are represented."

Perhaps unsurprisingly, many of the submissions focus on the activity of filers originating in China, with one poster noting: "Some of the Chinese municipal governments are offering cash subsidies to local entities who register trademarks in other countries including the US. The amount of cash subsidies is greater than the official fee and attorney fee combined. This results in a business in which the Chinese entities are

motivated to obtain as many US trademark registrations as possible with no intention to use the marks at all. This also gives rise to Chinese agencies which do *pro se* filings for the Chinese applicants, despite the lack of experience and knowledge in US trademark practice. In many of these instances, forged specimens and materials are used."

In terms of fraudulent applications, another adds: "It is also not uncommon that these Chinese individuals and firms handle the US applications using fake identities stolen from registered US registered attorneys. Some of them even go as far as showcasing on their websites and pamphlets the names of the US registered attorneys who are unaware of their identities being stolen."

A number of submissions suggest that the USPTO goes even further, such as setting up a more secure system for filing and prosecuting trademark applications, more stringent requirements for proving the identity of the US registered attorney, or a secondary bar certification. As noted, though, there are a few submissions that oppose the suggested rule change. Of these, a number come from outside the US, with practitioners from firms in Sweden and Denmark arguing that the additional costs that would result from requiring a US attorney would result in increased costs, resulting in clients avoiding filing in the US "because of this proposed complicated requirement". Two other opposers appear to be from China (based on their email addresses), with one contending: "We consider this to be a form of trade discrimination, and... strongly demand that the existing policy be maintained."

Submissions from the US legal community will likely carry more weight than those from overseas, and in that regard there is clear backing for the proposals with one notable exception: Raj Abhyanker, the founder and shareholder in LegalForce RAPC Worldwide and Trademarkia. He has previously sent [a grievance complaint](#) to the USPTO centred on Chinese IP law firms "practicing illegally" in the United States. However, he contends that this rule change is not the answer, taking aim at the office's "misguided methods to bloat its own bureaucracy and further the monopoly of US licensed attorneys at the expense to access to justice and notions of fundamental fairness to inventors and small businesses".

He also hits out at the office's targeting of overseas applicants, stating: "The USPTO's own public comments have made it clear that the USPTO is specifically targeting applicants from certain countries, namely from China. Therefore the USPTO demonstrates a callous disrespect of fundamental principles of equality before the law and chooses to intentionally discriminate against persons and small businesses from China".

As alternatives to the proposed rule change, which Abhyanker characterises as "overbroad and burdensome", he suggests the creation of a new class of 'trademark agents' based on a qualification, mandatory self-reported CLE requirements every two years "to ensure that qualified practitioners are kept abreast of the latest changes in trademark law", the elimination of fee sharing rules for online legal marketplaces and the elimination of limits on law firm ownership rules to just lawyers.

Of course, Abhyanker has his own axe to grind. He has been involved in [a number](#) of high-profile legal actions against online filing engines – one of which, against UpCounsel, was recently resolved, with Abhyanker becoming a "significant shareholder" in the entity, which [he describes](#) as "a non-lawyer company". In his 67-page submission to the USPTO, he argues that "there is little benefit for the USPTO disciplining individual attorneys simply for the act of participating in online legal marketplaces like UpCounsel" and accuses it of utilising its Office of Discipline "to harass individual attorneys and legal innovators participating in online marketplaces such as UpCounsel by attempting to enforce fee sharing rules against solo and small firm attorneys".

He also takes issue with the office "harassing foreign trademark applicants, solo law firms and small practices while hypocritically turning a blind eye to fee sharing between BigLaw and foreign franchise

affiliates and fee sharing and non-attorney ownership rules between LegalZoom and LegalZoom UK [we have previously [reported](#) on the ongoing battle between LegalZoom and LegalForce].”

As noted, the submission period is open for four more days and, considering the weight of the submissions, the USPTO is likely to push forward with the proposed rule-changes. However, expect the battle being waged by the outspoken Abhyanker to continue.



**Trevor Little**

Editor

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## TAGS

[Online](#), [IP Offices](#), [Portfolio Management](#), [Government/Policy](#), [Law Firms](#), [Internet and Online](#), [North America](#), [United States of America](#)



# EXHIBIT 17



## **PUBLIC SUBMISSION**

March 13, 2019

**Docket:** PTO-T-2018-0021

Requirements of U.S. Licensed Attorney for Trademark Applicants and Registrants Not Domiciled in the United States.

**Comment On:** PTO-T-2018-0021-0001

Opposition on Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants.

**Document:**

Comment-Abhyanker

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### **Submitter Information**

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March 4, 2019

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## General Comment

America continues to be the shining beacon on the hill - land of opportunity, freedom and infinite possibilities. A land where the kid of immigrants can aspire to and be considered for the highest positions in the land. Where age, race or color, and national origin cannot hold you back. The march to reach equality of opportunity has been long and arduous but, no other country can match this. That is what should make us proud to be Americans every day and moment.

In contrast, the United States Patent & Trademark Office (USPTO) has embarked on misguided methods to bloat its own bureaucracy and further the monopoly of U.S. licensed attorneys at the expense to access to justice and notions of fundamental fairness to inventors and small businesses whose equal protection should be the charter for the USPTO to protect.

For a historical perspective, these protectionist methods which serve no public good have included:

1. **Disallowing non-attorney trademark agents from practicing before the USPTO.**

The USPTO has for decades permitted non attorneys who take and pass a patent bar exam and have the requisite technical education (1) prepare U.S. patent applications (2) respond to office action responses in patent matters - many of which require complex legal analysis and (3) prosecute, sign for, and file numerous documents before the USPTO on behalf of applicants.

- a. The USPTO has the power to enable non-trademark attorneys to prepare and file trademark applications just as it could with U.S. Patent Agents under the U.S. Supreme Court case "[Sperry v. Florida ex rel. Florida Bar, 373 US 379, 83 S. Ct. 1322, 10 L. Ed. 2d 428 \(1963\)](#)" See **Exhibit A**.
- b. The USPTO already has regulations in place to permit non-attorney trademark agents to prepare, file and prosecute U.S. trademarks, including [37 CFR § 11.14](#). See **Exhibit B**.

2. **Discrimination on the basis of race and national origin.** The USPTO has for decades disallowed those who are not citizens from becoming eligible for to prepare and file patent applications before it. Moreover, in its early history, the USPTO discriminated on

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the basis of race, national origin, and gender in its hiring practices. Under this backdrop, the present rulemaking expressly discriminating against a protected class of persons, namely foreign applicants for U.S. trademark rights has a discriminatory effect. Moreover, the USPTO's own public comments have made it clear that the USPTO is specifically targeting applicants from certain countries, namely from China. Therefore the USPTO demonstrates a callous disrespect of fundamental principles of equality before the law and chooses to intentionally discriminate against persons and small businesses from China.

3. **Curtailling access to justice for the poor and middle class by limiting innovative legal technology platforms to thrive.** The current regulatory structure — preventing attorneys from participating in online legal marketplaces disproportionately disadvantages low- and moderate-income groups. Simply put, there is little benefit for the USPTO disciplining individual attorneys simply for the act of participating in online legal marketplaces like UpCounsel.

The USPTO has utilized its Office of Discipline (OED) to harass individual attorneys and legal innovators participating in online marketplaces such as UpCounsel by attempting to enforce fee sharing rules against solo and small firm attorneys. Such rules are outdated and outmoded. Virtually every other industry permits incentives between online marketplaces and service provider to be aligned. Otherwise the world would have no Uber, Lyft, or AirBnB. The world is better when technology is permitted to foster through investment in businesses like UpCounsel. Without fee sharing, no prudent venture capitalist in Silicon Valley or elsewhere is willing to invest. *Why?* The incentives between the service provider and the technology platform are misaligned and quality of service suffers when there is no fee sharing.

4. **Harassing foreign trademark applicants, solo law firms and small practices while hypocritically turning a blind eye to fee sharing between BigLaw and foreign franchise affiliates and fee sharing and non-attorney ownership rules between LegalZoom and LegalZoom UK.** While focusing on solo law firms and small law firms while ignoring BigLaw and LegalZoom. BigLaw routinely shares fees with foreign franchise firms. LegalZoom fee shares with the law firm Dunlap Bennett & Ludwig PLLC (<https://www.dblawyers.com/>) for U.S. trademarks (now the largest trademark law firm in the United States as of 2018 because of its fee sharing with

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LegalZoom). In addition, LegalZoom has even bought a foreign law firm in the United Kingdom (U.K), and renamed it LegalZoom United Kingdom. LegalZoom uses this foreign law firm, which it 100% owns to hire U.S. lawyers led by “Lead Trademark Attorney” Nicholas Santucci. Yet, the USPTO hypocritically does nothing. It feels like the USPTO is a bully who selectively attacks those who cannot fight back rather than looking for large systematic solutions that will benefit consumers. Instead of modernizing rules for the Internet age, the USPTO harrasses foreign applicants, small businesses, and solo practitioners through illogical rulemaking like this and enforcing old outdated rules of the past.

It is not disputed that there exists a grave problem of troubled trademark filings from countries including China. Notably, it is the commenter here who first provided the USPTO with a detailed report of its widespread effect over one year ago (**Exhibit C**). However, the instant proposed rulemaking is NOT proportional to the needs manifested in the public record.

To combat the problem of poor filings of trademark applications, the USPTO should instead :

1. **Create mandatory free online education a new class of “Trademark Agents”** requiring QUALIFICATION examination (“Trademark Bar Exam”), administered by the USPTO to permit qualified non-attorney applicants, regardless of their national origin to become qualified to practice on behalf of others before the USPTO. Qualification standards should be (1) no previous felony record (2) at least three classes on U.S. law, one of which is on the United States Constitution, a second based on intellectual property law/overview, and a third based on U.S. trademark law. Each class should be offered to the world online and for a fee directly by the USPTO.
2. **Institute mandatory self-reported CLE requirements** every two years to ensure that qualified practitioners are kept abreast of the latest changes in trademark law. Recently, such rules were proposed for patent agents. They should logically be extended to trademark agents.

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*Requirements of U.S. Licensed Attorney for Trademark Applicants and Registrants Not Domiciled in the United States.*

March 4, 2019

Page 5

3. **Eliminate fee sharing rules for online legal marketplaces.** In its place, create a regulatory framework in which USPTO licensed attorneys can lawfully fee share with foreign law firms in the United Kingdom (some of which may not be owned by attorneys). To protect consumers, actively work with the FTC to monitor and regulate these legal marketplaces rather than try to selectively subject individual attorneys to discipline.
4. **Eliminate limits on law firm ownership rules to just lawyers.** These rules do not protect clients. They have only one effect - they hamper legal innovation through a lack of access to capital. As one author recently puts it, innovative companies go IPO and to venture capitalists, while lawyers and law firms “[gets to see the loan shark](#)” when they need capital to grow their business (**Exhibit D**).

Please consider this as my public comment and opposition to this proposed rulemaking which I believe is OVERBROAD and BURDENSOME given its objectives can be more simply achieved through mandatory legal education to reinstated TRADEMARK AGENTS as explained here. Moreover, I oppose this regulation because it is discriminatory to the poor and underrepresented, and discriminatory based on national origin in the sense it disproportionately prevents individuals in foreign countries from exercising their Constitutionally protected right of petitioning the U.S. government.

Respectfully submitted,



Raj Abhyanker, Esq.

Enclosures: As stated.

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# EXHIBIT A



Caution

As of: September 19, 2018 7:49 PM Z

## Sperry v. Fla.

Supreme Court of the United States

March 25, 1963, Argued ; May 27, 1963, Decided

No. 322

### Reporter

373 U.S. 379 \*; 83 S. Ct. 1322 \*\*; 10 L. Ed. 2d 428 \*\*\*; 1963 U.S. LEXIS 2486 \*\*\*\*; 137 U.S.P.Q. (BNA) 578

SPERRY v. FLORIDA EX REL. FLORIDA BAR

**Prior History:** [\*\*\*\*1] CERTIORARI TO THE SUPREME COURT OF FLORIDA.**Disposition:** [140 So. 2d 587](#), judgment vacated and cause remanded.

### Core Terms

Patent, practitioners, regulations, nonlawyers, Hearings, registered, applications, patent attorney, attorneys, lawyers, preparation, practicing, practice of law, authorize, administrative agency, patent application, proceedings, registration, rights, agencies, unauthorized practice of law, advertising, Inventions, inventors, license, legislative history, member of the bar, bar association, state law, qualifications

### Case Summary

#### Procedural Posture

Certiorari was granted from an order of the Supreme Court of Florida to review whether petitioner, who was registered to practice before the United States Patent Office, but not admitted to practice law before the Florida or any other bar, was able to represent clients before the United States Patent Office. Petitioner appealed the lower court order enjoining him from practicing before the Patent Office.

#### Overview

The order enjoining petitioner was vacated and remanded because it prohibited him from performing tasks which were incident to the preparation and prosecution of patent applications before the Patent Office. 35 U.S.C.S. § 31, which permitted nonlawyers to represent applicants before the Patent Office, preempted Florida law, under which the preparation and

prosecution of patent applications for others constituted the practice of law. Petitioner maintained an office in Florida, held himself out as a patent attorney, prepared patent applications, represented clients before the Patent Office, and was not a member of the bar of any state. The court held that 35 U.S.C.S. § 31 expressly permitted the Commissioner of Patents to authorize practice before the Patent Office by nonlawyers, and the Commissioner had explicitly granted such authority. Under the [Supremacy Clause](#), Florida may not deny petitioner the right to perform the functions within the scope of the federal authority.

#### Outcome

The order enjoining petitioner was vacated and remanded because it prohibited him from performing tasks which were incident to the preparation and prosecution of patent applications before the United States Patent Office. Under the [Supremacy Clause](#), federal law, which permitted nonlawyers to represent applicants before the Patent Office under 35 U.S.C.S. § 31, preempted Florida law.

### LexisNexis® Headnotes

Governments &gt; Legislation &gt; Interpretation

#### [HN1](#) [📄] Legislation, Interpretation

Under Florida law the preparation and prosecution of patent applications for others constitutes the practice of law.

Governments > State & Territorial  
Governments > Licenses



373 U.S. 379, \*379; 83 S. Ct. 1322, \*\*1322; 10 L. Ed. 2d 428, \*\*\*428; 1963 U.S. LEXIS 2486, \*\*\*\*1; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

Legal Ethics > Practice Qualifications

Congress

## [HN2](#) **State & Territorial Governments, Licenses**

A state has a substantial interest in regulating the practice of law within the state.

Constitutional Law > Supremacy Clause > General Overview

## [HN3](#) **Constitutional Law, Supremacy Clause**

The law of the state, though enacted in the exercise of powers not controverted, must yield when incompatible with federal legislation.

Constitutional Law > Congressional Duties & Powers > Copyright & Patent Clause

## [HN4](#) **Congressional Duties & Powers, Copyright & Patent Clause**

Congress has provided that the Commissioner of Patents may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, 35 U.S.C.S. § 31, and the Commissioner, pursuant to § 31, has provided by regulation that an applicant for patent may be represented by an attorney or agent authorized to practice before the Patent Office in patent cases. [37 C.F.R. § 1.31](#).

Constitutional Law > Congressional Duties & Powers > Copyright & Patent Clause

## [HN5](#) **Congressional Duties & Powers, Copyright & Patent Clause**

See 35 U.S.C.S. § 31.

Constitutional Law > Supremacy Clause > General Overview

Governments > State & Territorial Governments > Licenses

Governments > Federal Government > US

## [HN6](#) **Constitutional Law, Supremacy Clause**

A state may not enforce licensing requirements which, though valid in the absence of federal regulation, give the state's licensing board a virtual power of review over the federal determination that a person or agency is qualified and entitled to perform certain functions, or which impose upon the performance of activity sanctioned by federal license additional conditions not contemplated by Congress. No state law can hinder or obstruct the free use of a license granted under an act of Congress.

Constitutional Law > Congressional Duties & Powers > Copyright & Patent Clause

## [HN7](#) **Congressional Duties & Powers, Copyright & Patent Clause**

Registration in the Patent Office shall only entitle the persons registered to practice before the Patent Office. 37 C.F.R. § 1.341.

Constitutional Law > Congressional Duties & Powers > Copyright & Patent Clause

Legal Ethics > Unauthorized Practice of Law

Patent Law > ... > Defenses > Inequitable Conduct > General Overview

## [HN8](#) **Congressional Duties & Powers, Copyright & Patent Clause**

Recognition of any person under this section is not to be construed as sanctioning or authorizing the performance of any acts regarded in the jurisdiction where performed as the unauthorized practice of law. [37 C.F.R. § 2.12\(d\)](#).

Constitutional Law > Congressional Duties & Powers > Copyright & Patent Clause

## [HN9](#) **Congressional Duties & Powers, Copyright & Patent Clause**

For gross misconduct, the Commissioner of Patents may refuse to recognize any person as a patent agent,

373 U.S. 379, \*379; 83 S. Ct. 1322, \*\*1322; 10 L. Ed. 2d 428, \*\*\*428; 1963 U.S. LEXIS 2486, \*\*\*\*1; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

either generally or in any particular case. [35 U.S.C.S. § 6](#).

[35 U.S.C.S. § 31](#) contains sufficient standards to guide the Patent Office in its admissions policy to avoid the criticism that Congress has improperly delegated its powers to the administrative agency.

Constitutional Law > Congressional Duties & Powers > Copyright & Patent Clause

## [HN10](#) **Congressional Duties & Powers, Copyright & Patent Clause**

Any person of intelligence and good moral character may appear as the attorney in fact or agent of an applicant upon filing proper power of attorney. Rules and Directions for Proceedings in the Patent Office, § 127 (1869).

Administrative Law > Agency Rulemaking > Informal Rulemaking

## [HN11](#) **Agency Rulemaking, Informal Rulemaking**

[Section 6\(a\)](#) of the Administrative Procedure Act provides that every party shall be accorded the right to appear in person or by or with counsel or other duly qualified representative in any agency proceeding. Nothing herein shall be construed either to grant or to deny to any person who is not a lawyer the right to appear for or represent others before any agency or in any agency proceeding. [5 U.S.C.S. § 1005\(a\)](#).

Constitutional Law > Congressional Duties & Powers > Copyright & Patent Clause

## [HN12](#) **Congressional Duties & Powers, Copyright & Patent Clause**

Failure to comply with the standards of the Patent Office may result in suspension or disbarment. [35 U.S.C.S. § 32](#).

Constitutional Law > Congressional Duties & Powers > Copyright & Patent Clause

Patent Law > Remedies > Equitable Relief > Injunctions

## [HN13](#) **Congressional Duties & Powers, Copyright & Patent Clause**

## Lawyers' Edition Display

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### Summary

The Florida Bar instituted proceedings in the Supreme Court of Florida to enjoin one having an office in Florida, and registered to practice before the United States Patent Office, but not admitted to practice before the Florida or any other bar, from representing Florida clients before the Patent Office. Holding that the practitioner's conduct constituted the unauthorized practice of law within the state, the court enjoined him from preparing and prosecuting patent applications and rendering legal opinions as to patentability or infringement on patent rights. ([140 So 2d 587](#).)

On certiorari, the Supreme Court of the United States vacated the decree. In an opinion by Warren, Ch. J., expressing the unanimous views of the Court, it was held that (1) by [35 USC 31](#) the Commissioner of Patents is permitted to authorize nonlawyers to practice before the Patent Office; (2) by appropriate regulations, the Commissioner has authorized such practice by nonlawyers; and (3) a state may not impose additional restrictions on the right to practice before the Patent Office.

## Headnotes

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ERROR §1662 > mootness -- voluntary discontinuance of practice. -- > Headnote:

[LEdHNJ1](#)  [1]

On certiorari to review a state decree enjoining a lay practitioner before the Patent Office from engaging in acts alleged to constitute the unauthorized practice of law, the lay practitioner's right to refer to himself as a "patent attorney" is mooted by his voluntary discontinuance of the use of the term "attorney."

ATTORNEYS §1 > preparing patent applications -- practice

373 U.S. 379, \*379; 83 S. Ct. 1322, \*\*1322; 10 L. Ed. 2d 428, \*\*\*428; 1963 U.S. LEXIS 2486, \*\*\*\*1; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

of law. -- > Headnote:

[LEdHN\[2\]](#) [2]

Under Florida law the preparation and prosecution of patent applications for others constitutes the practice of law.

STATES §36 > practice of law -- patent applications -- state regulation. -- > Headnote:

[LEdHN\[3\]](#) [3]

A state has a substantial interest in regulating the practice of law within its borders; in the absence of federal legislation, a state can validly prohibit nonlawyers from preparing and prosecuting patent applications for others.

STATES §18 > federal legislation -- supremacy. --

> Headnote:

[LEdHN\[4\]](#) [4]

The law of a state, although enacted in the exercise of powers not controverted, must yield when incompatible with federal legislation.

PATENTS §3 > nonlawyers -- admission to practice before Patent Office. -- > Headnote:

[LEdHN\[5\]](#) [5]

By 35 USC 31, authorizing the Commissioner of Patents to "prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office," the Commissioner is expressly permitted to authorize practice before the Patent Office by nonlawyers; by prescribing regulations providing that patent applicants may be represented either by an attorney or by an agent authorized to practice before the Patent Office in patent cases ( [37 CFR 1.31](#)) and providing for the admission to practice of nonlawyer agents ( [37 CFR 1.341](#)), the Commission explicitly exercises such authority.

LICENSE §8 > STATES §25 > federal licenses -- state regulation -- additional requirements. -- > Headnote:

[LEdHN\[6\]](#) [6]

A state may not enforce licensing requirements which, although valid in the absence of federal regulation, give the state's licensing board a virtual power of review over the federal determination that a person or agency is qualified and entitled to perform certain functions, or which impose upon the performance of activity sanctioned by federal license additional conditions not contemplated by Congress.

LICENSE §8 > federal license -- obstruction by state. --

> Headnote:

[LEdHN\[7\]](#) [7]

No state law can hinder or obstruct the free use of a license granted under an act of Congress.

PATENTS §3 > registration in Patent Office -- effect. --

> Headnote:

[LEdHN\[8\]](#) [8]

Registration in the Patent Office confers a right to practice before the Office without regard to whether the state within which the practice is conducted would otherwise prohibit such conduct.

LAW §41 > nonlawyers -- practice before agency. --

> Headnote:

[LEdHN\[9\]](#) [9]

The power of administrative agencies to admit nonlawyers to practice before them, without state approval, is recognized by 6(a) of the Administrative Procedure Act ( [5 USC 1005\(a\)](#)), which provides that nothing therein shall be construed either to grant or to deny to any nonlawyer the right to appear for or represent others before any agency or in any agency proceedings.

373 U.S. 379, \*379; 83 S. Ct. 1322, \*\*1322; 10 L. Ed. 2d 428, \*\*\*428; 1963 U.S. LEXIS 2486, \*\*\*\*1; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

STATES §16 > Tenth Amendment -- federal action. --

> Headnote:

[LEdHN\[14\]](#) [14]

PATENT §5 > patents as federal rights. -- > Headnote:

[LEdHN\[10\]](#) [10]

The rights conferred by the issuance of letters patent are federal rights.

In acting within the scope of the powers delegated to the United States by the Federal Constitution, Congress does not exceed the limits of the [Tenth Amendment](#) despite the concurrent effects of its legislation upon a matter otherwise within the control of a state.

PATENT §3 > Patent Office and bar -- constitutional

authority. -- > Headnote:

[LEdHN\[11\]](#) [11]

The Patent Office and its specialized bar have been established pursuant to [Federal Constitution Article 1, 8, clauses 8](#) and 18, giving Congress the power to promote the progress of science and the useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries, and to take all steps necessary and proper to accomplish that end.

STATES §16 > powers of state judiciary -- displacement. --

> Headnote:

[LEdHN\[15\]](#) [15]

Congress' authority to act within the scope of its powers so as to displace state power is no less when the state power which it displaces would otherwise have been exercised by the state judiciary rather than by the state legislature.

ATTORNEYS §8 > Patent Office -- suspension or

disbarment. -- > Headnote:

[LEdHN\[12\]](#) [12]

Failure to comply with the Patent Office's standards of integrity may result in suspension or disbarment of one allowed to practice before the Patent Office.

LAW §47 > PATENTS §3 > sufficiency of standards --

practice by nonlawyers. -- > Headnote:

[LEdHN\[16\]](#) [16]

In 35 USC 31, authorizing the Commissioner of Patents to prescribe regulations governing the recognition and conduct of persons representing parties before the Patent Office, and to require them to show that they are of good moral character and possessed of the necessary qualifications to render "valuable service, advice, and assistance," Congress provides sufficient standards to guide the Patent Office in its admissions policy, and does not improperly delegate its powers to the Commissioner of Patents.

PATENTS §3 > lay patent practitioners -- authority. --

> Headnote:

[LEdHN\[13\]](#) [13]

A lay practitioner authorized by the Patent Office to prepare patent applications may render opinions as to the patentability of the inventions brought to him, and may also hold himself out as qualified to perform his specialized work, so long as he does not misrepresent the scope of his license.

STATES §36 > nonlawyer patent practitioners -- injunction

against practice. -- > Headnote:

[LEdHN\[17\]](#) [17]

A state has no power to enjoin a layman having an office in the state and registered to practice before the United States Patent Office from rendering opinions as to patentability or infringement on patents, or preparing or prosecuting applications for letters patent, where the



373 U.S. 379, \*379; 83 S. Ct. 1322, \*\*1322; 10 L. Ed. 2d 428, \*\*\*428; 1963 U.S. LEXIS 2486, \*\*\*\*1; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

Commissioner of Patents has explicitly exercised his authority under 35 USC 31 to permit practice before the Patent Office by nonlawyers.

## Syllabus

Petitioner is not a lawyer and has never been admitted to the Bar of any State; but, under regulations issued by the Commissioner of Patents with the approval of the Secretary of Commerce pursuant to 35 U. S. C. § 31, he has been authorized to practice before the United States Patent Office. As part of that practice, he has for many years represented patent applicants, prepared and prosecuted their applications, and advised them in connection with their applications in the State of Florida. The Florida Bar sued in the Supreme Court of Florida to enjoin the performance of these and other specified acts within the State, contending that they constituted unauthorized practice of law. *Held*:

1. Florida may not prohibit petitioner from performing within the State tasks which are incident to the preparation and prosecution of patent applications before the Patent Office. Pp. 381-402.

(a) The determination of the Supreme Court [\*\*\*\*2] of Florida that the preparation and prosecution of patent applications for others constitutes the practice of law, within the meaning of the law of that State, is not questioned. P. 383.

(b) Florida has a substantial interest in regulating the practice of law within the State, and, in the absence of federal legislation on the subject, it could validly prohibit nonlawyers from engaging in this circumscribed form of patent practice. P. 383.

(c) A federal statute, 35 U. S. C. § 31, expressly permits the Commissioner of Patents to authorize practice before the Patent Office by nonlawyers; the Commissioner has explicitly granted such authority; and Florida may not deny to those failing to meet its own qualifications the right to perform acts within the scope of the federal authority. Pp. 384-385.

(d) There cannot be read into the federal statute and regulations a condition that such practice must not be inconsistent with state law, thus leaving registered patent practitioners with the unqualified right to practice only in the physical presence of the Patent Office and in the District of Columbia, where that Office is now located. Pp. 385-387.

(e) The legislative [\*\*\*\*3] history of the statute and its predecessor provisions shows that Congress recognized that registration in the Patent Office confers a right to practice before that Office, without regard to whether the State within which the practice is conducted would otherwise prohibit such conduct. Pp. 387-402.

(f) Since patent practitioners are authorized to practice only before the Patent Office, the State maintains control over the practice of law within its borders except to the limited extent necessary for the accomplishment of the federal objectives. P. 402.

2. As so construed, 35 U. S. C. § 31 is constitutional. Pp. 403-404.

(a) By establishing the Patent Office and authorizing competent persons to assist in the preparation of patent applications, Congress has not exceeded the bounds of what is "necessary and proper" to the operation of the patent system established under [Art. I, § 8, Cl. 8, of the Constitution](#). P. 403.

(b) Having acted within the scope of the powers "delegated to the United States by the Constitution," Congress has not exceeded the limits of the [Tenth Amendment](#), despite the concurrent effects of its legislation upon a matter otherwise within [\*\*\*\*4] the control of the State. P. 403.

(c) In view of the standards prescribed in 35 U. S. C. § 31 to guide the Patent Office in its admissions policy, it cannot be said that Congress has improperly delegated its powers to the administrative agency. Pp. 403-404.

**Counsel:** Carlisle M. Moore argued the cause for petitioner. With him on the briefs were Oscar A. Mellin, LeRoy Hanscom and Jack E. Hursh.

F. Trowbridge vom Baur argued the cause for respondent. With him on the brief were Sherwood Spencer, J. Lewis Hall, Donald J. Bradshaw and John Houston Gunn.

Briefs of amici curiae, urging reversal, were filed by Solicitor General Cox, Acting Assistant Attorney General Guilfoyle, Louis F. Claiborne and Morton Hollander for the United States; by John R. Turney, D. W. Markham and Nuel D. Belnap for the Association of Interstate Commerce Commission Practitioners; by Roger Robb for the American Association of Registered Patent Attorneys and Agents; and by Arthur B. Hanson and Emmett E. Tucker, Jr. for the American Chemical Society.

373 U.S. 379, \*379; 83 S. Ct. 1322, \*\*1322; 10 L. Ed. 2d 428, \*\*\*428; 1963 U.S. LEXIS 2486, \*\*\*\*4; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

Briefs of amici curiae, urging affirmance, were filed by F. Trowbridge vom Baur, H. H. Perry, Jr., Wayland B. Cedarquist, Raymond Reisler [\*\*\*\*5] and Warren H. Resh for the American Bar Association; by Lyman Brownfield and Phillip K. Folk for numerous State Bar Associations; and by William H. Webb for the American Patent Law Association.

**Judges:** Warren, Black, Douglas, Clark, Harlan, Brennan, Stewart, White, Goldberg

**Opinion by:** WARREN

## Opinion

[\*381] [\*\*\*430] [\*\*1324] MR. CHIEF JUSTICE WARREN delivered the opinion of the Court.

[579] Petitioner is a practitioner registered to practice before the United States Patent Office. He has not been admitted to practice law before the Florida or any other bar. Alleging, among other things, that petitioner "is engaged in the unauthorized practice of law, in that although he is not a member of The Florida Bar, he nevertheless maintains an office . . . in Tampa, Florida, . . . holds himself out to the public as a Patent Attorney . . . represents Florida clients before the United States Patent Office, . . . has rendered opinions as to patentability, and . . . has prepared various legal instruments, including . . . applications and amendments to applications for letters patent, and filed same in the United States Patent Office in Washington, D. C.," the Florida Bar instituted these proceedings [\*\*\*\*6] in the Supreme Court of Florida to enjoin the performance of these and other specified acts within the State. Petitioner filed an answer in which he admitted the above allegations but pleaded as a defense "that the work performed by him for Florida citizens is solely that work which is presented to the United States Patent Office and that he charges fees solely for his work [\*382] of preparing and prosecuting patent applications and patent assignments and determinations incident to preparing and prosecuting patent applications [\*\*\*431] and assignments." Thereupon, the court granted the Bar's motion for a summary decree and permanently enjoined the petitioner from pursuing the following activities in Florida until and unless he became a member of the State Bar:

"1. using the term 'patent attorney' or holding himself out to be an attorney at law in this state in any field or phase of the law (we recognize that the respondent according

to the record before us has already voluntarily ceased the use of the word 'attorney');

"2. rendering legal opinions, including opinions as to patentability or infringement on patent rights;

"3. preparing, drafting and construing legal documents;

[\*\*\*\*7] "4. holding himself out, in this state, as qualified to prepare and prosecute applications for letters patent, and amendments thereto;

"5. preparation and prosecution of applications for letters patent, and amendments thereto, in this state; and

"6. otherwise engaging in the practice of law."

The Supreme Court of Florida concluded that petitioner's conduct constituted the unauthorized practice of law which the State, acting under its police power, could properly prohibit, and that neither federal statute nor the Constitution of the United States empowered any federal body to authorize such conduct in Florida. [140 So. 2d 587](#).

In his petition for certiorari, petitioner attacked the injunction "only insofar as it prohibits him from engaging in the specific activities . . . [referred to above], covered by his federal license to practice before the Patent Office. He does not claim that he has any right otherwise to [\*383] engage in activities that would be regarded as the practice of law." <sup>1</sup> We granted certiorari, *371 U.S. 875*, to consider the significant, but narrow, questions thus presented.

[\*\*\*\*8] [LEdHN\[2\]](#) [↑] [2] [LEdHN\[3\]](#) [↑] [3] We [\*\*1325] do not question the determination that [HN1](#) [↑] under Florida law the preparation and prosecution of patent applications for others constitutes the practice of law. [Greenough v. Tax Assessors, 331 U.S. 486](#); [Murdock v. Memphis, 20 Wall. 590](#). Such conduct inevitably requires the practitioner to consider and advise his clients as to the patentability of their inventions under

<sup>1</sup> [LEdHN\[1\]](#) [↑] [1]

Petitioner's right to refer to himself as a "Patent Attorney" has been mooted by his voluntary discontinuance of the use of the term "attorney."

373 U.S. 379, \*383; 83 S. Ct. 1322, \*\*1325; 10 L. Ed. 2d 428, \*\*\*431; 1963 U.S. LEXIS 2486, \*\*\*\*8; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

the statutory criteria, 35 U. S. C. §§ 101-103, [161](#), [171](#), as well as to consider the advisability of relying upon alternative forms of protection which may be available under state law. **[580]** It also involves his participation in the drafting of the specification and claims of the patent application, [35 U. S. C. § 112](#), which this Court long ago noted "constitute[s] one of the most difficult legal instruments to draw with accuracy," [Topliff v. Topliff](#), [145 U.S. 156](#), [171](#). **[\*\*\*\*9]** And upon rejection of the application, the practitioner may also assist in the preparation of amendments, [37 CFR §§ 1.117-1.126](#), which frequently requires written argument to establish the patentability of the claimed invention under the applicable rules of law and in light of the prior art. 37 CFR § 1.119. Nor do we doubt that [HN2](#) Florida has a substantial interest **[\*\*\*432]** in regulating the practice of law within the State and that, in the absence of federal legislation, it could validly prohibit nonlawyers from engaging in this circumscribed form of patent practice.<sup>2</sup>

**[\*384]** [LEdHN\[4\]](#) [\[4\]](#) **[\*\*\*\*10]** But [HN3](#) "the law of the State, though enacted in the exercise of powers not contravened, must yield" when incompatible with federal legislation. [Gibbons v. Ogden](#), [9 Wheat. 1](#), [211](#). [HN4](#) Congress has provided that the Commissioner of Patents "may prescribe regulations governing the *recognition* and *conduct of agents*, attorneys, or other persons representing applicants or other parties before the Patent Office," 35 U. S. C. § 31, <sup>3</sup> and the Commissioner, pursuant to § 31, has provided

<sup>2</sup> See [Königsberg v. State Bar of California](#), [366 U.S. 36](#), [40-41](#); [Schware v. Board of Bar Examiners of New Mexico](#), [353 U.S. 232](#), [239](#); [West Virginia State Bar v. Earley](#), [144 W. Va. 504](#), [109 S. E. 2d 420](#); [Gardner v. Conway](#), [234 Minn. 468](#), [48 N. W. 2d 788](#).

<sup>3</sup> Act of July 19, 1952, c. 950, § 1, 66 Stat. 795, **35 U. S. C. § 31**:

[HN5](#) "The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their

by regulation that "an applicant for patent . . . *may be represented by an attorney or agent* authorized to practice before the Patent Office in patent cases." [37 CFR § 1.31](#). (Emphasis added.) The current regulations establish two separate registers "on which are entered the names of all persons recognized as *entitled to represent applicants* before the Patent Office in the preparation and prosecution of applications for patent." 37 CFR § 1.341 **[\*\*\*\*11]**. (Emphasis added.) One register is for attorneys at law, 37 CFR § 1.341 (a), and the other is for nonlawyer "agents." 37 CFR § 1.341 (b). A person may be admitted under either category only by establishing "that he is of good moral character and of good repute and possessed of the legal and scientific and technical qualifications necessary to enable him to render applicants for patents valuable service, and is otherwise competent to advise and assist them **[\*385]** in the presentation and prosecution of their applications before the Patent Office." 37 CFR § 1.341 (c).

**[\*\*\*\*12]** [LEdHN\[5\]](#) [\[5\]](#) [LEdHN\[6\]](#) [\[6\]](#) [LEdHN\[7\]](#) [\[7\]](#) The **[\*\*1326]** statute thus expressly permits the Commissioner to authorize practice before the Patent Office by nonlawyers, and the Commissioner has explicitly granted such authority. If the authorization is unqualified, then, by virtue of the [Supremacy Clause](#), Florida may not deny to those failing to meet its own qualifications the right to perform the functions within the scope of the federal authority. [HN6](#) A State may not enforce licensing requirements which, though valid in the absence of federal regulation, give "the State's licensing board a virtual power of review over the federal determination" that a person or agency is qualified and entitled to perform certain functions,<sup>4</sup> or which impose upon the performance of activity sanctioned **[\*\*\*433]** by federal license additional conditions not contemplated by Congress.<sup>5</sup> "No State

applications or other business before the Office."

<sup>4</sup> [Miller, Inc., v. Arkansas](#), [352 U.S. 187](#), [190](#); [First Iowa Hydro-Electric Coop. v. Federal Power Comm'n](#), [328 U.S. 152](#); cf. [Castle v. Hayes Freight Lines, Inc.](#), [348 U.S. 61](#); [Cloverleaf Butter Co. v. Patterson](#), [315 U.S. 148](#).

<sup>5</sup> [Rice v. Santa Fe Elevator Corp.](#), [331 U.S. 218](#), [235-236](#); [Moran v. New Orleans](#), [112 U.S. 69](#); [Sinnot v. Davenport](#), [22 How. 227](#); [Gibbons v. Ogden](#), [9 Wheat. 1](#); [Huron Portland Cement Co. v. Detroit](#), [362 U.S. 440](#), [449](#) (dissenting opinion); cf. [Hill v. Florida](#), [325 U.S. 538](#).

373 U.S. 379, \*385; 83 S. Ct. 1322, \*\*1326; 10 L. Ed. 2d 428, \*\*\*433; 1963 U.S. LEXIS 2486, \*\*\*\*12; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

law can hinder or obstruct [\*\*\*\*13] the free use of a license granted under an act of Congress." [\*Pennsylvania v. Wheeling & B. Bridge Co.\*, 13 How. 518, 566.](#)

Respondent argues, however, that we must read into the authorization conferred by the federal statute and regulations the condition that such practice not be [\*\*\*\*14] inconsistent with state law, thus leaving registered practitioners with the unqualified right to practice only in the physical presence of the Patent Office and in the District of Columbia, where the Office is now located.

[\*386] The only language in either the statute or regulations which affords any plausible support for this view is the [581] provision in the regulations that [HN7](#) [↑] "registration in the Patent Office . . . shall only entitle the persons registered to practice before the Patent Office." 37 CFR § 1.341. Respondent suggests that the meaning of this limitation is clarified by reference to the predecessor provision, which provided that registration "shall not be construed as authorizing persons not members of the bar to practice law." [3 Fed. Reg. 2429](#). Yet the progression to the more circumscribed language without more tends to indicate that the provision was intended only to emphasize that registration in the Patent Office does not authorize the general practice of patent law, but sanctions only the performance of those services which are reasonably [\*\*\*\*15] necessary and incident to the preparation and prosecution of patent applications. That no more was intended is further shown by the contrast with the regulations governing practice before the Patent Office in trademark cases, also issued by the Commissioner of Patents. These regulations now provide that [HN8](#) [↑] "recognition of any person under this section is not to be construed as sanctioning or authorizing the performance of any acts regarded in the jurisdiction where performed as the unauthorized practice of law." [37 CFR § 2.12 \(d\)](#). The comparison is perhaps sufficiently telling. But any possible uncertainty as to the intended meaning of the Commissioner must be dispelled by the fact that when the present regulations were amended in 1948,<sup>6</sup> it was first proposed to add a provision similar to that appearing in the trademark regulations.<sup>7</sup> After

[\*\*1327] objection had been leveled [\*387] against the revision on the ground that it "indicated that the office thinks that the states have the power to circumscribe and limit the rights of patent attorneys who [\*\*\*\*434] [\*\*\*\*16] are not lawyers,"<sup>8</sup> the more sweeping language was deleted and the wording modified to its present form.

[\*\*\*\*17] Bereft of support in the regulations, respondent directs us to the legislative history of the statute to confirm its understanding that § 31 and its predecessor provisions were not designed to authorize practice not condoned by the State. Insofar as this history provides any insight [\*388] into the intent of Congress, however, we are convinced that the interpretation which respondent asks us to give the statute is inconsistent with the assumptions upon which Congress has acted for over a century.

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Patent Office under the provisions of these rules shall not be construed as authorizing persons not members of the bar to practice law or to perform any acts regarded as practicing law in the jurisdiction where performed."

<sup>8</sup> "I think I know what you mean to say, but you have not said what you mean to say. If you stopped at the end of the first clause there and said that it does not authorize the persons not members of the bar to practice law, you might be closer to being right; but, as you have written it here, you have said that patent attorneys may not do in the states things which it may be necessary for them to do in order to prosecute their claims before the Patent Office.

"In other words, you are giving it to the states to say what a patent attorney may do rather than leaving it up to the Congress and to the laws of the United States.

"I may suggest that what patent attorneys do before the Patent Office might be construed as practicing law, were it not for the fact that their particular conduct is permitted by the acts of Congress and under the rules of the Patent Office.

"The states cannot pass laws derogating from the rights of the patent attorneys as created by Congress and existing under the rules of the Patent Office. I think that the rule, as proposed, makes it possible for the states, or indicated that the Office thinks that the states have the power to circumscribe and limit the rights of patent attorneys who are not lawyers, which rights are created under the laws of Congress, and subject to the rules of the Patent Office rather than to regulation by the individual states.

"I think you would have no power to pass this particular part of your proposed rule."

Remarks of A. P. Kane, Attorney, Hearing on Proposed Revision of Rules of Practice in Patent Cases, 281-282 (Sept. 30, 1948). See also [id.](#), at pp. 319-330.

<sup>6</sup> [13 Fed. Reg. 9596](#).

<sup>7</sup> Proposed Revision of Patent Rules § 5.1, 611 O. G. Pat. Off., June 29, 1948, Supp. 8:

"Registration of attorneys and agents. . . . Registration in the



373 U.S. 379, \*388; 83 S. Ct. 1322, \*\*1327; 10 L. Ed. 2d 428, \*\*\*434; 1963 U.S. LEXIS 2486, \*\*\*\*17; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

[LEdHN/8](#)<sup>[↑]</sup> [8] Examination of the development of practice before the Patent Office and its governmental regulation reveals that: (1) nonlawyers have practiced before the Office from its inception, with the express approval of the Patent Office and to the knowledge of Congress; (2) during prolonged congressional study of unethical practices before the Patent Office, the right of nonlawyer agents to practice before the Office went unquestioned, and there was no suggestion that abuses might be curbed by state regulation; (3) despite protests of the bar, Congress in enacting the Administrative Procedure Act refused to [\*\*\*\*18] limit the right to practice before the administrative agencies to lawyers; and (4) the Patent Office has defended the value of nonlawyer practitioners while taking steps to protect the interests which a State has in prohibiting unauthorized [582] practice of law. We find implicit in this history congressional (and administrative) recognition that registration in the Patent Office confers a right to practice before the Office without regard to whether the State within which the practice is conducted would otherwise prohibit such conduct.

The power of the Commissioner of Patents to regulate practice before the Patent Office dates back to 1861, when Congress first provided that [HN9](#)<sup>[↑]</sup> "for gross misconduct he may refuse to recognize any person as [\*\*\*435] a patent agent, either generally or in any particular case . . . ." <sup>9</sup> [\*\*\*\*20] The "Rules and Directions" [\*\*1328] issued by the Commissioner in 1869 provided that [HN10](#)<sup>[↑]</sup> "any person of intelligence and good moral character may appear as the attorney in fact or agent of [\*\*\*\*19] [389] an applicant upon filing proper power of attorney." <sup>10</sup> From the outset, a substantial number of those appearing in this capacity were engineers or chemists familiar with the technical subjects to which the patent application related. "Many of them were not members of the bar. It probably never occurred to anybody that they should be." <sup>11</sup> Moreover, although a concentration of patent practitioners developed in Washington, D. C., the regulations have

provided since the reorganization of the Patent Office in 1836 that personal attendance in Washington is unnecessary and that business with the Office should be transacted in writing. <sup>12</sup> The bulk of practitioners are now scattered throughout the country, and have been so distributed for many years. <sup>13</sup> [\*\*\*\*21] As a practical matter, if [390] practitioners were not so located, and thus could not easily consult with the inventors with whom they deal, their effectiveness would often be considerably impaired. <sup>14</sup> Respondent's suggestion that practice by nonlawyers was intended to be confined to the District of Columbia thus assumes either congressional ignorance or disregard of long-established practice.

Despite the early recognition of nonlawyers by the Patent Office, these agents, not subject to the professional restraints of their lawyer brethren, were particularly responsible for the deceptive advertising and victimization of inventors which long plagued the Patent Office. <sup>15</sup> [\*\*\*\*22] To remedy these abuses, the Commissioner of Patents in 1899 first required [\*\*\*436] registration of persons practicing before the Patent Office <sup>16</sup> and, in 1918, required practitioners to obtain his prior approval of all advertising material [\*\*1329]

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<sup>12</sup> "Personal attendance of the applicant at the Patent Office, to obtain a patent, is unnecessary. The business can be done by correspondence, (free of postage) or by power of attorney." Information to Persons Having Business to Transact at the Patent Office, 8 (July 1836). In 1854, it was first provided that "all business with the office should be transacted in writing. . . ." Rules and Directions for Proceedings in the Patent Office, § 122 (Feb. 20, 1854). Compare [37 CFR § 1.2](#).

<sup>13</sup> Roster of Attorneys and Agents Registered to Practice Before the U.S. Patent Office (1958); Names and Addresses of Attorneys Practicing Before the U.S. Patent Office (1883); Testimony of T. E. Robertson, Commissioner of Patents, Hearings before House Committee on Patents on H. R. 699, 71st Cong., 2d Sess. 12. Commencing in 1848, the Commissioner for many years informed inventors that "if the services of Patent Agents are desired, able and competent persons engaged in that business can be found at their offices *in this city, and in other cities*." Information to Persons Having Business to Transact at the Patent Office, Patent Agents or Attorneys (1848). (Emphasis deleted and added.)

<sup>14</sup> See Berle, *Inventions and Their Management*, 189-190; Hoar, *Patent Tactics and Law* (3d ed.), 256-257; Woodling, *Inventions and Their Protection* (2d ed.), 289-290, 333; Rivise, *Preparation and Prosecution of Patent Applications*, § 42.

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<sup>9</sup> Act of March 2, 1861, c. 88, § 8, 12 Stat. 247; see also Act of July 8, 1870, c. 230, § 19, 16 Stat. 200, as amended, 66 Stat. 793, [35 U. S. C. § 6](#).

<sup>10</sup> Rules and Directions for Proceedings in the Patent Office, § 127 (Aug. 1, 1869).

<sup>11</sup> Letter from Edward S. Rogers, Hearings before House Committee on Patents on H. R. 5527, 70th Cong., 1st Sess. 84 (1928); cf. *Hoosier Drill Co. v. Ingels*, 15 O. G. Pat. Off. 1013; 2 Robinson, *Patents*, § 431.

373 U.S. 379, \*390; 83 S. Ct. 1322, \*\*1329; 10 L. Ed. 2d 428, \*\*\*436; 1963 U.S. LEXIS 2486, \*\*\*\*22; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

which they distributed.<sup>17</sup> It was to reach these same evils that § 31 was given much its present form when, in 1922, the statute was amended to expressly authorize the Commissioner to prescribe regulations for the recognition of agents and attorneys.<sup>18</sup>

[\*391] This modification of the statute, first [583] proposed in 1912, was designed to provide for the "creation of a patent bar" and "to require a higher standard of qualifications for registry."<sup>19</sup> Although it was brought to the attention of the House Committee on Patents that practitioners included lawyers and nonlawyers alike,<sup>20</sup> [\*\*\*\*25] it was never suggested that agents would be subject to exclusion. In fact, although the Commissioner of Patents had at one time expressed the view that Patent Office abuses could be eliminated only by restricting practice to lawyers,<sup>21</sup> [\*392] his successor concluded that such a limitation [\*\*\*\*23] would be unwise and during the

pendency of this legislation recommended to Congress against such a limitation:

"It has been suggested many times that the privilege of practising before the Office should be granted only after examination similar to examinations held for admission to the bar. It is believed that this requirement would be too severe, as many persons not specially trained in the law and without any particular educational advantages may by careful study of the practice and of the useful arts learn adequately to prosecute applications. Fundamentally knowledge of the invention is more important than knowledge of the rules and is often possessed by men of a type of mind which does [\*\*\*437] not acquire legal knowledge readily."<sup>22</sup>

Moreover, during the consideration in 1916 of another bill enacted to curb abusive advertising by patent practitioners, by prohibiting persons practicing before [\*\*1330] government agencies from using the names of government officials in their advertising literature,<sup>23</sup> the same point was made on the floor of the House:

"Mr. OGLESBY. I will say to the gentleman that a good many men appear before the Patent Office who are not admitted [\*\*\*\*24] attorneys. The commissioner stated at the hearing that he had considered the question as to whether or not anyone except a regularly admitted attorney at law should be excluded from practicing before the Patent Office, but for certain reasons thought, perhaps, he ought not to establish such a rule."<sup>24</sup>

[\*393] Disclosure that persons were falsely holding

<sup>15</sup> See Hearings before House Committee on Patents on H. R. 5527, 70th Cong., 1st Sess. 16-18; 69 Cong. Rec. 6580; Spencer, *The United States Patent Law System*, 94-96. Berle, 184-186. Compare H. R. Rep. No. 1622, 68th Cong., 2d Sess. 2-3; H. R. Rep. No. 364, 64th Cong., 1st Sess. 2; Information to Persons Having Business to Transact at the Patent Office, Patent Agents or Attorneys (1848).

<sup>16</sup> Rules of Practice in the United States Patent Office, § 17 (July 18, 1899). Compare § 17 in the edition of June 18, 1897.

<sup>17</sup> 252 O. G. Pat. Off. 967. Compare 37 CFR § 1.345.

<sup>18</sup> Act of February 18, 1922, c. 58, § 3, 42 Stat. 390. Compare Act of July 8, 1870, c. 230, § 19, 16 Stat. 200, as amended, [35 U. S. C. § 6](#), and Act of July 4, 1884, c. 181, § 5, 23 Stat. 101, [5 U. S. C. § 493](#).

<sup>19</sup> Letter from E. B. Moore, Commissioner of Patents, Hearings before House Committee on Patents on H. R. 23417, No. 1, 62d Cong., 2d Sess. 6-7. See also Hearings before House Committee on Patents on H. R. 210, 67th Cong., 1st Sess. 16; Commissioner of Patents, Annual Report, xii (1908).

<sup>20</sup> The following colloquy regarding an identical bill introduced the session before passage occurred between Congressman Himes and the Commissioner of Patents:

"Mr. HIMES. It seems to me that we should know just who the man practicing before the Patent Office happens to be. Must he be a member of the bar or are the requirements the same for the patent attorney who simply goes and gets a patent for his clients as the man that goes and practices before the Patent Office, before the Commissioner of Patents?

"Mr. ROBERTSON. The Patent Office can register anyone who shows a degree of proficiency necessary to write specifications, whether or not he is a member of the bar.

"Mr. HIMES. He must not be a member of the bar?

"Mr. ROBERTSON. He need not be a member of the bar. That is not as bad as it sounds. Some of our best practitioners are not members of the bar. They are the older line of attorneys. There are some very fine ones who have been practicing before the Patent Office 30 or 40 years who are not members of the bar, but they are honest men, and there are some of the practitioners who are members of the bar who are not honest men. So it is a very difficult thing to reach." Hearings before House Committee on Patents on H. R. 210, 67th Cong., 1st Sess. 15-16.

See also Hearings before House Committee on Patents on H. R. 5011, 5012, 7010, 66th Cong., 1st Sess. 281.

<sup>21</sup> Commissioner of Patents, Annual Report, vi (1893).

<sup>22</sup> Commissioner of Patents, Annual Report, xiv (1915).

<sup>23</sup> Act of April 27, 1916, c. 89, 39 Stat. 54.

<sup>24</sup> 53 Cong. Rec. 6313.

373 U.S. 379, \*393; 83 S. Ct. 1322, \*\*1330; 10 L. Ed. 2d 428, \*\*\*437; 1963 U.S. LEXIS 2486, \*\*\*\*24; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

themselves out to be registered patent practitioners led in 1938 to the enactment of legislation making such misrepresentation a criminal offense.<sup>25</sup> This corrective legislation was under consideration for over a decade and originally contained several other provisions, including one which would have prohibited any person "duly registered to practice in the Patent Office . . . [from holding] himself out as a patent attorney, patent lawyer, patent solicitor, or patent counselor unless he is legally admitted to practice law in the State . . . or in the District of Columbia."<sup>26</sup> During the extended consideration given the matter in both Houses of Congress, [584] the distinction between patent lawyers, who had been admitted to the bar, and nonlawyer agents, was repeatedly brought out;<sup>27</sup> [\*\*\*\*28] time and again it was made clear that the above provision was [\*\*\*\*26] not intended to restrict practice by agents, but was designed only to prevent them from labeling themselves "patent attorneys,"<sup>28</sup> as the Patent Office had theretofore permitted.<sup>29</sup> [\*\*\*\*29] [\*394] The proposed bills would not have affected [\*\*\*438] "any engineers or draftsmen from doing those things which they have always been doing before the Patent Office";<sup>30</sup> the bills sought "to bring about no change in the status of the [\*\*1331] many men now registered and *entitled to*

*practice before the Patent Office*, regardless of whether they are members of the bar or not . . . ." <sup>31</sup> (Emphasis added.) "There are quite a number of solicitors of patents who are highly qualified and who are not members of the bar, who never graduated at law and were never admitted to the bar. But this bill doesn't disqualify those men. *They can continue to qualify as patent agents.*" <sup>32</sup> (Emphasis added.) When asked "what is going to be the difference in the legal prerogatives of the agents and the others that come in," the Commissioner of Patents responded that "*their rights in the Patent Office will be exactly the same.* Their rights in the courts will be different." <sup>33</sup> [\*395] (Emphasis [\*\*\*\*27] added.) The House debates on the bill before Congress in 1930 reveal the same understanding:

"Mr. STAFFORD. . . . I was under the impression that hereafter a person in order to practice before the Patent Office must be admitted to practice before some bar of a State.

"Mr. LaGUARDIA. That is my understanding.

"Mr. PERKINS. I will correct myself. He may be admitted to act as a patent agent, but after the passage of this act no one who is not admitted to the bar generally can hold himself out to be a patent attorney, patent lawyer, patent solicitor, or patent counselor.

<sup>25</sup> Act of May 9, 1938, 52 Stat. 342; now 66 Stat. 796, **35 U. S. C. § 33**.

<sup>26</sup> This was the so-called "Cramton bill," H. R. 699, 71st Cong., 2d Sess.; H. R. 5527, 70th Cong., 1st Sess.; H. R. 5811, 69th Cong., 1st Sess.; H. R. 10735, 69th Cong., 1st Sess.; H. R. 5790, 68th Cong., 1st Sess.

<sup>27</sup> *E. g.*, 69 Cong. Rec. 6580; Hearings before Senate Committee on Patents on H. R. 5527, 70th Cong., 1st Sess. 4-7, 51; Hearings before House Committee on Patents on H. R. 699, 71st Cong., 2d Sess. 34, 49.

<sup>28</sup> *E. g.*, 69 Cong. Rec. 6580; S. Rep. No. 628, 71st Cong., 1st Sess. 4; Hearings before Senate Committee on Patents on H. R. 5527, 70th Cong., 1st Sess. 7, 59; Hearings before House Committee on Patents on H. R. 5527, 70th Cong., 1st Sess. 14-25, 28-33, 56-76, 85-100; Hearings before Senate Committee on Patents on H. R. 699, 71st Cong., 2d Sess. 3, 5, 10; Hearings before House Committee on Patents on H. R. 699, 71st Cong., 2d Sess. 2-5, 41.

<sup>29</sup> Prior to 1938, the Patent Office listed both lawyers and nonlawyers on a single register and referred to both as Patent Attorneys. The legislation which was proposed would not have prohibited nonlawyers previously registered from continuing to use this appellation. *E. g.*, H. R. Rep. No. 947, 70th Cong., 1st Sess. 4. Although the several bills containing this provision failed to gain approval (though passing the

House repeatedly), in 1938, the Commissioner, following suggestions made to him during the course of the Committee hearings, Hearings before House Committee on Patents on H. R. 5811, 69th Cong., 1st Sess. 46; Hearings before House Committee on Patents on H. R. 5527, 70th Cong., 1st Sess. 20, 26-27, established separate registers for lawyers and for nonlawyer agents, 495 O. G. Pat. Off. 715, and has since prohibited agents so registered from representing themselves to be attorneys, solicitors or lawyers. See 37 CFR §§ 1.341, 1.345. The registration of those agents previously enrolled on the single register, of whom petitioner is one, was not changed.

<sup>30</sup> S. Rep. No. 1209, 70th Cong., 1st Sess. 1.

<sup>31</sup> H. R. Rep. No. 947, 70th Cong., 1st Sess. 4; S. Rep. No. 626, 71st Cong., 2d Sess. 4; H. R. Rep. No. 728, 71st Cong., 2d Sess. 3.

<sup>32</sup> Statement of E. W. Bradford, Chairman of the Committee on Ethics of the American Patent Law Association, Hearings before House Committee on Patents on H. R. 699, 71st Cong., 2d Sess. 61.

<sup>33</sup> Hearings before House Committee on Patents on H. R. 5527, 70th Cong., 1st Sess. 15.

373 U.S. 379, \*395; 83 S. Ct. 1322, \*\*1331; 10 L. Ed. 2d 428, \*\*\*438; 1963 U.S. LEXIS 2486, \*\*\*\*27; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

"Mr. STAFFORD. A person without being a member of the bar may be registered as a patent agent to practice before the Commissioner of Patents?

"Mr. PERKINS. He may." <sup>34</sup>

Hence, during the period the 1922 statute was being considered, and prior to its readoption in 1952, <sup>35</sup> we find strong and unchallenged implications that registered agents have a right to practice before the Patent Office. The repeated efforts to assure Congress that no attempt was being made to limit this right are not without significance. Nor is it insignificant that we find no suggestion that the abuses being perpetrated by patent agents could or should be corrected by the States. To the contrary, reform was effected by the Patent Office, which now requires all practitioners to pass a rigorous [\*\*\*\*30] examination, [\*396] 37 CFR § 1.341 (c), strictly regulates their advertising, 37 CFR § 1.345, and demands that "attorneys and agents appearing [585] before the Patent Office . . . conform to the standards of ethical and professional conduct generally applicable to attorneys before the courts of the United States." 37 CFR § 1.344.

[LEdHN9\[↑\]](#) [9]Moreover, the extent to which [\*\*\*439] specialized lay practitioners should be allowed to practice before some 40-odd federal administrative agencies, including the Patent Office, received continuing attention both in and out of Congress during the period prior to 1952. <sup>36</sup> The Attorney General's Committee on Administrative Procedure which, in 1941, studied [\*\*1332] the need [\*\*\*\*31] for procedural reform in the administrative agencies, reported that

<sup>34</sup> 72 Cong. Rec. 5467.

<sup>35</sup> No changes of substance were intended by the 1952 revision. S. Rep. No. 1979, 82d Cong., 2d Sess. 4; H. R. Rep. No. 1923, 82d Cong., 2d Sess. 6.

<sup>36</sup> See Committee on Administrative Practice of the Bar Association of the District of Columbia, Report on Admission to and Control Over Practice Before Federal Administrative Agencies (1938); Survey of the Legal Profession, Standards of Admission for Practice Before Federal Administrative Agencies (1953); House Committee on Government Operations, Survey and Study of Administrative Organization, Procedure, and Practice in the Federal Agencies, 85th Cong., 1st Sess. (Comm. Print); Note, Proposed Restriction of Lay Practice Before Federal Administrative Agencies, 48 Col. L. Rev. 120.

"especially among lawyers' organizations there has been manifest a sentiment in recent years that only members of the bar should be admitted to practice before administrative agencies. The Committee doubts that a sweeping interdiction of nonlawyer practitioners would be wise . . . ." <sup>37</sup> [\*\*\*\*35] Ultimately it was provided in [§ 6 \(a\) HN11\[↑\]](#) of the Administrative Procedure Act that "every party shall be accorded the right to appear in person or by or with counsel or other duly qualified representative in any agency proceeding. . . . Nothing herein shall be construed either to grant or to deny to any person who is not a lawyer the [\*397] right to appear for or represent others before any agency or in any agency proceeding." 60 Stat. 240, [5 U. S. C. § 1005 \(a\)](#). Although the act thus disavows any intention to change the existing practice before any of the agencies, so that the right of nonlawyers to practice before each agency must be determined by reference to the statute and regulations applicable to the particular [\*\*\*\*32] agency, the history of [§ 6 \(a\)](#) contains further recognition of the power of agencies to admit nonlawyers, and again we see no suggestion that this power is in any way conditioned on the approval of the State. The Chairman of the American Bar Association's committee on administrative law testified before the House Judiciary Committee:

"A great deal of complaint has been received from two sources. Number one is the lay practitioners before the various agencies, chiefly the Interstate Commerce Commission, who are afraid something might be said that would oust them from practice. On the other hand, there is a great deal of protest from the committees on unauthorized practice of the law in various State, local, and municipal bar associations who are just as vehement in saying that these measures fail to recognize that legal procedure must be confined to lawyers. But these bills do not eliminate the lay practitioner, if the administrative agency feels they have a function to perform and desires to admit him to practice." <sup>38</sup>

<sup>37</sup> Attorney General's Committee on Administrative Procedure, Final Report, 124 (1941). Compare Commission on Organization of the Executive Branch of the Government, Report to the Congress on Legal Services and Procedure, 32-35, 40-44 (1955).

<sup>38</sup> Hearings before House Committee on the Judiciary on Federal Administrative Procedure, 79th Cong., 1st Sess. (Serial No. 19) 33-34, Legislative History of the Administrative Procedure Act, S. Doc. No. 248, 79th Cong., 2d Sess. 79-80 (hereinafter referred to as "Legislative History").



373 U.S. 379, \*397; 83 S. Ct. 1322, \*\*1332; 10 L. Ed. 2d 428, \*\*\*439; 1963 U.S. LEXIS 2486, \*\*\*\*32; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

Despite the concern of the bar associations, the Senate Judiciary Committee reported that "nonlawyers, if permitted by the agency to [\*\*\*440] practice [\*\*\*\*33] before it, are not excluded from representing interested parties in administrative [\*398] matters." <sup>39</sup> And in the House debates on this provision we find the following instructive passage:

"Mr. AUSTIN. Mr. President, before the Senator leaves that thought, I wish to ask a question. I notice . . . in the section to which the Senator is referring, this language:

"Nothing herein shall be construed either to grant or to deny to any person who is not a lawyer the right to appear for or represent others before any agency or in any agency proceeding."

" [\*\*\*1333] Is it not a fact that somewhere in the bill the distinguished Senator has reserved the right to a non-professional -- that is, a man who is not a lawyer -- to appear, if the agency having jurisdiction permits it? That is, there is a discretion permitted, is there not? For example, take a case where a scientific expert would better represent before the Commission the interests involved than would a lawyer. The right to obtain that privilege is granted in the bill somewhere, is it not?

[586] "Mr. McCARRAN. The Senator is correct; and in connection with that I wish to read from the Attorney General's comment, as follows:

[\*\*\*\*34] "This subsection does not deal with, or in any way qualify, the present power of an agency to regulate practice at its bar. It expressly provides, moreover, that nothing in the act shall be construed either to grant or to deny the right of nonlawyers to appear before agencies in a representative capacity. *Control over this matter remains in the respective agencies.*"

"That is the Attorney General's observation." <sup>40</sup> (Emphasis added.)

[\*399] It is also instructive to note that shortly after the adoption of the Administrative Procedure Act, the American Bar Association proposed the adoption of an "Administrative Practitioners Act." <sup>41</sup> [\*\*\*\*36] Though

limiting the powers of nonattorneys in respects not here relevant, the bill did provide that "authorized participation in agency proceedings" was permissible, without regard to whether the conduct constituted the practice of law in the State where performed. <sup>42</sup>

[\*\*\*\*37] Indicative [\*\*\*441] of this same general understanding, we note that every state court considering the problem prior to 1952 agreed that the authority to participate in administrative proceedings conferred by the Patent Office and by [\*400] other federal agencies was either consistent with or preemptive of state law. <sup>43</sup>

[587] [\*\*\*\*38] [LEdHN\[10\]](#)<sup>[↑]</sup> [10] [LEdHN\[11\]](#)<sup>[↑]</sup> [11] [LEdHN\[12\]](#)<sup>[↑]</sup> [12] Finally, [\*\*\*1334] regard to the underlying considerations renders it difficult to conclude that Congress would have permitted [\*401] a State to prohibit patent agents from operating within its

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Commerce Commission, 14 I. C. C. Pract. J. 491.

<sup>42</sup> "Credentials for Agents

"SEC. 6. If any agency shall find it necessary in the public interest and in the interest of parties to agency proceedings before it to authorize practice by individuals not subject to section 5 and provides by generally applicable rule therefor in any case in which the governing statute does not provide only for appearances in person or by attorney or counsel, any such individual may be admitted hereunder to practice as an agent before such agency except in proceedings pursuant to section 7 or 8 of the Administrative Procedure Act or in connection with any form of compulsory process. . . . On application, individuals subject to this section who have been individually authorized to practice before any agency, have maintained such standing, are actively engaged in practice so permitted, and are so certified by the agency with a specification of the extent to which they have been so qualified to practice and have practiced shall be given credentials enabling them to continue such practice. No agency, and nothing in this Act, shall be deemed to permit any person to practice law in any place or render service save the authorized participation in agency proceedings by holders of credentials; and no person shall hold himself out, impliedly or expressly, as otherwise authorized hereunder."

<sup>43</sup> *Chicago Bar Assn. v. Kellogg*, 338 Ill. App. 618, 88 N. E. 2d 519 (1949) (Patent Office); *Sharp v. Mida's Research Bureau*, 45 N. Y. S. 2d 690 (1943), aff'd, 48 N. Y. S. 2d 799 (1944) (Patent Office); *Schroeder v. Wheeler*, 126 Cal. App. 367, 14 P. 2d 903 (1932) (Patent Office); *People ex rel. Colorado Bar Assn. v. Erbaugh*, 42 Colo. 480, 94 P. 349 (1908) (Patent Office) (by implication); *In re New York County Lawyers Assn.* ( *In re Bercu* ), 273 App. Div. 524, 534-535, 78 N. Y. S. 2d 209, 218 (1948), aff'd, 299 N. Y. 728, 87 N. E. 2d 451 (1949)

<sup>39</sup> S. Comm. Print on S. 7, 79th Cong., 1st Sess. 10 (June 1945), Legislative History 26.

<sup>40</sup> 92 Cong. Rec. 2156, Legislative History 316-317.

<sup>41</sup> H. R. 2657, 80th Cong., 1st Sess. See Curry, Bills in Congress Sponsored by American Bar Association Seek to Prevent Nonlawyers From Practicing Before the Interstate

373 U.S. 379, \*401; 83 S. Ct. 1322, \*\*1334; 10 L. Ed. 2d 428, \*\*\*441; 1963 U.S. LEXIS 2486, \*\*\*\*38; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

boundaries had it expressly directed its attention to the problem. The rights conferred by the issuance of letters patent are federal rights. It is upon Congress that the Constitution has bestowed the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries," Art. I, § 8, cl. 8, and to take all steps necessary and proper to accomplish that end, Art. I, § 8, cl. 18, pursuant to which the Patent Office and its specialized bar have been established. The Government, appearing as *amicus curiae*, informs the Court that of the 7,544 persons registered to practice before the Patent Office in November 1962, 1,801 were not lawyers [\*\*\*\*39] and 1,687 others were not lawyers admitted [\*\*\*442] to the bar of the State in which they were practicing.<sup>44</sup> Hence, under the respondent's view, one-quarter of the present practitioners would be subject to disqualification or to relocation in the District of Columbia and another one-fourth, unless reciprocity provisions for admission to the bar of the State in which they are practicing are available to them, might be forced to relocate, apply for admission to the State's bar, or discontinue practice. The disruptive effect which [\*402] this could have upon Patent Office proceedings cannot be ignored. On the

other hand, the State is primarily concerned with protecting its citizens from unskilled and unethical practitioners,<sup>45</sup> interests which, as we [\*\*1335] have seen, the Patent Office now safeguards by testing applicants for registration, and by insisting on the maintenance of high standards of integrity. [HN12](#)<sup>[↑]</sup> Failure to comply with these standards may result in suspension or disbarment. 35 U. S. C. § 32; 37 CFR § 1.348. So [\*\*\*\*40] successful have the efforts of the Patent Office been that the Office was able to inform the Hoover Commission that "there is no significant difference between lawyers and nonlawyers either with respect to their ability to handle the work or with respect to their ethical conduct." <sup>46</sup>

Moreover, since patent practitioners are authorized [\*\*\*\*41] to practice only before the Patent Office, the State maintains control over the practice of law within its borders except to the limited extent necessary for the accomplishment of the federal objectives.<sup>47</sup>

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**Wisconsin v. Keller**, 16 Wis. 2d 377, 114 N. W. 2d 796, now pending on certiorari as No. 429, 1962 Term (I. C. C.); [Petition of Kearney](#), 63 So. 2d 630 (Fla. 1953) (Treasury and Tax Court); cf. [Marshall v. New Inventor's Club, Inc.](#), 69 O. L. Abs. 578, 117 N. E. 2d 737 (C. P. 1953) (Patent Office).

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(Treasury and Tax Court) (by implication); [Auerbacher v. Wood](#), 139 N. J. Eq. 599, 604, 53 A. 2d 800, 803 (1947), aff'd, 142 N. J. Eq. 484, 59 A. 2d 863 (1948) (N. L. R. B.); [De Pass v. B. Harris Wool Co.](#), 346 Mo. 1038, 144 S. W. 2d 146 (1940) (I. C. C.); [Blair v. Motor Carriers Service Bureau, Inc.](#), 40 Pa. D. & C. 413, 426 (1939) (I. C. C.); [Bennett v. Goldsmith](#), 280 N. Y. 529, 19 N. E. 2d 927 (1939) (Immigration Department); [Public Service Traffic Bureau, Inc., v. Haworth Marble Co.](#), 40 Ohio App. 255, 178 N. E. 703 (1931) (I. C. C.) (dictum); [In re Gibbs](#), 35 Ariz. 346, 355, 278 P. 371, 374 (1929) (Land Office) (dictum); [Mulligan v. Smith](#), 32 Colo. 404, 76 P. 1063 (1904) (Land Office); see also [In re Lyon](#), 301 Mass. 30, 16 N. E. 2d 74 (1938) (bankruptcy); [Brooks v. Mandel-Witte Co.](#), 54 F.2d 992 (C. A. 2d Cir.), cert. denied, 286 U.S. 559 (1932) (Customs Court). Compare [Lowell Bar Assn. v. Loeb](#), 315 Mass. 176, 184-185, 52 N. E. 2d 27, 33-34 (1943) (Treasury and Tax Court).

Normally, the state courts have deemed the authority granted by the federal agency to be closely circumscribed. *E. g.*, [Chicago Bar Assn. v. Kellogg](#), *supra*; [In re Lyon](#), *supra*; [Public Service Traffic Bureau, Inc., v. Haworth Marble Co.](#), *supra*.

In recent years divergence in opinion has developed. Compare [Battelle Memorial Inst. v. Green](#), 133 U. S. P. Q. 49 (Ohio Ct. App. 1962) (Patent Office), and [Noble v. Hunt](#), 95 Ga. App. 804, 99 S. E. 2d 345 (1957) (Treasury and Tax Court), with [Agran v. Shapiro](#), 127 Cal. App. 2d Supp. 807, 273 P. 2d 619 (App. Dept. Super. Ct., 1954) (Treasury);

State courts have frequently held practice before state administrative agencies by nonlawyers to constitute the unauthorized practice of law. *E. g.*, [People ex rel. Chicago Bar Assn. v. Goodman](#), 366 Ill. 346, 8 N. E. 2d 941, 111 A. L. R. 1, cert. denied, 302 U.S. 728; [Clark v. Austin](#), 340 Mo. 467, 101 S. W. 2d 977. But compare [State ex rel. Reynolds v. Dinger](#), 14 Wis. 2d 193, 109 N. W. 2d 685; [Realty Appraisals Co. v. Astor-Broadway Holding Corp.](#), 5 App. Div. 2d 36, 169 N. Y. S. 2d 121.

<sup>44</sup> Of the 73 patent practitioners in Florida, 62 are not members of the Florida Bar.

<sup>45</sup> [Hexter Title & Abstract Co. v. Grievance Committee](#), 142 Tex. 506, 509, 179 S. W. 2d 946, 948; [Lowell Bar Assn. v. Loeb](#), 315 Mass. 176, 180, 52 N. E. 2d 27, 31. Commission on Organization of the Executive Branch of the Government, Report of the Task Force on Legal Services and Procedure, Part VI, Appendices and Charts, 169 (1955).

<sup>46</sup> *Id.*, 158. The Patent Office noted the qualification that nonlawyers are able to advertise. Compare Hearings before House Committee on Patents on H. R. 5527, 70th Cong., 1st Sess. 16-19, 71-72, 89, 90.

<sup>47</sup> [LEdHN13](#)<sup>[↑]</sup> [13]

Because of the breadth of the injunction issued in this case,

373 U.S. 379, \*402; 83 S. Ct. 1322, \*\*1335; 10 L. Ed. 2d 428, \*\*\*442; 1963 U.S. LEXIS 2486, \*\*\*\*41; 137 U.S.P.Q. (BNA) 578, \*\*\*\*\*578

powers to the administrative [\*404] agency. [\*\*\*\*44] Fahey v. Mallonee, 332 U.S. 245; Curran v. Wallace, 306 U.S. 1, 16-18.

[\*403] LEdHN[14] [↑] [14] LEdHN[15] [↑] [15] [\*\*\*\*42] LEdHN[16] [↑] [16] We have not overlooked respondent's constitutional arguments, but find them singularly without merit. We have already noted the source of Congress' power to grant patent rights. It has never been doubted that the establishment of the Patent Office to process patent applications is appropriate and plainly adapted to the end of securing to inventors the exclusive right to their discoveries, nor can it plausibly be suggested that by taking steps to authorize competent persons to assist in the preparation of patent applications Congress has exceeded the bounds of what is necessary and proper to the accomplishment of this same end. Cf. Goldsmith v. United States Board of Tax Appeals, 270 U.S. 117; United States v. Duell, 172 U.S. 576. Congress having acted within the scope of [\*\*\*443] the powers "delegated to the United States by the Constitution," it has not exceeded the limits of the Tenth Amendment despite the concurrent effects of its legislation upon a matter otherwise within the control of [\*\*\*\*43] the State. "Interference with the power of the States was no constitutional criterion of the power of Congress. If the power was not given, Congress could not exercise it; if given, they might exercise it, although it [588] should interfere with the laws, or even the Constitution of the States." II Annals of Congress 1897 (remarks of Madison). The Tenth Amendment "states but a truism that all is retained which has not been surrendered." United States v. Darby, 312 U.S. 100, 124; Case v. Bowles, 327 U.S. 92, 102. Compare Miller, Inc., v. Arkansas, 352 U.S. 187. The authority of Congress is no less when the state power which it displaces would otherwise have been exercised by the state judiciary rather than by the state legislature. Cf. Pennsylvania R. Co. v. Public Service Comm'n, 250 U.S. 566. Finally, § 31 HN13 [↑] contains sufficient standards to guide the Patent Office in its admissions policy to avoid the criticism that Congress has improperly delegated its

[\*\*1336] LEdHN[17] [↑] [17] It follows that the order enjoining petitioner must be vacated since it prohibits him from performing tasks which are incident to the preparation and prosecution of patent applications before the Patent Office. The judgment below is vacated and the case is remanded for further proceedings not inconsistent with this opinion.

*It is so ordered.*

## References

### Annotation References:

1. What amounts to practice of law. 111 ALR 19, 125 ALR 1173, 151 ALR 781.
2. Construction and application of Administrative Procedure Act. 94 L ed 631, 95 L ed 473, 97 L ed 884.

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End of Document

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we are not called upon to determine what functions are reasonably within the scope of the practice authorized by the Patent Office. The Commissioner has issued no regulations touching upon this point. We note, however, that a practitioner authorized to prepare patent applications must of course render opinions as to the patentability of the inventions brought to him, and that it is entirely reasonable for a practitioner to hold himself out as qualified to perform his specialized work, so long as he does not misrepresent the scope of his license.

# EXHIBIT B



# 37 CFR § 11.14 - Individuals who may practice before the Office in trademark and other non-patent matters.

[CFR](#)[prev](#) | [next](#)

## § 11.14 Individuals who may practice before the [Office](#) in trademark and other non-patent matters.

**(a) Attorneys.** Any individual who is an attorney as defined in [§ 11.1](#) may represent others before the [Office](#) in trademark and other non-patent matters. An attorney is not required to apply for [registration](#) or recognition to practice before the [Office](#) in trademark and other non-patent matters. [Registration](#) as a patent [practitioner](#) does not itself entitle an individual to practice before the [Office](#) in trademark matters.

**(b) Non-lawyers.** Individuals who are not attorneys are not recognized to practice before the [Office](#) in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the [Office](#) in trademark matters under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the [Office](#) in trademark matters. Except as provided in the preceding sentence, [registration](#) as a patent agent does not itself entitle an individual to practice before the [Office](#) in trademark matters.

**(c) Foreigners.** Any foreign attorney or agent not a resident of the [United States](#) who shall file a written application for reciprocal recognition under [paragraph \(f\)](#) of this section and prove to the satisfaction of the [OED Director](#) that he or she is registered or in good standing before the patent or trademark [office](#) of the country in which he or she resides and practices and is possessed of [good moral character and reputation](#), may be recognized for the limited purpose of representing parties located in such country before the [Office](#) in the presentation and prosecution of trademark matters, provided: the patent or trademark [office](#) of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the [Office](#). Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

**(d)** Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.

**(e)** No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the [Office](#) in trademark matters on behalf of a client. Any individual may appear in a trademark or other non-patent matter in his or her own behalf. Any individual may appear in a trademark matter for:

- (1)** A firm of which he or she is a member,
- (2)** A partnership of which he or she is a [partner](#), or
- (3)** A corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the [Office](#).

**(f) Application for reciprocal recognition.** An individual seeking reciprocal recognition under [paragraph \(c\)](#) of this section, in addition to providing [evidence](#) satisfying the provisions of [paragraph \(c\)](#) of this section, shall apply in [writing](#) to the [OED Director](#) for reciprocal recognition, and shall pay the application fee required by [§ 1.21\(a\)\(1\)\(i\)](#) of this subchapter.

[[73 FR 47688](#), Aug. 14, 2008]

# EXHIBIT C



Monday January 29, 2018

*Via Overnight Mail*

Ms. Mary Boney Denison, Esq.  
Commissioner for Trademarks  
United States Patent and Trademark Office (USPTO)  
600 Dulany Street—Madison Building West, Room 10/A69  
Eighth Floor, 8C43-B  
Alexandria, Virginia 22314

cc:

Mr. William Covey, Esq.  
Director, Office of Enrollment and Discipline  
United States Patent and Trademark Office  
600 Dulany Street—Madison Building West  
Eighth Floor, 8C43-B  
Alexandria, Virginia 22314

The American Bar Association  
Chicago Headquarters  
321 North Clark Street  
Chicago, IL 60654  
312-988-5000

**Re: Grievance & Exhibits for UPL Violations of trademark prosecution by foreign nationals not licensed to practice before the USPTO - 25% of the Top 100 filers of U.S. Trademarks in 2017 the United States are unlicensed practitioners from China.**

**Law-inspiring™**

Dear USPTO and the American Bar Association:

This grievance is being submitted to provide additional facts and research with respect to the growing trend in 2017 of rampant unauthorized practice of law by Chinese law firms, Chinese trademark agencies, and Chinese individuals (“Unlicensed Chinese Practitioners”) with respect to U.S. trademark matters before the United States Patent & Trademark Office.

To assist the USPTO and the American Bar Association, we have conducted our own research to help identify the “real parties” of interest behind each of the following Chinese trademark agencies described herein.

## **NATURE OF GRIEVANCE**

This Grievance is brought to expose the willful, reckless and systematic acts of false and deceptive advertising and unfair competition by a Chinese trademark law firms practicing law illegally in the United States.

The Grievant (the U.S. law firm of LegalForce RAPC Worldwide P.C.) examined the Top 100 trademark filers in the United States before the United States Patent & Trademark Office in the year 2017 and ranked them (see: **Exhibit**



O). The Grievant identified a large percentage of different entities in the Top 100 ranking that are practicing law without being U.S. licensed attorneys from China, some of which using “mail drop” virtual office addresses in the United States with no local presence beyond that. This constitutes approximately 25% of the top 100 U.S. trademark filers, directly competing with licensed U.S. practitioners, that are not lawfully permitted to engage in the practice of law.

The Grievant conducted extensive research, and below summarizes our findings for each of the 25 individuals practicing law without a license from China. Upon reason and belief, each of the non-practitioners below practice U.S. trademark law covertly by selecting U.S. trademark classifications for U.S. trademark applications, writing descriptions of goods and services in English, modifying standard class selections, conducting pre-filing trademark searches, responding to U.S. trademark office actions, and waiving privacy privileges for their largely Mandarin and/or Cantonese speaking clients residing in China who, upon reason and belief, have limited English verbal and written skills given that English is not a widely spoken language in China as it is not the first language of that nation.

# **HARM TO PUBLIC INTEREST**

Through its acts of preparing and filing trademarks, Unlicensed Chinese Practitioners harm the “public interest” in that public consumers become susceptible to the risk of bad legal advice dispensed by unlicensed, un-trained, and uninformed non-lawyers.

The rules for protecting trademarks in China are very different than in the United States. There is no common law first use in commerce system in China. For this reason, the public interest is harmed because the Unlicensed Chinese Practitioners may adopt strategies for filing trademarks in the United States for marks that have no bonafide intent to use in commerce within the United States, and with fraudulent specimens of use. The World Trademark Review pointed out a number of these false specimens of use in its article in **Exhibit V**.

Since nobody affiliated with Unlicensed Chinese Practitioners are licensed attorneys in the United States, then they are necessarily a non-lawyers that operate beyond the reach of protections built into the legal profession. Because regulatory protections are built into the U.S. legal profession, but no regulatory protections are in place for Chinese online legal services practicing U.S. trademark law by

non-licensed practitioners, American consumers are worse off getting bad U.S. legal advice from LegalHoop.com Entities than from Plaintiffs.

The Plaintiffs are bound to the rules governing the legal profession and USPTO, and those rules are designed to protect consumers.

By renouncing or not being subject to the attorney-client relationship and purporting to provide legal information rather than legal advice, Unlicensed Chinese Practitioners hope to achieve two business advantages at the expense of consumers: (1) sidestepping professional responsibilities governing the legal profession and (2) avoiding liability.

The Plaintiffs' emphasize that Unlicensed Chinese Practitioners avoid the responsibilities of law practice by characterizing its services as "self-help" for pro se litigants and maintaining that the website cannot substitute for an attorney, without regard to any understandable assumptions otherwise. Unlicensed Chinese Practitioners' employees are trained to disseminate U.S. legal "advice." Despite this, if taken at face value, Unlicensed Chinese Practitioners disclaimer and privacy policy allow them to operate free from the confines of U.S. ethical rules enforceable upon attorneys.

Plaintiffs further argue that by falling outside the existing regulatory space

for legal services—where regulations are designed by and applied to licensed lawyers— Unlicensed Chinese Practitioners deny consumers redress that they would otherwise have for faulty legal advice.

For example, communications with the Unlicensed Chinese Practitioners’ website are not protected by U.S. attorney-client privilege or work product doctrine. Unlicensed Chinese Practitioners have no duty of confidentiality, which would otherwise prevent an attorney from revealing information relating to the representation to any Court within the United States. Under the existing regulatory structure, Unlicensed Chinese Practitioners also operate beyond the reach of comparable disciplinary authorities for charging an unreasonable fee or obtaining consent for representing clients with conflicts of interest.

Upon reason and belief, deceptive advertising is another particularly relevant problem for many customers using Unlicensed Chinese Practitioners. Grievants argue that if Unlicensed Chinese Practitioners were U.S. law firms, their practices would be disciplined by potential violations for communicating false or misleading information about their services.

Moreover, Unlicensed Chinese Practitioners limit their own liability for problems arising from its services in ways impermissible for practicing lawyers.



By operating outside the professional rules and from China, Unlicensed Chinese Practitioners bypass the duties of competence and diligence required of all lawyers practicing U.S. law—duties which, if violated, could give teeth to malpractice actions.

Without a U.S. licensed lawyer to fall back on, customers relying on Unlicensed Chinese Practitioners may sometimes fail to comply with jurisdiction-specific requirements, resulting in an increase of reliance on lawyers conducting post-mortem fixes to remedy problems.

## **REGULATORY SUMMARY**

Since early 2017, the United States Patent & Trademark Office USPTO has been inundated with unlicensed individuals and businesses from China representing clients before the United States Patent & Trademark Office (USPTO) in patent and trademark matters. The trend has continued to accelerate through 2017 to a point where 25% of the [top 100% trademark filing individuals in the United States in 2017 are unlicensed trademark practitioners from China](#), upon reason and belief. (**Exhibit O**). The Trademark Public Advisory Committee has also expressed interest in understanding the issues facing the USPTO from

unauthorized trademark filers. *See* OED, Statement to TPAC Regarding UPL. :

[https://www.uspto.gov/sites/default/files/about/advisory/tpac/unauthorized\\_practice\\_of-Law\\_before\\_the\\_uspto.pdf](https://www.uspto.gov/sites/default/files/about/advisory/tpac/unauthorized_practice_of-Law_before_the_uspto.pdf)

Under U.S. federal regulations, the only individuals who may represent an applicant or registrant in trademark matters before the USPTO, other than certain previously recognized trademark agents, are (1) attorneys who are licensed to practice in the United States or (2) Canadian agents or attorneys who are authorized by the USPTO to represent applicants located in Canada. *See* 37 C.F.R. §§ 2.17 and 11.1.

Otherwise, foreign attorneys and non-attorneys are not recognized to practice before the USPTO in trademark matters and therefore may not perform before the United States. Upon reason and belief, this is because of the reciprocal nature of the Canadian trademark office with USPTO with respect trademark attorneys able to practice before their offices. The State Intellectual Property Office of China (SIPO) has no similar reciprocal relationship with U.S. licensed trademark attorneys. Specifically, rule 37 C.F.R. § 11.14 states:

(c) Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is registered or in good standing before the patent or trademark office of the

country in which he or she resides and practices and is possessed of good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain. (**Exhibit S**)

Given that U.S. licensed trademark attorneys cannot practice before SIPO for their U.S. clients and formal training of differences in the rules between SIPO and the USPTO is required, Chinese attorneys and Chinese non-attorneys should not be permitted to practice before the USPTO.

The USPTO has tried to enforce their rules with respect to foreign Chinese trademark filers (**Exhibit T** and **Exhibit U**), but has fallen behind as evidenced by 25% of the trademark filers in the United States being non-licensed practitioners from just one country - China - as described in **Exhibit O**. Generally, foreign attorneys and non-attorneys are not recognized to practice before the USPTO in trademark matters and therefore may not perform any of the following actions: giving advice to an applicant or registrant in contemplation of filing a trademark application or application-related document; preparing or prosecuting an application, response, post-registration maintenance document, or other related

document; signing amendments to applications, and responses to Office actions.  
(Exhibit T).

## 1. LegalHoop.com

Liang Yong Chang (“Chang”) & Vicky Feng (“Feng”) are unlicensed individuals who assist, are responsible for, and/or are directly involved in the unauthorized practice of U.S. trademark law through the website LegalHoop.com. Neither Chang or Feng are licensed attorneys in the United States and are therefore not authorized to practice law in any state. To avert regulatory scrutiny, Feng covertly hides her true identity on all correspondence with customers of LegalHoop.com, announcing herself only through her *alibi* as “Vicky Ffs” with the email address “[vicky.f@legalhoop.com](mailto:vicky.f@legalhoop.com)”, and listing herself as “Trademark Consultant” with LegalHoop at 100 M Street, S.E., Suite 600, Washington, District Of Columbia 20003 as well as with ShnFan Intellectual Property Service Limited.  
(Exhibit A).

Upon reason and belief, “Ffs” is a fictitious last name, as Grievant are unable to identify even a single person with this last name anywhere in the world,



much less in the United States or in China through a search on Facebook and Google except the Vicky Ffs. Upon reason and belief, 100 M Street, S.E., Suite 600, Washington, District Of Columbia 20003 is a fraudulent “headquarters” office address (**Exhibit L**) associated with a postal address and no physical address for the ShnFan law firm at a Regus Virtual offices at this address (**Exhibit B**). When Grievant called Regus at this location on January 24, 2018, the receptionist mentioned that no business with the name “LegalHoop”, “Vicky Ffs”, and/or “ShnFan” had a physical office anywhere at that location now or in the past. The receptionist said that ShnFan only has a mailing drop at that Regus virtual office, with no staff, no office, and no phone at that location.

In addition, upon reason and belief, Vicky Ffs is, in fact, the assumed name and *alibi* of Vicky Feng, an “International Intellectual Property Consultant” with the Shnfan IP Law Firm in their Beijing China office (See *LinkedIn Profile*, **Exhibit C**). Vicky Feng’s role as expressed on her LinkedIn profile is to assist the Shnfan IP Law Firm with “Help with trademark, design and patent protection issues, including filing, registration, renewal, change of name and address, response to OA or opposition” (**Exhibit C**).

Similarly, Liang Yong Chang operates covertly by not listing himself

anywhere on the LegalHoop.com website or the website of ShnFan. Liang Yong Chang however is the registered contact for the domain LegalHoop.com (**Exhibit D**) and has prepared numerous U.S. trademark applications in the United States on behalf of clients in China listing his employer to be ShnFan (**Exhibit D**). Upon reason and belief, Liang Yong Chang & Vicky Feng are not a registered or bonded legal document assistant under California Business and Professions Code, sections §6400 et seq., or any other state code for legal document assistants, upon reason and belief. Upon reason and belief, Beijing Sheng Fan Network Intellectual Property Agency Ltd. (“ShnFan”) is a Chinese law firm (**Exhibit E**) which created and runs the LegalHoop.com website (**Exhibit F**). ShnFan has place of business at 23/F,B07, Hover Ind Bldg, No. 26-38, Kwai Cheong Rd, Kwai Chung Nt, Hong Kong, Tel:010-59538170, qq : 2360903284, Email: [service@shnfan.com](mailto:service@shnfan.com), and a virtual mail drop address a Regus virtual office at 100 M Street, S.E., Suite 600, Washington, District Of Columbia.

Liang Yong Chang (“Yong Chang”) is a foreign national and individual who at ShnFan runs the LegalHoop.com website with a principal place of business at C-1203-14, BLDG1, No.18, Zhongguancundonglu, Haidian Dist., Beijing, China 100000, Tel:+86-10-5953 8003FAX:+86-10-5862 9431, Email:

[2360903284@qq.com](mailto:2360903284@qq.com);suda\_lyc@163.com.

Vicky Feng (“Feng”) is a foreign national and individual who communicates with United States trademark filers through LegalHoop.com with a principal place of business at C-1203-14, BLDG1, No.18, Zhongguancundonglu, Haidian Dist., Beijing, China 100000, Tel:+86-10-5953 8003FAX:+86-10-5862 9431, Email:[vicky.f@legalhoop.com](mailto:vicky.f@legalhoop.com).

LegalHoop.com solicits, transacts and does business in United States via its website and at least one “headquarter” address (**Exhibit L**) in the District of Columbia” (a Regus office that has only a mail-drop for ShnFan, **Exhibit B**) and one disconnected mimicked toll-free U.S. telephone number “1 (200) 470-0543”

Although LegalHoop.com Entities represent that they do not practice law, this representation is false and/or misleading, upon reason and belief. Grievant requested the filing of two trademarks through LegalHoop.com for real trademarks using their real names (Raj Abhyanker and Dongxia Liu, CTO of LegalForce, Inc.). For the first mark ENTREPRENEUR, non-attorney Vicky Ffs provided legal advice that the mark was not likely registrable for class 35 based on a preliminary search (**Exhibit J**). For the second mark, NATIONALPCT, a second email was received threatening the Grievant with retaliation through cyberattacks.

Specifically, the defendants eerily threatened:

“You guys are funny, we will not waste time sending you email nor doing refund job for your tricky orders anymore. **Don't test my patience. Or ten times more orders are on the way to your employers.**” (Exhibit G).

The Grievant responded respectfully in **Exhibit H** asking for clarifications on LegalHoop.com's procedures. Instead of addressing the questions on their merits, Chang replied continuing his threats against the Grievant. (see **Exhibit H**).

Moreover, LegalHoop continues to send auto-emails to thousands of trademark correspondents in half-broken English (**Exhibit I**), attempting to deceive legal correspondents to utilize their services. These auto-emails are signed “Vicky.F / Trademark Attorney” (**Exhibit I**). Upon reason and belief, Vicky F. is another *alibi* for Vicky Feng (a.k.a. Vicky Ffs). Upon reason and belief, Vicky F. is not a trademark attorney at all but rather an “international intellectual property consultant” in the Beijing office of ShnFan (see LinkedIn profile in **Exhibit C**).

Specifically, LegalHoop.com Entities practice law when they offer U.S. trademark filing services (Exhibit I, *Section 6*) in which they offer “Preparation & filing of your trademark application with the USPTO” (**Exhibit J**).

Specifically, LegalHoop.com Entities' ads include deceptive advertising



with impossible claims on their home page LegalHoop.com such “Searching National Trademark Database of United States & China Since 1870” and “LegalHoop is one of the largest trademark search engines and intellectual property players operating in the world” when their domain was just recently registered in 2016. (**Exhibit K**). They even list a unique “1 (200)” phone number that does not ring anywhere in the United States, much less anywhere in China or the world. (**Exhibit K**).

## 2. Liu Jing

Liu Jing was the #2 largest trademark filer before the USPTO in the year 2017, with 1,429 trademarks filed in that year alone (**Exhibit O**). A quick review of USPTO TSDR records reveals her email addresses (**Exhibit M**) show her to be associated with a Chinese law firm having the website [www.simateip.com](http://www.simateip.com). This Chinese law firm has a money back guarantee if your U.S. trademark is not registered on their U.S. trademarks web page (written entirely in Chinese) as shown in **Exhibit N**. The contact information for this firm is 江苏省苏州市园区乐嘉大厦1幢3019室 ir International Trademark Room 3019, Building 1, Lejia Building, Suzhou City, Jiangsu Province, China. In contrast, their TSDR pages

list this P.O. Box : P.O. Box 2409 Suzhou City, Jiangsu Province, China, 215028.

According to the World trademark review, this address is associated with numerous Chinese individuals filing from this address. (See *chart*, **Exhibit V**).

### **3. Ying Ayala**

Ying Ayala was the #6 largest trademark filer before the USPTO in the year 2017, with 1,091 trademarks filed in that year alone (**Exhibit O**). A quick review of USPTO TSDR records reveals Ayala's email addresses (**Exhibit M**) show Ayala to have a Texas address at 2006 Chippewa Ave, Edinburg Texas 78541 with a phone number 956-577-1268. (**Exhibit P**). Upon reason and belief, Ayala is a non-lawyer. Ayala used the emails [bodoyor@126.com](mailto:bodoyor@126.com); [kimli201504@163.com](mailto:kimli201504@163.com) to file more than 1,091 trademarks before the USPTO in 2017 alone. Upon reason and belief, this person is associated with President for Ying International Trade LLC, a Domestic Limited Liability Company (LLC) in the State of Texas.

According to the World Trademark Review as of November 2017, "taking a closer look at these legal entities, many of them are difficult to track down. Ying Ayala, for example, claims to be located at an address in Edinburg in Texas, and has submitted close to 1,400 trademark applications to the USPTO so far this year.

Despite that high figure, there does not appear to be any person by that name associated with any law firm in Texas or elsewhere in the United States. The name is, though, associated with a company called Ying International Trade LLC, which appears to specialise in durable goods.” The World Trademark Review goes on to write “the correspondent email address used on Ying Ayala’s applications is also being used by a Chinese law firm, USAEU Intellectual Property Agency. There are also posts featuring the email on internet message boards searching for US IP attorneys to conduct filing work, and the email is further used by the owner of a Chinese fashion website, BadboyMart.” (**Exhibit V**).

## **4. Citus Technology llc**

Citus Technology llc is a non-individual who goes by the email [zxtdhnrft@163.com](mailto:zxtdhnrft@163.com) and was was the #8 largest trademark filer before the USPTO in the year 2017, with 929 trademarks filed in that year (**Exhibit O**). Upon reason and belief, the address listed with this company is entirely fictitious and the filer is filing from China. Specifically, the applicants are in China and it does not appear to be a legitimate company at 8 The Green Suite #5538, Dover, Delaware, 19901.

**(Exhibit Q).**

Citus Technology llc has submitted a number of likely fraudulent proofs of use, upon reason and belief. Many of his specimens seem to be “cut and paste” in Photoshop images of products found on the Internet. At least one of these examples is explained in the World Trademark Review article **(Exhibit V)**.

The World Trademark Review also explains “Also on the representative list is Citus Technology LLC, with 758 US applications originating from China, which also has no online presence (the representative email returns zero results on Google) – its cited address in Delaware appears to be the headquarters of many different small businesses.” **(Exhibit V)**.

## **5. Zhou Emei**

Zhou Emei cannot be identified as a U.S. licensed attorney and is the #9th largest trademark filer before the USPTO with 834 marks in 2017 **(Exhibit O)**. Zhou’s clients appear to be mostly in China and has the address 616 Corporate Way, Suite 2-5451, Valley Cottage, New York, 10989 with the phone 845-503-2379 and email [iplaw\\_mark@hotmail.com](mailto:iplaw_mark@hotmail.com). **(Exhibit R)**.

Emei has submitted a number of likely fraudulent proofs of use, upon reason



and belief. Many of his specimens seem to be “cut and paste” in Photoshop images of products found on the Internet. At least one of these examples is explained in the World Trademark Review article (**Exhibit V**). In addition, according to the World Trademark Review, “Meanwhile, Zou Emei – representative for 800 US trademarks this year, all originating from China – does not have an obvious online presence. However, according to court records, Emei has been involved in 50 trademark-related legal dockets in the past 18 months, some involving well-known brands including CBS, Microsoft, PepsiCo and Victoria Beckham”. (**Exhibit V**).

## **6. Ye Li Fang**

Ye Li Fang cannot be identified as a U.S. licensed attorney and is the #10th largest trademark filer before the USPTO with 834 marks in 2017 (**Exhibit O**). The clients appear to be mostly in China, and he is a non-lawyer founder of Shenzhen LPH Intellectual Property Service Co., Ltd., Tel: +86 0755-8239 9816, Fax: +86 0755-8239 9826, [admin@pto360.com](mailto:admin@pto360.com), Room 2407 Huajia Square No. 2216 Hubei Road Luohu Shenzhen upon reason and belief. It should be noted that

the World Trademark Review article in Exhibit F shows that this address is associated with a number of other names of unlicensed individuals filing U.S. trademarks from China (See *chart*, **Exhibit V**).

Ye Li Fang's website upon reason and belief is <http://www.pto360.com/contact.html>. The way this is known is that because on some of his TSDR applications, Ye Li Fang accidentally lists this correspondence information, such as in registration 4789525 for the AURSEN mark.

## **7. Alexander Dii**

Alexander Dii cannot be identified as a U.S. licensed attorney and is the #11th largest trademark filer before the USPTO with 834 marks in 2017 (**Exhibit O**). Dii's clients appear to be mostly in China, and he is a non-lawyer founder of usa eu intellectual property service 16057 Tampa Palms Blvd W, #444, Tampa, Florida, United States, 33647, 352-623-2356, Dii uses the email [alexander\\_dii@hotmail.com](mailto:alexander_dii@hotmail.com) to file before the USPTO upon reason and belief.

## **8. Yang Le**

Yang Le cannot be identified as a U.S. licensed attorney and is the #12th largest trademark filer before the USPTO with 646 marks in 2017 (**Exhibit O**). Based on his emails used on TSDR [adalyn@qifip.com](mailto:adalyn@qifip.com), Le is with this Chinese law firm : [www.qifip.com](http://www.qifip.com). Their Chinese Business Name is: 北京企凡国际知识产权代理有限公司 . We could not find a U.S. name. The translation is: Beijing QiFan International intellectual Property Agent, LLC. The interesting thing is, they are "Qi Fan", the other "Sheng Fan" operating the domain [www.legalhoop.com](http://www.legalhoop.com), the top #2 TM china is "Chao Fan". They all do similar business - TM + PCT + Copyright. The address is: 北京市朝阳区广渠路38号东区2层120室.

## 9. Xue Chaoxing

Xue Chaoxing cannot be identified as a U.S. licensed attorney and is the #14th largest trademark filer before the USPTO with 621 marks in 2017 (**Exhibit O**). Chaoxing's clients appear to be mostly in China, and he is a U.S. non-lawyer individual at 709#, Qiaodan Center, No.86, Anling, Xiamen China 361015, with a

phone +86-15280200001 and email [75213932@qq.com](mailto:75213932@qq.com); and  
[957500001@qq.com](mailto:957500001@qq.com) based on USPTO TSDR records.

## 10. Sun Ping

Sun Ping cannot be identified as a U.S. licensed attorney and is the #17th largest trademark filer before the USPTO with 546 marks in 2017 (**Exhibit O**). Peng's clients appear to be mostly in China, and Ping is a non-lawyer founder of DaFen YouHuaYuan ([www.dgxbip.com](http://www.dgxbip.com)), Ping uses the email [enquiry@dgxbip.com](mailto:enquiry@dgxbip.com); and [dh1699@foxmail.com](mailto:dh1699@foxmail.com) to file before the USPTO upon reason and belief. They have an English language website, their address and contact is found at Floor 11, Building B, Dongjinmingzuo, Pingshan District, Shenzhen, Guangdong, China, 13480683226, Alex Wei is the contact, <http://dgxbip.com/en/page/contact/contact.php>

Ping has submitted a number of likely fraudulent proofs of use, upon reason and belief. Many of his specimens seem to be “cut and paste” in Photoshop images of products found on the Internet. At least one of these examples is explained in the World Trademark Review article (**Exhibit V**).

The World Trademark Review article goes on to explain “Sun Ping has



submitted countless specimens which are a pair of headphones with a generic text tag attached to them (example 1, 2, 3, 4, 5, 6). This includes at least one instance that appears to be the same pair of distinctly-designed headphones used on two applications. Ping has also submitted specimens of jewelry with the trademark term – some of which are for well-known fashion designers (eg, Alex Perry, Koalabi) – etched into the metal (example 1, 2, 3, 4, 5). Furthermore, some of the specimens of use appear to be just stickers placed on nonassociated products, such as this one featuring a Mickey Mouse bowl (the mark in question has reached registration).” (Exhibit V).

## **11.Chen Yan Hua**

Chen Yan Hua cannot be identified as a U.S. licensed attorney and is the #22nd largest trademark filer before the USPTO with 507 marks in 2017 (**Exhibit O**). Yan Hua’s clients appear to be mostly in China, and he is a non-lawyer founder of a China trademark agency upon reason and belief, at the address Rm.1105, North Wing, Jinhua Building, No.4 QianJianTongJin, DonghuaDong Rd., Yuexiu, Guangzhou, China, 510030 Yan Hua uses the email [trademarkqds@foxmail.com](mailto:trademarkqds@foxmail.com) to file before the USPTO upon reason and belief.

## **12. Zhang Yi**

Zhang Yi cannot be identified as a U.S. licensed attorney and is the #24th largest trademark filer before the USPTO with 485 marks in 2017 (**Exhibit O**). Yi's clients appear to be mostly in China, and he is a non-lawyer founder of Huanyee Intellectual Property Agency Co., Ltd. ([www.huanyee.com](http://www.huanyee.com)), with the address Room.1636, Floor 16th, Rainbow Building, No. 3019 Central Road, Nanshan District, Shenzhen, China, 518000, +86-18033057625. Yi uses the email [huanyee@huanyee.com](mailto:huanyee@huanyee.com) to file before the USPTO upon reason and belief.

## **13. Zhang Lian Jiao**

Zhang Lian Jiao cannot be identified as a U.S. licensed attorney and is the #27th largest trademark filer before the USPTO with 436 marks in 2017 (**Exhibit O**). Jiao's clients appear to be mostly in China, and he is a non-lawyer founder of a China trademark agency believed to be at Longhua Jiedao, Donghuan 1 Lu 196#, Gonghe Xiaoqu, Hexing Dasha, 3F, 310B, Guangzhou, Guangdong. Jiao uses the email [brand.register@foxmail.com](mailto:brand.register@foxmail.com) to file before the USPTO upon reason and belief.

## **14. Kevin Chen**

Kevin Chen cannot be identified as a U.S. licensed attorney and is the #31st largest trademark filer before the USPTO with 376 marks in 2017 (**Exhibit O**). Chen's clients appear to be mostly in China, and he is a non-lawyer founder of a company with a false address listed in New York associated with the Wang law office in Flushing New York <http://www.wanglawoffice.com/>, upon reason and belief, Chen uses the email [ourwills@163.com](mailto:ourwills@163.com); and [224420436@qq.com](mailto:224420436@qq.com) to file before the USPTO upon reason and belief.

## **15. Trademark.USAEU**

"Trademark.usaeu" cannot be identified as a U.S. licensed attorney and is the #45th largest trademark filer before the USPTO with 313 marks in 2017 (**Exhibit O**). "Trademark.usaeu" clients appear to be mostly in China, and they seem to be operating the website in Chinese [www.usaeu.cn](http://www.usaeu.cn). Upon reason and belief, "Trademark.usaeu" is a non-lawyer founder of the company at this website and uses the email ID [trademark@usaeu.cn](mailto:trademark@usaeu.cn); and [service@usaeu.cn](mailto:service@usaeu.cn) to file before the USPTO upon reason and belief.

According to their About Us page Trademark.usaeu writes that they file more than 1000 trademarks using different names of Chinese nationals each year before the USPTO when they write:

美鸥网简介

美鸥网成立于 2013 年，是国内最早的亚马逊周边服务商之一，逐步发展为综合性跨境电商服务商和行业媒体，拥有华东运营中心、华南销售中心、西南售后支持中心。旗下公司包含美鸥网（深圳）传媒有限公司、美鸥网（深圳）知识产权代理有限公司、美鸥网（深圳）创业孵化有限公司、深圳美欧网贸易服务有限公司、美鸥网（昆山）贸易有限公司等。

美鸥网涉及业务包含跨境电商资讯传播、国际知识产权与税务代理、跨境电商平台中国区招商等。

美鸥网覆盖 Amazon、ebay、aliexpress 三大跨境电商平台 10 万多专业卖家，构成了国内最大的出口电商交流圈。

2015 年美鸥网累计代理提交美国商标超过 1000 件，成为国内最大的美国商标代理公司之一，2016 年美国商标总提交量突破 3000 件，欧盟商标提交量突破 1000 件，2017 年预计增长率 50% 以上，成为当之无愧行业的标杆企业。

美鸥网华东运营中心:苏州花桥经济开发区绿地总部大厦（杰座）8 号楼 703-704 室  
0512-85889493

美鸥网华南运营中心:深圳市龙华区南贤商务中心 B 座 1603 室  
0755-33153152

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Google Translation:

Founded in 2013, Mei'ou.com is one of the earliest service providers in the periphery of Amazon and has gradually developed into a comprehensive cross-border e-commerce service provider and industry media. It owns East China Operations Center, South China Sales Center and Southwest After Sales Support Center. Its subsidiaries include Meiou Network (Shenzhen) Media Co., Ltd., Mei Ou Network (Shenzhen) Intellectual Property Agency Ltd., Meiou Network (Shenzhen) Venture Incubation Co., Ltd., Shenzhen Meiou Network Trade Services Ltd., ) Trading Co., Ltd. and so on.

Meigu Network involves businesses including cross-border e-commerce information dissemination, international intellectual property and tax agency, cross-border e-commerce platform investment in China.

US gull network covering Amazon, ebay, aliexpress three major cross-border e-commerce platform more than 100,000 professional sellers, constitute the largest export e-commerce exchange.

In 2015, the cumulative agency of the USGU submitted more than 1,000 U.S. trademarks and became one of the largest U.S. trademark agencies in the country. In 2016, the total number of U.S. trademarks submitted surpassed 3,000 and the number of EU trademark filings surpassed 1,000 with a projected growth rate of 50 in 2017 % Or more, a well-deserved industry benchmarking company.

US gull network East China Operations Center: Huaqiao Economic Development Zone, Suzhou Greenland headquarters building (Jie seat) Building 8, Room 703-704  
0512-85889493

US gull network in South China Operations Center: Longhua District, Shenzhen Nanxian Business Center Room 1603, Block B  
0755-33153152"

In addition, the World Trademark Review writes "the correspondent email address used on Ying Ayala's applications (see above, #3 on this list) is also being



used by USAEU Intellectual Property Agency. There are also posts featuring the email on internet message boards searching for US IP attorneys to conduct filing work, and the email is further used by the owner of a Chinese fashion website, BadboyMart.” (**Exhibit V**).

## **16. Donald C.S.**

Donald C.S. cannot be identified as a U.S. licensed attorney and is the #48th largest trademark filer before the USPTO with 304 marks in 2017 (**Exhibit O**).

Donald C.S.’s clients appear to be mostly in China, and he is a non-lawyer founder of an unknown company with a mail drop address believed to be at 1201 N Orange St, Suite 7488 Wilmington Delaware 19801. Donald C.S. uses the email [donald-cs@outlook.com](mailto:donald-cs@outlook.com) and [donald-cs@outlook.com](mailto:donald-cs@outlook.com) to file before the USPTO upon reason and belief.

## **17. Chun-Ming Shih/Kao H. Lu**

Chun-Ming Shih cannot be identified as a U.S. licensed attorney, and is the #49th largest trademark filer before the USPTO with 303 marks in 2017 (**Exhibit**

O). Shih clients appear to be mostly in Taiwan, and he is a non-lawyer founder of HDLS IPR Services operating the website <http://www.hdgroup.com.tw/>, located at Sec.2, ZhiNan Rd., Wenshan District, Taipei City 11605, Taiwan. Shih uses the email [hdlsipr@gmail.com](mailto:hdlsipr@gmail.com) and [services.ipr@gmail.com](mailto:services.ipr@gmail.com) to file before the USPTO upon reason and belief.

## **18.Xiang Ying**

Xiang Ying cannot be identified as a U.S. licensed attorney and is the #51st largest trademark filer before the USPTO with 294 marks in 2017 (**Exhibit O**). Ying's clients appear to be mostly in China, and Ying is a non-lawyer founder of a Chinese trademark agency upon reason and belief located at 4-2204,Songde Garden, Xia Mei Lin Street,Futian District, Shenzhen, China 518000 Ying uses the email [aotumanmark@outlook.com](mailto:aotumanmark@outlook.com) to file before the USPTO upon reason and belief.

## **19.Peng Qing**

Peng Qing cannot be identified as a U.S. licensed attorney and is the #53rd largest trademark filer before the USPTO with 290 marks in 2017 (**Exhibit O**).

Qing's clients appear to be mostly in China, and he is a non-lawyer founder of a Chinese trademark agency upon reason and belief located at 4-2204, Songde Huayuan, Xiameilin Street, Futian, Shenzhen, Guangdong, China, 518000, +86-75523772027. Qing uses the email [aotumanmark@outlook.com](mailto:aotumanmark@outlook.com) to file before the USPTO upon reason and belief.

## **20. Xiaoyan Yang**

Xiaoyan Yang cannot be identified as a U.S. licensed attorney and is the #57th largest trademark filer before the USPTO with 279 marks in 2017 (**Exhibit O**). Yang's clients appear to be mostly in China, and he is a non-lawyer founder of a Chinese trademark agency with a PO Box at ASAP Postal Mail Center (<http://asappostal.com>) that Yang uses for his address with the USPTO at 333 W Garvey Ave Ste 396, in Monterey Park California 91714, upon reason and belief. Yang uses the email [memorytechcenter@hotmail.com](mailto:memorytechcenter@hotmail.com) to file before the USPTO upon reason and belief.

## **21. Hu Li Hai**

Hu Li Hai cannot be identified as a U.S. licensed attorney and is the #60th largest trademark filer before the USPTO with 269 marks in 2017 (**Exhibit O**). Hai's clients appear to be mostly in China, and he is a non-lawyer at a Chinese trademark agency called Tezhila ([www.tezhila.com](http://www.tezhila.com)) with an address at Room 725, NO.B Tianhui Bldg., Yousong Rd., Longhua District, Shenzhen, Guangdong, China, 518109. Phone: +86-18002998647. The email address used on filings is [lisa.chan@tezhila.com](mailto:lisa.chan@tezhila.com) and [lisa.chan@tezhila.com](mailto:lisa.chan@tezhila.com).

## **22. Dong Zhi Guang**

Dong Zhi Guang cannot be identified as a U.S. licensed attorney and is tied for #65th largest trademark filer before the USPTO with 247 marks in 2017 (**Exhibit O**). Guang's clients appear to be mostly in China, and he is a non-lawyer founder of a Chinese trademark agency, upon reason and belief, located at 901 Data Centre, PO Box 910 Xueyuan Rd., Haidian, Beijing, China, 100083. Guang uses the email [916837811@qq.com](mailto:916837811@qq.com) to file before the USPTO upon reason and belief.

## **23. Yang, Min, Shenzhen Yamon**

### **Intellectual Property**

Yang, Min, Shenzhen Yamon Intellectual Property cannot be identified as a U.S. licensed attorney and is the #70th largest trademark filer before the USPTO with 241 marks in 2017 (**Exhibit O**). Yang, Min, Shenzhen Yamon Intellectual Property clients appear to be mostly in China, and he is a non-lawyer founder of Yang, Min of ShenZhen YaMon Intellectual Property Agency Co.,Ltd., 1002, 10/F, Bldg 2, Colorful Tech City, Guanlan High-tech Park, Longhua New Dist, Shenzhen, China, 518109. The email used is [yamon123@163.com](mailto:yamon123@163.com) to file before the USPTO upon reason and belief.

## **24. Amanda Li**

Amanda Li cannot be identified as a U.S. licensed attorney and is the #84th largest trademark filer before the USPTO with 222 marks in 2017 (**Exhibit O**). Li's clients appear to be mostly in China, and she is a non-lawyer at i -Mark trademark agency, ([www.i-mark.com.hk](http://www.i-mark.com.hk)) at Unit B6, 20/F, Tak Wing Industrial



Bldg, No. 3 Tsun Wen Road, Tuen Mun, N.T., Hong Kong. Li uses the email [info@i-mark.com.hk](mailto:info@i-mark.com.hk) to file before the USPTO upon reason and belief.

## **25. Yolanda Lee**

Yolanda Lee cannot be identified as a U.S. licensed attorney and is the #89th largest trademark filer before the USPTO with 215 marks in 2017 (**Exhibit O**).

Lee's clients appear to be mostly in China, and he is a non-lawyer at a trademark agency in China, upon reason and belief, with a Regis virtual mail drop address at 77 Water Street, 7th & 8th Floors, New York, New York, 10005 (eg, See Regis office at the same address

<https://www.regus.com/virtual-office/united-states/new-york/manhattan/new-york-new-york-77-water-street>). Lee uses the email [yolandab@foxmail.com](mailto:yolandab@foxmail.com) to file before the USPTO upon reason and belief.

## **26. Various Individuals, Common Addresses.**

In addition to the top 25 identifiable individuals above, the World Trademark Review article in **Exhibit V** points to a number of various other Chinese nationals using the same common address so as to not rank highly on the USPTO rankings list. These individuals can easily be identified by the USPTO searching addresses below:

<b>Filing Correspondent</b>	<b>Address</b>	<b>Total Applications in 2017</b>	<b>Applications from China</b>
Various Chinese Individuals	Excellence Century Centre, Tower 3, Shenzhen, China	2327	2327
Yi Li Fang And others.	Unit 3, Building 19, Yimeishanzhuang, Shenzhen, China	988	988
Various Chinese Individuals	Changdi Torch Building, Hangzhou, China	852	852
Various Chinese Individuals	PO Box 2409, Suzhou City, China	553	553

## **RELIEF REQUESTED**

For the above mentioned reasons, Grievant respectfully requests that the USPTO restrain and enjoin them, directly or indirectly, on his own or as a partner,

or an employee from operating websites known as LegalHoop.com or any other website that attempts to offer any legal services requiring the practice of law including, but not limited to, U.S. trademark filing and prosecution services for office actions, statements of use, oppositions, trademark watch, renewal, opposition, and litigation services.

For the above mentioned reasons, Grievant respectfully requests that the USPTO follow its stated procedures for notification to affected applicants of an excluded marks for all trademarks in which government fees were paid by the excluded party including, but not limited notifications to the affected applicant or registrant that:

i. Unlicensed Chinese Practitioners and their websites including but not limited to LegalHoop.com are not entitled to practice before the USPTO in trademark matters and, therefore, may not represent the applicant or registrant.

ii. Any U.S. trademarks and documents filed by Unlicensed Chinese Practitioners are *void ab initio*, meaning they were invalid from the start of any action taken by the excluded party.

Iii. Unlicensed Chinese Practitioners may not sign checkboxes, pay government fees, prepare trademark applications, assist with responses to the USPTO's actions,

authorize examiner's amendments or priority actions, conduct interviews with USPTO employees, or otherwise represent an applicant, registrant, or party to a proceeding before the USPTO.

iv. All correspondence concerning the application or registration will be sent to the domestic representative if one has been appointed, or, alternatively, and in most circumstances, to the applicant or registrant at his/her address of record.

## **CONCLUSION**

While the Grievant understands and appreciates the need for Chinese nationals to be able to access the United States trademark system through culturally compatible Mandarin language speaking trademark professionals, the same can be said in the reverse. American business owners often want to seek protection in China using culturally compatible English speaking U.S. trademark attorneys. For example, the World Trademark Review writes:

Overall, then, finding concrete information on many of the new entities on the list is not an easy task, with Cindy Johnson Walden, chair of the trademark copyright practice group at Fish & Richardson, reflecting: "There is obviously an increased desire by Chinese companies to file trademark applications in the US, and they are doing so through less established channels." The question, then, is why tens of thousands of Chinese applicants are not choosing more established norms when they look to file trademarks in the country. Walden suggests it is probably "something to do with a higher comfort level of working with native Chinese speakers" and also "to do with cost". This latter point is reiterated by Douglas Wolf, shareholder and IP lawyer at Wolf Greenfield. (**Exhibit V**).

There is no reciprocity offered by the Chinese government. Therefore, there is an unreasonable competition against the interests of the Grievant, upon which this grievance is based. Under the context of current state and federal law, the practice of trademark law by these individuals and entities is unlawful. *See e.g.*, 37 C.F.R. §§ 11.5(b)(2) and 11.505,, TMEP § 608.01.

The World Trademark Review (WTR) featured an article on November 10, 2017 titled “US trademark filings from China soar, but law firms struggle to capitalise amid warnings of suspicious activity”. (**Exhibit V**). In this article, the article described “New data reveals a massive rise in US trademark applications from China.” (**Exhibit V**). “The figures, compiled by CompuMark, show that US trademark applications originating from the country have skyrocketed; in 2012, there were just 3,400 filings from Chinese applicants. In 2017 (up to November 8) that figure stands at close to 50,000 – accounting for over 10% of all filings to the USPTO so far this year.” (**Exhibit V**).

At the USPTO’s quarterly meeting of its Trademark Public Advisory Committee (TPAC) in the last quarter of 2017, the trademark commissioner Mary Boney Denison specifically brought up one problem that the office is aware of.



“There has been a dramatic increase in Chinese filings which don’t appear [to be] legitimate,” she noted. “Many people are sending in fake specimens as part of applications; we are working on a suspicious specimens email box to help with this.”(Exhibit V).

For the reasons stated, it is respectfully submitted that there are reasonable grounds to conclude that above violated, *inter alia*, the Rules of Professional Conduct of the USPTO, the Rules of Professional Conduct of the State of California, and/or the laws of the United States. An investigation, therefore, is warranted.

The undersigned is available to provide any further assistance, information, or documentation as may be necessary.

Thank you for your attention to this important matter.

Respectfully submitted,

Raj Abhyanker, Esq.

Enclosures: As stated.

**Law-inspiring™**

# EXHIBIT D

## BIGLAW

# Axiom's War On Biglaw

Axiom's IPO application foreshadows problems for Biglaw.

By JAMES GOODNOW

Mar 8, 2019 at 9:59 AM



Axiom's war on Biglaw continues, and this time it's making a move that Biglaw cannot, by definition, respond to.

Axiom, the alternative legal services provider founded in 2000, has been on a tear in recent years. Its most recently reported revenues, from 2017, came in at \$300M for the year, about the same as an Am Law 150 firm. It has over 1,300 attorneys on staff, global reach, and high-powered clients eager for alternatives to traditional, pricey Biglaw. Axiom's success has been [one more example](#) of how smartly deployed 21<sup>st</sup>-Century technology has allowed small startups to rocket to the top of well-established industries in relatively little time.

Late last month, Axiom dropped a potentially game-changing bombshell. The alternative legal services provider recently [applied for an IPO](#) in the U.S. We don't know yet the terms of the IPO, or where the stock will be listed, or really much of anything other than the fact that an IPO is on the menu. What we do know is that Axiom is looking to turbocharge its growth, which has already been explosive for several years.

## We've Got Stock, But No Options

For leadership of law firms that Axiom is competing with, this development is equal parts terrifying and frustrating. It's terrifying in that the IPO threatens more growth by one of the companies that has been aggressively eating into what was traditionally a law-firm-only pool of work. And it's frustrating because U.S.-based law firms have no equivalent countermeasures.

[As I've discussed in this space previously](#), one of the major economic and organizational hurdles that law firms of today face is the ethical bar on ownership of firms by non-lawyers. The ethical rules are there with noble intention: we want to ensure that the biggest decisionmakers and stakeholders impacting our clients and their cases are all bound by the ethical rules that govern our profession.

There's a healthy debate to be had over whether this aspiration is worth the limits it places on law firm development. In practice, it means law firm management is often composed of attorneys with limited or no organizational management training. It further limits the pool of non-attorney managers that law firms can turn towards, since law firms can't offer equity in the company, as would be offered to most high-end management candidates. When you self-impose limits on the ways you can pay your staff, you self-impose limits on the quality of that staff.

### **Shark Tank vs. Loan Sharks**

As we're now seeing with Axiom, the problem isn't just limited to limiting how law firms attract and compensate their managers. The problem extends to how those firms finance their growth.

Growth takes cash, and IPOs are a great way to get cash. Take a successful company on a winning streak, offer to allow the public to buy a piece of equity, then take that investment money and grow the company further. In an ideal world the company makes money, the investors make money, and everyone ends up happy. That's exactly what Axiom is hoping it can pull off, and it's free to do so since it's not a law firm.

Law firms don't have this same luxury, which is one more reason why news of this IPO is so disheartening. For the same reason we can't give equity in our firms to potential managers, we can't sell equity to the non-JD-having public at large through an IPO. If a law firm wants

to finance growth, its only options are to do so out of its own pocket or to take out a large loan.

Growing out of one's own pocket is a fine goal, but it generally requires major sacrifices to income and stability that most law firm partners aren't eager to take on. Plus, many projects will just be too expensive to self-finance. In those instances, law firms are left seeking gigantic business loans. Unlike IPOs, loans have to be repaid, on time and with interest tacked on. If a company that went IPO experiences slower-than-expected growth, its investors will grumble, but have little to no recourse. If a law firm's loan-financed expansion doesn't pan out, the firm and its partners may find themselves in serious legal jeopardy.

In short, Axiom gets to go on Shark Tank. Biglaw gets to see the loan shark.

### **A Business Model That Belongs In A Museum**

Biglaw is in a tough spot right now. Most large firms have barely finished clawing their way back to where they were prior to the Great Recession, despite roughly a decade of overall economic expansion in the U.S. Our customers are increasingly looking to decrease their spend with us, whether by dragging work back in house, or resorting to alternative providers such as Axiom or the [Big 4 accounting firms](#). Work is increasingly funneling to either the absolute tip-top of the market, or to niche, commoditized boutiques, leaving a middle market that's struggling to survive.

Axiom's IPO should be read as both a warning sign and a wake-up call. In this environment, we need every tool and every innovation possible at our disposal to make our century-old business model relevant again.

Relaxing the rules on law firm ownership by non-attorneys seems as good a place to start as any. The UK has been experimenting with publicly owned and traded law firms for several years at this point, and the sky has yet to fall. There surely must be a way to allow firms to grant equity stakes in themselves while still insulating the legal decision-making from their non-attorney owners. Until we recognize that, we're bringing a knife to a gun fight. [If you've seen Indiana Jones, you know how that turns out.](#)

Biglaw has lost ground to Axiom and its kind for the last two decades. We imposed the ethical rules on ourselves to protect both the public at large and the industry's reputation. If



those same ethical rules allow our space to become dominated by non-attorneys who aren't bound by them, are they not doing more harm than good?

The time to move is now. Axiom isn't waiting, so why should we?

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# EXHIBIT 18

# EXHIBIT 19

# EXHIBIT 20